

798
No. 2232

United States

Circuit Court of Appeals

For the Ninth Circuit.

Transcript of Record. (IN TWO VOLUMES)

FRED STEBLER,

Appellant,

vs.

RIVERSIDE HEIGHTS ORANGE GROWERS' ASSO-
CIATION, a Corporation, and GEORGE D.
PARKER,

Appellees.

VOLUME II.

(Pages ~~369~~ to 793, Inclusive.)

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Upon Appeal from the United States District Court for the
Southern District of California.

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(Deposition of Arthur P. Knight.)

different. I would add that this machine would not be adapted to grading oranges for the reason that the ribs on the rollers would mutilate the fruit so as to render it useless, but in so far as it would work with anything its principle would be the same.

Q. 39. You have referred to the fact that in this exhibit Defendant's Exhibit "Hutchins Patent," the grading elements are superposed one above the other, while, as you have stated, the grading rollers *consisting the* grading element of the patent in suit and of defendant's machine are arranged end-to-end. Does this construction *illustrate* in this Hutchins Patent throw any light, in your opinion, upon the meaning of the term "end-to-end," as used in the patent in suit?

A. Yes, sir. I think that this construction is an example of a construction other than end-to-end, that is to say, the successive grading elements are not displaced [703] endwise in relation to each other, but transverse, this is to say, one above the other. I would like here to call attention to another defect in this construction of Hutchins, which is overcome by the end-to-end construction. Each grading element of the Hutchins device discharges a portion of the fruit over the end and another portion passes through between the two members of the grading element. Now, the portion that passes over the end in the Hutchins device is the separated portion sized by that element and the portion which passes through to the next element is the portion which is not sized or graded by that element. Consequently, if a large

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number of such elements were used, such as is required in orange packing, the fruit which passes onto the last grading elements would have to pass through all of these grading devices, that is to say, between each set of rollers and belts successively being subject to a correspondingly great amount of wear and tear in the operation, whereas, with the end-to-end arrangement, the fruit which passes through between the two members of each grading element is immediately removed from the machine and does not have to undergo this grading operation again and the other fruit, which does not pass through, simply runs to the next grading element.

Q. 40. The oranges would drop by gravity through from one grading element to another in this Hutchins device, until it found the roller and belt which formed an opening slightly less than its size, would it? [704] A. Yes, sir.

Q. 41. And in your opinion, the successive falls of the oranges in that machine would be a deteriorating agent inducing decay in the oranges?

Mr. ACKER.—Objected to as leading in the extreme, furthermore, this witness has repeatedly testified that he is not qualified to testify as an expert in regard to the orange industry.

A. Yes, sir.

Q. 42. Proceed with your answer to the former question, Mr. Knight.

A. (Continuing.) The Rayburn patent, being Defendant's Exhibit "Rayburn Patent," number 726,756,—

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Mr. LYON.—(Interrupting.) This is the patent, Mr. Knight, is it not, that the application for Robert Strain for a reissue, resulting in the reissue patent in suit, was in interference with?

A. Yes, sir.

Mr. LYON.—You need give this patent no further consideration.

A. (Continuing.) Defendant's Exhibit "Bailey Patent," being letters patent number 671,646. This is a fruit grader comprising a series of grading elements, each element being double and one member or each side consisting of a vertically adjustable plate carrying a series of disks, the other member of each grading element consisting of the corresponding portion of a rotary disk or ring having inclined or beveled edges so that as the fruit [705] is delivered up onto the ring it is carried on by the ring into contact with the disks "12" of the successive sections and the supporting plates of these disks are adjusted so that the aperture between the rotating carrying disks and the disk carried by the adjustable plates increases in steps, the fruit passing through as soon as it reaches an aperture of sufficient size. In regard to the broad principle of operation, this machine is similar to the California, the Strain and other rope and roller graders. It has, however, inherent defects, which, in my opinion, prevents it from being an equivalent for any of these other straight line graders, its rotary motion leading to inherent difficulties in operation. To secure any considerable capacity in the machine, it would have to

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be given a considerable angular velocity and this would result in an appreciable centrifugal action on the fruit, tending to increase the outward pressure on the other side of the machine and decrease the discharging pressure on the inner side, furthermore, this circular shape renders it necessary to use a large number of disks "12" for each section and this does not give a smooth-bearing face for the fruit.

Q. 43. In your opinion, Mr. Knight, based upon your observation of fruit graders and your knowledge of oranges and the orange industry, as heretofore testified by you, would or would not a device built in accordance with Defendant's Exhibit "Bailey Patent," be a practical commercial machine for sizing oranges?

Mr. ACKER.—Objected to as incompetent, irrelevant and [706] immaterial and on the further ground that the witness has not been shown to possess the qualifications necessary to testify to such fact.

A. My opinion is that it would not be a practical commercial machine.

Mr. LYON.—Proceed.

A. (Continuing.) Defendant's Exhibit "Hutchins Patent No. 2," being letters patent number 465,856. This is similar in construction and operation to the Hutchins patent, above described, and open to the same comments.

Defendant's Exhibit "Huntley Patent," being letters patent number 538,330. I find no special similarity between the construction shown in this

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patent and that of either the Strain or Parker machines. The fruit runs by gravity along a guide-way under a roll which is spaced from the guide-way so that the space gradually increases and the fruit is ejected from the guide-way by the friction of the roll moving in such direction as to lift the fruit over the side of the guide-way. This is not the principle of operation of either the Strain or the Parker machines.

Defendant's Exhibit "Burke Patent," being letters patent number 482,294. In this machine the grade-way is formed by two stationary members, each of which is stepped and the fruit is drawn along between said members by a belt carrying fingers, which extend up into the grade-way and push the fruit along. This is not the principle of operation of either the [707] Strain or the Parker machines.

Defendant's Exhibit "Jones Patent No. 2," being letters patent number 442,288. This is strictly a roller machine, the grade-way being formed on one side by a roller, a rotating roller having a series of stepped sections and on the other side by a stationary member which serves as a fixed wall. There is no longitudinally moving member for conveying the fruit along the grade-way and presenting it successively to the different sections or rotating members and the principle of operation is therefore different to that of either the Strain or the Parker machine.

Defendant's Exhibit "Jones Patent," being letters patent number 430,031. This is similar to the

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Jones patent number 442,288 and the same remarks apply.

Defendant's Exhibit "Ish Patent," being letters patent number 458,422. This is the typical rope and roller grade, Ish showing a belt, but stating that he may use a rope. The principle of operation of this patent is that of carrying the fruit by the operation of the longitudinally moving member along the grade-way and presenting it successively to contact with successive roller sections of different diameters so that as soon as it reaches an aperture of sufficient size it will pass through. As far as concerns the act of grading the fruit in any one section, the Ish operation is similar to that of the Strain and Parker machines, but as regards a complete machine providing [708] for the grading of a number of sizes, the machine is different in that the several grades are provided for on a solid roller having stepped sections which sizes are predetermined and invariable. In the machine as illustrated then, there is no provision for individual or independent adjustment or variation of the sizes of successive sections so as to give any desired variation to the grading along the grade-way.

Defendant's Exhibit "Ellithorpe Patent" being letters patent number 399,509. I find nothing in this patent requiring comment as it is of the gravity table type in which the fruit is sized by passing over a table with differently sized holes.

Defendant's Exhibit "Maull Patent," being letters patent number 673,127. This is a rotary grader

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having a central wheel forming the inner member of the grade-way and an outer curved gauge, preferable of volute shape, which forms the outer member of the grade-way, a series of spouts being arranged directly below the grade-way so that as the fruit is carried around by the rotation of the wheel it will fall through between the inner and outer members of the grade-way, as soon as it reaches a point where the space is sufficiently great and will fall into the corresponding spout. This is somewhat similar to the Bailey patent in general principle of operation but it does not have separate sections of the outer member and does not appear to me of any special interest in this connection. [709]

Defendant's Exhibit "Fleming Patent," being letters patent number 475,497. The principle of operation of this machine is entirely different from that of the Strain or Parker or any rope and roller grader, the fruit being carried along by a belt and falls through apertures whose size are controlled by tilting flaps which are let down gradually by passing over an incline.

Defendant's Exhibit "Jones Patent of 1894," being letters patent number 529,032. This is a machine of the rotary type operating by gravity, the grade-way being formed by two concentrically mounted rotating members and the weight of the fruit causing the members to turn so that the fruit is carried through the grade-way from the portion of less width to portions of greater width. I see no special resemblance between this and the Strain or

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Parker machines.

Defendant's Exhibit "Woodward Patent," being letters patent number 466,817. This is a rope grader, the grade-way being formed by two ropes mounted so that the space between them diverges gradually and the fruit being carried along by the ropes and falling through as soon as it reaches a point of sufficient separation. There is no provision for individual or independent adjustment or variation of successive portions so as to provide for variation in grading and the machine is in that respect different from the Strain and Parker machines as well as in the general respect of being a rope grader instead of a rope and roller grader. [710]

Defendant's Exhibit "Cerruti Patent," being letters patent number 534,783. This is also a rope grader and the same remarks apply to it as to the Woodward patent.

Q. 44. You have read the testimony of the defendant, George D. Parker, that at the packing-house at Uplands, in an alleged test of the grader of the patent in suit without the use of the positive belts for driving the rollers the fruit would clog, have you?

A. Yes, sir.

Q. 45. In your investigation of such graders, did you pay any particular attention to such operation having in view this testimony? A. Yes, sir.

Q. 46. Do you agree with the testimony that Mr. Parker gives in that regard?

A. I do not. As far as I could determine from my investigation the fruit did not clog in the grade-

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way as long as there was a clear passage below. In some cases I found that the fruit had accumulated to an extent in the bins that it piled up in the space directly below the grade-way and in that situation there was clogging at that point.

Q. 47. Where you noticed such clogging, were the belts driving the rollers or were they removed.

A. At that particular location the rollers were being driven by the belts. We did not have an opportunity to examine in this case where there was such accumulation [711] with the belt taken off.

Q. 48. In other words, if I understand your testimony correctly, with this accumulation of oranges under the grade-way, even with the belt on the rollers and in position to rotate them, and rotating them, still the oranges clogged in the run-way of the grader?

A. Under those circumstances, yes.

Mr. LYON.—You may take the witness, Mr. Acker.

Cross-examination.

(By Mr. ACKER.)

XQ. 1. Do I understand you to testify that in the Upland packing-house that you examined Strain sizers constructed under the patent in suit and likewise a Parker sizer?

A. That is my recollection.

XQ. 2. You are positive that there was a Parker sizer in that packing-house?

A. No, I could not swear to the exact location of the sizer.

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XQ. 3. You are not able to state at this time whether you examined a Parker sizer in that house or not?

A. My recollection is directed mainly to the operation of the Strain machine and I could not swear positively whether I examined the Parker machine or not there.

XQ. 4. In your direct examination I understood you to say that you examined both.

A. That is my recollection but I could not swear positively. [712]

XQ. 5. Is the balance of your testimony based on the same recollection of the machine?

A. At the Riverside Heights packing-house I remember distinctly the Parker machine.

XQ. 6. What time did you devote to the examination of the machines at the various packing-houses that you have referred to?

A. It took us substantially a whole day to make the examinations.

XQ. 7. That is a whole day divided between the various houses? A. Yes, sir.

XQ. 8. And that would give approximately how much time at each place?

A. I should judge that we spent between a half an hour and an hour at each place.

XQ. 9. For what time did you examine the Strain machine with the belts removed?

A. About half an hour.

XQ. 10. Can you state approximately the quantity of fruit that passed through the grader during

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your examination? A. No, sir.

XQ. 11. What portion of the sizer, Mr. Knight, requires the most delicate adjustment?

A. Well, I should say the rollers.

XQ. 12. What portion of the run-way relative to its length?

A. I could not say as to that. [713]

XQ. 13. Your knowledge of the fruit grading industry is not sufficient to enable you to answer that?

A. No, sir.

XQ. 14. Please state in detail what knowledge you have of the orange industry and more particularly the use of sizing machines, and the extent thereof.

A. My knowledge of the industry and of the machines is confined to that gained by the inspections made on several occasions for my own instruction and as to the extent of the industry I cannot claim to have any special knowledge.

XQ. 15. You say for your own instruction. For the purpose of enabling you to testify for the purposes of this suit? A. Yes, sir.

XQ. 16. What machines have you examined in practical operation?

A. The Strain or Stebler machine, the H. K. Miller machine and the Parker machine.

XQ. 17. The H. K. Miller machine was the one that was involved in the previous suit?

A. Yes, sir.

XQ. 18. And to all intents and purposes, except for the utilization of power drive belts for the rollers

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was the same as the Strain?

A. There was a slight difference in the way the rollers were held but it was practically the same.

XQ. 19. Would it be a fair statement to state that your knowledge of the practical operation of sizing machines [714] for fruit has been confined to the Strain type of machine and the Parker type?

A. I would go further than that and say that it has been confined to the Strain type of machine.

XQ. 20. Entirely? A. Yes, sir.

XQ. 21. You have never examined any other machine in practical operation?

A. So far as practical operation goes.

XQ. 22. And your testimony as to the practicability of any machine other than the Strain type, as you have testified to, is solely from what you have concluded from a reading of the patents, is that correct?

A. And my general knowledge of mechanics. I would like to explain here that by the Strain type I include the H. K. Miller and the Parker machines as being of the same type.

XQ. 23. When you say your knowledge of machinery, you except therefrom any knowledge of machinery relating to fruit sizers of other than the Strain type, is that correct?

A. I do not understand your question.

Mr. ACKER.—Read his previous answer. I think it was drawn by your previous answer.

Previous answer of witness read by reporter.

A. As far as concerns having seen machines in

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actual operation, yes.

XQ. 24. What practical knowledge have you of machinery, Mr. Knight? [715]

A. The only practical connection I have had with machinery in the way of manufacture has been during the several years I was with the General Electric Company at Lynn, Massachusetts and Schenectady, New York in the manufacture of electrical machines.

XQ. 25. Were you personally engaged in the manufacture of such machinery as mechanic?

A. Not as mechanic but as one of the examiners in the testing department, testing the machinery and supplies.

XQ. 26. Can you state from your inspection of the Strain machine as you have examined it at the various packing-houses at what rate of speed or approximately the revolutions per minute of the rollers? A. No, sir.

XQ. 27. Then, I understand you to say that your testimony on that point is based upon merely glancing at the operation of these rolls?

A. No, it was more than glancing. I examined them quite at length but I did not attempt to count the number of revolutions.

XQ. 28. Is the Strain sizer what is known as a rope and roller sizer? A. Yes, sir.

XQ. 29. I understood you to testify that Mr. Stebler was present at the time of your inspection of the sizers at the various packing-houses you have testified to, which inspection was made June 12th, 1912?

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A. Except at Pomona. At the other two he was present.

XQ. 20. Did Mr. Stebler hold any conversation with you [716] regarding the action of these various sizers in connection with the run of fruit through them with the drive belts on and with the drive belts off of the rollers?

A. I can't remember that we had any special conversation on the subject, no. The investigations were made personally on my own account, but to the best of my recollection we did mention some of the features of the machines in talking it over during the trip.

XQ. 21. And discussed the operation of the parts?

A. Yes, sir.

XQ. 22. And likewise the operation of the parts involved in the Parker machine? A. Yes, sir.

XQ. 23. In answer to one of your direct questions, in describing the operation of the roll, that is the direction of its rotation, you stated that it was partly due to the oblique rotation of the fruit, and I will ask you to explain somewhat more definitely what you mean by the oblique rotation of the fruit.

A. The movement of the rope or belt is, of course, in a longitudinal direction and the only possible movement of the rollers is in a transverse plane. If the fruit were rotating only in a vertical plane extending longitudinally of the machine, it would not be capable of imparting a transverse rotation to the rollers unless the point of contact of the roller was above or below the center of the fruit. In that

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case the friction would cause an oblique rotation and this oblique rotation [717] around an axis which makes an angle with the axes of rollers would be sufficient to cause a transverse rotation.

XQ. 24. Would the shape of the fruit have any effect on the rotation of the rolls? A. Yes, sir.

XQ. 25. To what extent would the fruit which is perfectly round vary the movement of the rolls relative to fruit of irregular shape.

A. I did not investigate this point by experiment but offhand I would say that fruit of the irregular shape would produce a spasmodic movement. In every instance that I watched there was a rotation and it was in the direction which I stated.

XQ. 26. Is it your understanding that the patent in suit is confined to the sizing of oranges?

A. No, sir.

XQ. 27. It is for the sizing of fruits of all kinds including nuts, is it not? A. Yes, sir.

XQ. 28. Directing your attention, Mr. Knight, to the Hutchins patent number 456,094, I will ask you to state what constitutes the run-way for the fruit in said device.

A. It consists of a series of grading elements, each element consisting of the belt "f" on one side and the roller "2" on the other side.

XQ. 29. Does the Hutchins patent disclose what you have termed a rope and roller sizer, and when I use the [718] expression "rope and roller," let me say that I include the belt as being the equivalent of the rope.

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A. Yes, it is a rope and roller sizer in a sense.

XQ. 30. What do you mean by the qualification of your answer?

A. For the reason that a single rope does not serve for the conveying and sizing operation of a series of grading elements along the run-way, but separate ropes are used for the successive elements.

XQ. 31. Would it be a fair statement to say that the rope and roller sizer dates from as early as July, 1891? A. The intrinsic principle, yes.

XQ. 32. I believe you have testified that you have been connected with the examining corps of the Patent Office? A. As an Assistant Examiner.

XQ. 33. As an Assistant Examiner of the Patent Office, would you term the Hutchins device a rope and roller sizer?

A. It would be so classified.

XQ. 34. How many grades of fruit are taken care of in the Hutchins device? A. Three.

XQ. 35. Are the rotating elements or grading rollers of the Hutchins device adjustable toward and from the traveling members of the run-way?

A. Yes, sir.

XQ. 36. Are the rolls adjustable independently of one [719] another A. Yes, sir.

XQ. 37. The Hutchins device then discloses independent and individual adjustment of the grading rollers? A. Yes, sir.

XQ. 38. How are these rolls suspended?

A. They are journaled in horizontally adjustable hangers.

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XQ. 39. Might you properly term these hangers bearings or bearing brackets? A. Yes, sir.

XQ. 40. And these bearing brackets are adjustable? A. Yes, sir.

XQ. 41. And does the adjustment of the rollers move the same toward and from the propelling rope to vary the apertures for the escape of fruit?

A. Yes, sir.

XQ. 42. Does the Hutchins patent disclose a plurality of independently adjustable grading rolls which are movable toward and from the propelling means of the run-way? A. Yes, sir.

XQ. 43. In the Hutchins device, as I understand your testimony, and from the patent, the grading members are arranged one above the other, is that correct? A. Yes, sir.

XQ. 44. And in the complainant's machine the grading rolls are arranged end-to-end in longitudinal alignment, is that correct?

A. End-to-end but not exactly in longitudinal alignment.

XQ. 45. They would be in longitudinal alignment unless [720] they are adjusted to produce a graduated run-way, would they not? A. Quite so.

XQ. 46. Does the adjustment of one grading roll in the Hutchins device vary the position of any other grading roll? A. No, sir.

XQ. 47. Is it not a fact that the adjustment given the individual grading rolls of the Hutchins device is substantially the same as the adjustment given the grading rolls of the patent in suit?

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A. The effect is not the same.

XQ. 48. I did not ask about the effect, Mr. Knight. Please read the question.

Question read by reporter.

A. The adjustment is the same.

XQ. 49. Can you state what was the extent of the fruit industry in the year 1891? A. No, sir.

XQ. 50. You have no knowledge one way or the other on that point? A. No, sir.

XQ. 51. Is it a correct statement that the Hutchins device discloses a grader or sizer wherein the independent adjustment of the various grading members may be produced without varying the position of any other grading unit? A. Yes, sir.

XQ. 52. Is it not a fact that the fruit which passes [721] one grading member of the device of the patent in suit has to travel or traverse all other grading members of the grader or sizer until it reaches an aperture sufficient to permit it to escape from the sizer? A. Yes, sir.

XQ. 53. What reason had you for making the statement in your direct testimony that the Hutchins device is not adapted for the grading of oranges?

A. In the first place the rollers are provided with ribs which would be out of the question with oranges. In the second place, the arrangement of the successive grading elements one above the other and causing the fruit to pass successively between the members of each grading element for nine or ten different sizes, would in my opinion, damage the fruit even if the rollers were not ribbed.

(Deposition of Arthur P. Knight.)

XQ. 54. Does not the ungraded fruit in the sizer of the patent in suit have to pass successively through grading elements until it reaches a point of escape? A. Not through; no.

XQ. 55. Or between?

A. Yes, between in a manner which does not create any injurious pressure.

XQ. 56. Have you any foundation for your statement that the Hutchins device would not be adapted for sizing of oranges other than your theoretical opinion on that subject?

A. Only that I have been in a number of packing-houses [722] and have never seen one of them in use for the purpose.

XQ. 57. You mean during what time?

A. Oh, within the last two years.

XQ. 58. But you did not examine any of the machines in use during the year 1891? A. No, sir.

XQ. 59. Is it your understanding of the patent in suit that the sizing or grading rollers must be of uniform diameter, by which I mean each roll of uniform diameter? A. Throughout its length?

XQ. 60. Throughout its length? A. No, sir.

XQ. 61. A service of end-to-end stepped rolls would fall within the patented device, would it not?

A. Each roller being stepped?

XQ. 62. Yes, sir. A. Not in my opinion.

XQ. 63. Then, if I provide a series of end-to-end rollers as one member of the fruit run-way and step the said rollers, it is your idea that it would not fall within the terms of the patent in suit, is that correct?

(Deposition of Arthur P. Knight.)

Mr. LYON.—Objected to as a question directed to a question of law and not to a question of fact and as to a hypothetical construction not shown to have ever existed.

A. I could not pass on that question until some Court, [723] having authority to, should pass upon the exact meaning of the word “rollers” in this case.

XQ. 64. Independent of any decision of a Court, on said point, I will ask you to give an answer based on your observation of the patent in suit.

Mr. LYON.—The objection is repeated and the further objection is urged that it is not the proper subject of expert testimony. Expert testimony is for the purpose of explaining mechanical constructions and comparisons thereof and not for the purpose of determining by the mouth of an expert the scope of a patent, which is the province of the Court. A further objection is urged to the question, that it is indefinite and uncertain, as it does not contain a whole combination sufficient to make an operative grading or sizing machine or to illustrate the mode of operation of such machine or the construction of the parts.

A. As a matter of opinion, I would say that the terms of at least one of the claims would be sufficient to include such a construction. The meaning and scope of this claim would depend upon the specifications, drawings and prior state of the art and the question would arise whether such a construction, with a plurality of sections of different size to each

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roll, but with the different rollers independently adjustable so that each roll could be adjusted to and from the main other members of the grader without affecting in any way the adjacent roll, would be the same as with rollers [724] each roller of uniform size throughout its length. I should say, as a matter of opinion, that such a stepped construction of each roll would embody the principle of the Strain patent partially but not perfectly, as, without putting myself in the place of the Court, I could conceive that the Court might hold it to come under the principle of the Strain patent or it might not.

XQ. 65. Do you find anything in the specifications of the patent in suit that restricts or limits the sizing rolls to be of uniform diameter throughout their length?

A. On page 2, lines 13 to 16, Strain states: "By having short grade rollers separately adjustable very fine grading can be done and more than one roller may be adjusted to the same grade if desired," and on page 1 lines 60 to 64, Strain states, "there are as many bins as there are grade rollers." Both of these statements indicate to my mind that it was the intention to have a single roller for each grade and these rollers would be of uniform diameter throughout.

XQ. 66. What is your understanding of the language which you have read from the specifications contained between lines 13 and 16 on page 2 of the specifications?

A. My understanding of this language is that two

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adjacent rollers, for example, may be adjusted at the same distance from the opposite member of the grade-way. That is, for instance, rollers number one and [725] number two could be adjusted to the same grade of fruit.

XQ. 67. And if you adjusted number one and number two to the same grade of fruit that would necessitate cutting out one grade, would it not?

A. Keeping the same number of rollers on the machine, yes.

XQ. 68. And is such your understanding of the language contained between the lines to which your attention has been directed? A. Yes, sir.

By consent the taking of the depositions was at this point continued until two o'clock P. M. of the same day.

At two o'clock P. M. of the same date, at the same place and with those persons present as noted at the beginning of these depositions, the following proceedings were had:

ARTHUR P. KNIGHT, a witness produced on behalf of complainant, was recalled for further cross-examination, and testified as follows, to wit:

Cross-examination (Con.).

(By Mr. ACKER.)

XQ. 69. In order that the record may be clear, Mr. Knight, you understand that my questions regarding the Hutchins patent referred to the patent number [726] 456,092. There are two Hutchins patents and we want to clear the record.

(Deposition of Arthur P. Knight.)

A. Yes, sir.

XQ. 70. Directing your attention, Mr. Knight, to Defendant's Exhibit "Ish Patent," number 458,422, I will ask whether or not the machine therein disclosed is what is known as a rope and roller sizer, the same being the Ish patent of August 25, 1891?

A. Yes, sir.

XQ. 71. In the Ish device the rotating or revolving grading member is formed as a stepped roller, is it not? A. Yes, sir.

XQ. 72. And in the Ish device the grading sections of the roller are parallel with the traveling member of the grader or sizer, is that correct?

A. Yes, sir.

XQ. 73. And in the Ish device each grading section of the revolving member is in substantially longitudinal alignment, is that correct?

A. Yes, sir.

XQ. 74. To that extent it differs from the revolving grading members of the Hutchins device, is that true? A. Yes, sir.

XQ. 75. How would you describe the rotating member of the Ish device, or of the device of the Ish patent?

A. I know of no better way to describe it than in the terms of the patent, which states that it is [727] "a rotary member consisting of a graduated cylindrical body or roller which is mounted in suitable bearings."

XQ. 76. Are the bearings in which the graduated cylindrical roller is mounted adjustable?

(Deposition of Arthur P. Knight.)

A. No, sir.

XQ. 77. That is not adjustable one way or the other? A. No, sir.

XQ. 78. There are no provisions made in the Ish patent number 458,422 for adjustment of the graduated roller, is that correct? A. I find none.

XQ. 79. And it is your understanding that a machine built under the Ish patent would be a machine positively fixed so far as the bearings of the grading units are concerned, is that correct?

A. The word "under" is ambiguous here. It might be subservient to the Ish patent but departing considerably from the Ish patent. A machine constructed according to the specifications of the Ish patent would not provide for any such adjustment.

XQ. 80. If I should place another roll of similar structure to that disclosed by the Ish device at the end of the roll which appears in the drawing of the device, would I then have two rollers end-to-end?

A. Yes, sir, but the machine would then be inoperative.

XQ. 81. In other words, the fact that the roll is stepped does not in any manner change your definition of the word "roll," does it?

A. No, sir. [728]

XQ. 82. I will ask you to take patent number 671,646, granted Bailey August 9, 1901, and I will ask you whether that patent discloses a fruit grader, or what has been commonly termed throughout this present testimony, a sizer, having apertures for the escape of the fruit to be graded?

(Deposition of Arthur P. Knight.)

Mr. LYON.—This question and all questions asked the witness in regard to the Bailey patent will be understood as subject to the objection made to the offer of the Bailey patent in evidence, to wit, that it is not a part of the prior art.

Mr. ACKER.—I understand such an objection has been made to the introduction of the Bailey patent but I do not recognize the validity of the objection in any manner whatever.

A. Yes, sir.

XQ. 83. Are these apertures controlled in any manner so as to regulate the opening for the fruit to be sized? A. Yes, sir.

XQ. 84. Does the Bailey device disclose a fruit sizer provided with a plurality of controlled apertures for the fruit to be sized? A. Yes, sir.

XQ. 85. Does the Bailey device disclose a fruit grader one member of which is composed of a series of controlled apertures and rollers in each aperture.

A. I could hardly call the aperture a positive element but for each grading element there is a roller.
[729]

XQ. 86. Are the rollers arranged end-to-end?

A. In a sense, yes.

XQ. 87. Are the rollers of any one grade unit independently adjustable toward and from the propelling member of the grader?

A. Yes, sir, that is ambiguous. Do you mean independently with respect to the other rollers of the same element?

XQ. 88. No, independent of the roller of an ad-

(Deposition of Arthur P. Knight.)

jacent or other grading unit. A. Yes, sir.

XQ. 89. And that adjustment is independent of each other, that is to say, I can adjust one of the grade units carrying the rotating members without disturbing the position of the other?

A. Yes, sir.

XQ. 90. How are the end-to-end rollers of one grade unit carried?

A. By roller I take it you mean the discs "12," which are mounted on the curved shafts or rods "11."

XQ. 91. That is correct.

A. These shafts are carried by plates which are mounted so as to be vertically adjustable on the machine.

XQ. 92. Would it be proper to designate that plate which you have termed "a plate," as a supporting bracket for the rotatable member?

A. The plate together with the portion which extends outwardly therefrom and carries the shaft "11" might be termed a bracket. [730]

XQ. 93. Does the device disclose any guides for the bracket, or the equivalent of the guides?

A. The slots "9" in the plates, together with the thumb screws "10," may be regarded as guides.

XQ. 94. The series of disks sustained and supported by any one of the bracket plates, taken as a whole, constitutes a rotating member for that grading unit, do they not?

A. I would not call it a rotating member. It consists of rotating members.

(Deposition of Arthur P. Knight.)

XQ. 94. If any one roll of the series of rolls utilized in the Strain patent were divided into a plurality of sections would the subdivision of the same remove it from within the sphere of a roll?

A. I would not call it a roll, I would call it a series of rolls.

XQ. 95. Then, in that case you would call each rotating grading member to be comprised of a plurality of rolls? A. That is it.

XQ. 96. Can I correctly so designate the rotating member of each guide unit of the Bailey patent?

A. I should think so.

XQ. 97. And would you consider the rolls of the respective grading members of the Bailey device as being end-to-end rolls?

A. Yes, sir, if you take it referring to the several disks on one end.

XQ. 98. If the rolls of the patent in suit, take for [731] instance the first roll, was subdivided into twelve sections, it would still come within the term of end-to-end rollers, would it not?

A. I should think so.

XQ. 99. In other words, the multiplicity of sections going to make up any one roll would not divert from it being a roll within the meaning and the purposes and functions to be carried out by the patent in suit, would it?

A. Not if they are all strung along in a straight line.

XQ. 100. That is it would only be necessary that the sections of any one grading member be in the

(Deposition of Arthur P. Knight.)

same line and of the same diameter? A. Yes.

XQ. 101. And such is the case with the rotating members of each grade section of the Bailey device, is it not?

A. No, sir, they are on a curved line.

XQ. 102. But does the fact that they are on a curved line remove them from being end-to-end?

A. No, sir.

XQ. 103. From your knowledge of the prior art and your experience as an Examiner in the Patent Office, would you or would you not consider that the fruit sizing industry was a well-filled field at the time of the filing of the application for the reissue patent in suit?

Mr. LYON.—Objected to as incompetent, irrelevant and [732] immaterial.

A. I can't say that I would.

XQ. 104. How many rollers would it require to form a rotating member of a fruit sizer of end-to-end rollers?

Mr. LYON.—The question is objected to as indefinite, and uncertain and ambiguous.

Mr. ACKER.—I would suggest for the benefit of counsel for complainant that he wait until the witness expresses any doubt or indefiniteness as to a question, because what may be indefinite to counsel it does not necessarily follow that it would be indefinite to the witness.

Mr. LYON.—The fact remains, however, that a fruit grader is not composed solely of one or more rollers and we are not here dealing with simply a

(Deposition of Arthur P. Knight.)

series of end-to-end rollers but with two combination claims and it is elementary law that there is no particular novelty in the separate elements of these claims and it has been repeatedly held that such a combination claim cannot be anticipated piecemeal or by a process of combination or reorganization of the devices of the prior art for the purpose of picking out one element of the prior art here and there another, and thus building up an anticipation of the patent in suit solely for the purpose of a mental and theoretical anticipation and such a proceeding is not judging the invention by what actually existed prior thereto but is the same in force and effect as the interpolation [733] in the testimony of any witness of matter to which he has not testified. If counsel desires to be fair either to his subject matter or his witness, he will include sufficient in his question to make an operative combination so that the witness will then be able to judge as to the constructions and operations of the devices.

Mr. ACKER.—I desire to thank counsel for the statement he has made and I presume the Court is fully aware of the elementary principles which he has and the only purpose I can see for the dissertation he has given is to instruct the witness.

Mr. LYON.—It might be well for counsel for the defendants to consider the decisions of this Court and the Circuit Court of Appeals in the cases of Los Alamitas Sugar Company vs. Carroll and Parker vs. Stebler in this connection.

Mr. ACKER.—I again thank counsel for calling

(Deposition of Arthur P. Knight.)

attention to well-known decisions and which the Court is doubtless familiar with.

A. I should say that one roller would serve for the rotating member.

XQ. 105. One roller in your opinion would constitute a series of end-to-end rollers?

A. That was not the question.

Mr. ACKER.—I beg your pardon; I think it was. I will ask the stenographer to read the question.

XQ. 104. Read by the reporter.

A. It would only require one roller to form a rotating member of a fruit sizer having end-to-end rollers. [734]

XQ. 106. What do you understand by the expression “a series of end-to-end rollers”?

A. I understand a plurality of rollers arranged end-to-end, that is to say endwise of one another rather than sidewise or critically.

XQ. 107. And two rollers would answer the term “a series of end-to-end rollers”?

A. Yes, sir, in the terms.

Mr. ACKER.—That is all, Mr. Lyon.

Redirect Examination.

(By Mr. LYON.)

RDQ. 1. Referring, Mr. Knight, to Defendant's Exhibit “Bailey Patent,” point out in the drawing of this patent, or in the description, any belt longitudinally moving the length of the machine and forming one side of the fruit run-way.

A. I find no such element.

RDQ. 2. In your experience as one of the corps

(Deposition of Arthur P. Knight.)

of examiners of the United States Patent Office, in accordance with the interpretation of the patent laws as there interpreted, would you say that an inventor presenting to the Patent Office a claim for a combination in a fruit grader in which there was called for a longitudinally and horizontally moving belt as one member of the run-way and a plurality of rollers as the other side of the run-way, would be rejected as anticipated by the device of the defendant's exhibit "Bailey Patent"? [735]

Mr. ACKER.—Objected to as incompetent, irrelevant and immaterial as it has not been shown that Mr. Knight ever had anything to do in the Patent Office as an Examiner in charge or as an Assistant Examiner in the division having charge of this class of machinery.

A. I do not think that it would.

RDQ. 3. I notice in your cross-examination you made some differentiation between straight line alignment of rolls and the curved line arrangement of the disks in Defendant's Exhibit "Bailey Patent." Will you explain a little more fully what this line of differentiation is?

A. If the shaft "11" carrying the disks "12" in the Bailey patent were straightened out, it would then be an arrangement in which a plurality of rollers are mounted end to end along a straight line and if the disks were all of exactly the same size and were finished, they would present a smooth surface, which might act substantially the same as a single roll, but with a curved shaft the disks must necessarily be

(Deposition of Arthur P. Knight.)

separated somewhat at their outer edges, for the reason that even if they are in contact at their inner edges the curvature of the shaft will throw their outer edges out of contact. This will leave the edges of the disks "12" so that they no longer form a perfectly continuous surface. Of course the distance is small compared to the size of the fruit and the fruit would run over the surface of the disks, but I do not see how it could help being cut in the operation, especially [736] as the disks would have to be made of some material sufficiently strong and hard to stand considerable wear.

RDQ. 4. Referring, now, to Defendant's Exhibit "Hutchins Patent" Number 456,092, how many run-ways are shown in the drawing of this patent?

A. Two.

RDQ. 5. How many belts or ropes or longitudinally moving devices?

A. Well, I should say, it being a double machine to make two to six sizes, and the rope, of course, or in this case the belt, is formed double, so that there are really two conveying belts, one above the other.

RDQ. 6. And in the Defendant's Exhibit "Hutchins Patent," you do not find a single run-way having a plurality of grading apertures, do you?

A. No, sir.

RDQ. 7. If it were attempted to build an orange grading or sizing machine after the construction illustrated and described in Defendant's Exhibit "Hutchins Patent," several run-ways for the several grades would be arranged one above the other, would

(Deposition of Arthur P. Knight.)

they? A. Yes, sir.

RDQ. 8. And I understand there are ordinarily either nine or ten grades of fruit provided for in an orange grading or sizing machine, is that correct?

A. In the machines I have seen there are.

RDQ. 9. Now, in the device built in accordance with Defendant's Exhibit "Hutchins Patent," which size of [737] fruit would be first separated?

A. The largest size would be first separated.

RDQ. 10. And what would become of the smaller sizes that were passing onto the upper grade-way?

A. If the size of them corresponded to the second grade-way, it would fall on the incline H' or into the space at the end of that incline and pass on to the next roller and belt and then backward to the second discharge. If it was fruit of the smallest size, it would, on dropping on the incline H' or dropping through the grade slot beyond the lower end of the first grading roller, it would drop through the second slot out onto the incline at the bottom of the machine.

RDQ. 11. What would the result of such dropping effectuate in the practical use of machinery for separating oranges according to size?

A. In any delicate fruit, such as oranges, it would be extremely injurious to the skin of the orange.

RDQ. 12. And what effect would such injurious effect on the skin of the orange have?

A. It would tend to promote decay.

RDQ. 13. Some insinuations have been made by counsel for defendants as to your knowledge of oranges and I will now ask you if your testimony

(Deposition of Arthur P. Knight.)

that you have just given in regard to the injury of the skin of the orange and thereby causing decay is within your personal knowledge of the subject?
[738]

Mr. ACKER.—I object to the use of the word “insinuation,” as made use of in the last question.

Mr. LYON.—The word is not used in any derogatory or insulting sense, but in the same sense that counsel for defendants has asserted or insisted a lack of experience in this art to the witness.

A. In regard to the skin of the orange being delicate, I speak from actual experience, and as for the effect of the abrasion of the skin of oranges, I will say that it is a well-known fact.

RDQ. 14. On June 12th, 1912, you first visited packing-houses where?

A. Pomona, Uplands and Riverside.

RDQ. 15. In the Pomona packing-houses or house, either one of them, did you see any of the defendant's or Parker machines in operation?

A. Yes, sir.

RDQ. 16. At Uplands, did you see any of the Parker machines in operation?

A. I can't say that I did.

RDQ. 17. Did you at Riverside, California?

A. Yes, sir.

RDQ. 18. In any of these packing-houses, did they have in use both the defendant's or Parker machine and the Stebler or device of the patent in suit?

A. Yes, sir, at some of the packing-houses they had both of them, but I could not say that both of

(Deposition of Arthur P. Knight.)

them were in operation at the same time.

Mr. LYON.—That is all. [739]

Recross-examination.

(By Mr. ACKER.)

RCQ. 1. What is the purpose of the longitudinally traveling rope in the patent in suit?

A. It has a twofold purpose, first to convey the fruit along the grade-way so as to present it to the successive grading sections, and second to form one wall of each grading section.

RCQ. 2. Would not any traveling or propelling member serve the same function?

A. I cannot say as to that.

RCQ. 3. The main function of the traveling rope working in the groove of the nonmovable guide of the patent in suit is to propel the fruit through the grade-way, is it not?

A. You mean along the grade-way?

RCQ. 4. Yes.

A. I can't say that that is the main function. It would be useless without the further function of presenting the fruit to the successive grading sections.

RCQ. 5. Any traveling means that supported the fruit and propelled it along the grade-way would serve the same function, would it not?

A. Not necessarily. It might be of such an impractical nature that it would not perform the function.

RCQ. 6. Do you find any means in Claim 10 of the reissue of the letters patent in suit of a belt forming one member of the run-way?

(Deposition of Arthur P. Knight.)

Mr. LYON.—Objected to as incompetent, being an inquiry [740] directed to subject matter as to which it is the province of the Court to determine and not the proper subject of expert testimony, there being no ambiguity in the claim and therefore incompetent. A. Not in so many words.

RCQ. 7. You find no mention of a belt, do you?

Mr. LYON.—The same objection.

A. Not by name.

RCQ. 8. Do the specifications of the patent in suit state how many sizes or grades of fruit are to be taken care of? A. Yes, sir.

RCQ. 9. Where? A. Page 1, lines 81 and 82.

RCQ. 10. That is in connection with the function of orange grading? A. Yes, sir.

RCQ. 11. Do you find that it is restricted to nine grades? A. No, sir, not necessarily.

RCQ. 12. Would you consider a machine constructed exactly in accordance with the device of the patent in suit which embodied only three rolls arranged as therein shown and described, as being within the terms of the patent?

Mr. LYON.—Objected to as incompetent, being addressed to subject matter as to which *is it* the province of the Court to determine and not the proper subject of expert testimony. [741]

A. Yes, sir.

Mr. ACKER.—I believe that is all, Mr. Lyon.

Mr. LYON.—That is all.

**[Deposition of Fred Stebler, for Complainant
(Recalled).]**

FRED STEBLER, being recalled as a witness in his own behalf, testified as follows, to wit:

Direct Examination.

(By Mr. LYON.)

Q. 1. Mr. Stebler, you testified that you are familiar with Defendant's Exhibit Hutchins Patent, being letters patent number 456,092. I will ask you if you have ever seen in use anywhere in the grading of any kind of device, a machine built in substantial accordance with the description and drawing of this patent? A. No, sir, I never have.

Q. 2. Have you ever heard of such a machine being used? A. No, sir.

Q. 3. Based upon your experience of the past twenty-three years, are you able to state whether such a machine would be a practical machine for grading or separating oranges as to their size?

A. In my opinion it would not be practical.

Q. 4. What reason have you for such opinion?

A. Well, first of all the use of bins in connection with the use of an orange grader is imperative, and so far back as I am acquainted with the orange industry they [742] have always used them, due to the fact that ordinarily a machine is required to make from nine to twelve sizes of oranges. To construct one of these machines to make this number of sizes and direct them to suitable bins from which they could be packed would be utterly impractical,

(Deposition of Fred Stebler.)

for the reason that first of all the machine would have to be made correspondingly high, in so much as there is a positive drop required to make each and every size of fruit. This drop between the grading elements in the machine to make even nine sizes would aggregate eight or ten feet. Fruit being fed into the top of the machine, of course, the largest sizes would be immediately carried off into a bin, the remaining eight or nine sizes would tend to drop through the machine and bounce and pound on the various grading elements until they reached the bottom of the machine, and it is evident to anyone at all familiar with the constituents of any ordinary delicate fruit that this would be very detrimental to the appearance or carrying quality of the fruit after it was subject to this process. Then, again, there is the question of getting the sized fruit as it comes from this machine directed to the bins to enable the required number of packers to get at it. There is no means shown here in this patent for doing this, and it is obvious to anyone familiar with the orange-packing industry that this would be a serious problem.

Q. 5. You say that since 1905 you have owned the patent, Complainant's Exhibit "Rayburn Overhead System Patent," [743] and that the devices of this patent have been discontinued practically from use. Can you give us the reason for that?

A. The chief and real reason for the discontinuance of this Rayburn overhead system was due to the difficulty of getting the fruit down from the sizer

(Deposition of Fred Stebler.)

overhead to the bins below. It was found practically impossible to do this without the fruit suffering such injury as I have mentioned in connection with the Hutchins patent. And of late years it has become to be realized that oranges must not be bumped or bruised by dropping or rolling them around if the grower or packer of them wishes to get full value for them on sending them to market, and it is for this reason that the use of such devices that have tended to cause bruising or injury have been discontinued.

Q. 6. Mr. Knight was asked on cross-examination what portion of the run-way of an orange grading or sizing machine requires the most delicate adjustment. What have you to say in regard to this?

A. The only way I can answer that question would be to say the rotating element of the run-way, as a whole.

Q. 7. Well, is there any one particular portion of the rotating element of the run-way for any given one or two of the grades which requires greater attention than the others? A. No, sir.

Q. 8. You have heard Mr. Knight's criticism of the [744] operation of a device built in accordance with defendant's exhibit "Bailey Patent," have you not? A. Yes, sir.

Q. 9. State whether or not you agree with him and if you differ with him, give your reasons.

A. I agree with him that the machine constructed in accordance with the Bailey patent would be impractical both from the standpoint of the injury to

(Deposition of Fred Stebler.)

the fruit and the action it would have on the fruit.

Mr. LYON.—That is all.

Cross-examination.

(By Mr. ACKER.)

XQ. 1. Into how many grades are nuts separated, Mr. Stebler?

A. Well, I can answer that question first indirectly by saying that I don't know the number of sizes any kind of nuts are graded into. You have not stated what kind of nuts you refer to and I only know of one kind of nuts that are graded for size and that is walnuts.

XQ. 2. How are they graded?

A. On a machine.

XQ. 3. Into what sizes are they graded?

A. I don't know that.

XQ. 4. How are potatoes graded as to size?

A. I never yet saw potatoes graded for size.

XQ. 5. What have you to say concerning vegetables?

A. I have never seen vegetables graded for size.

XQ. 5. Is it not a fact that the Strain patent is [745] taken out as a grader designed to sort fruit, vegetables, such as potatoes, and nuts, into lots of regular sizes?

A. I presume it is a fact that the inventor stated in making application for patent on this machine that for any such purpose it could be applied to, it was to apply, it might apply.

XQ. 6. Is it not a fact that the patentee stated that the machine related to that class of graders de-

(Deposition of Fred Stebler.)

signed for the assorting of fruit, vegetables, such as potatoes, and nuts, into lots of different sizes and that the object of the invention was to provide a machine for that purpose?

A. I believe the specifications so state.

XQ. 7. Is it not a fact that the Hutchins patent was taken out as a sorting machine for fruits and vegetables?

A. His specifications state that it is for fruit and vegetables; yes.

XQ. 8. Have you ever manufactured, sold and had placed into use a machine built exactly in accordance with the machine of the Strain reissue patent in suit without any other appliances thereon?

Mr. LYON.—The question is objected to as indefinite and uncertain as to what is intended by the term “exactly in accordance with the machine of the Strain reissue patent in suit.”

A. Possibly not exactly in all details.

XQ. 9. In what respects did you differ, Mr. Stebler?

A. Possibly some difference in the manner of mounting [746] and adjusting the rollers.

XQ. 10. And how about the distribution of the fruit?

A. Well, this drawing of this patent does not refer to a manner of distribution of the fruit; it is as to the manner of sizing it.

XQ. 11. So I understand. How about so far as it relates to the conveying of the graded fruit to the bins? Were the machines constructed in accord-

(Deposition of Fred Stebler.)

ance with the device illustrated and described by this patent? A. Practically, so; yes.

XQ. 12. What do you mean by "practically so," the qualification?

A. Well, I stated in my last answer that I never followed it in detail.

XQ. 13. How far does the fruit fall after passing through between the grading rollers of the machine constructed in accordance with the patent in suit?

A. Never more than ten inches.

XQ. 14. How far would it fall in a machine constructed in accordance with the Hutchins patent, number 456,092?

A. As I stated awhile ago, when you come to make nine or ten sizes, some of it is apt to fall from eight to ten feet.

XQ. 15. Why?

A. Because it would start from the top and fall to the bottom.

XQ. 16. Does it not move from the first incline onto the second grading unit? [747]

A. Yes, and in the case of the next larger size it will possibly stay there and be carried on to the end of the machine, but in the case of the smaller sizes, it immediately drops through to the next grading element.

XQ. 17. And upon the incline?

A. Yes; on to an incline and strikes every one on its way down.

XQ. 18. You were asked what you had to say in regard to the Hutchins patent, based on your twenty-

(Deposition of Fred Stebler.)

three years' experience. Do I understand that you have been engaged in connection with the orange industry for twenty-three years? A. No, sir.

XQ. 19. How long have you been?

A. Thirteen years.

XQ. 20. Since 1899? A. Yes, sir.

XQ. 20. So your remarks as applicable to the Hutchins machine were not based on an experience of twenty-three years in the orange industry?

A. No, sir.

Mr. ACKER.—That is all, Mr. Lyon.

Redirect Examination.

(By Mr. LYON.)

RDQ. 1. Do you know, Mr. Stebler, in what pursuit Robert Strain was engaged when he made the invention of the patent in suit?

Mr. ACKER.—Objected to as incompetent, irrelevant and [748] immaterial, as it would have no bearing upon the purposes of the patented device and the patent speaks for itself in connection with that subject.

A. He was engaged in the pursuit of packing oranges.

RDQ. 2. Where? A. At Fullerton.

Mr. LYON.—That is all.

By consent the taking of the depositions was at this point continued until ten o'clock A. M. of Thursday, June 21, 1912.

On Thursday, June 21st, 1912, at the same place and with those persons present as noted at the beginning of these depositions, and at the hour of ten o'clock A. M. of said day, the following proceedings were had, to wit:

[Deposition of M. R. Whiffin, for Complainant.]

M. R. WHIFFIN, a witness produced on behalf of complainant, being first duly cautioned and sworn to testify the truth, the whole truth and nothing but the truth, testified as follows:

Direct Examination.

(By Mr. LYON.)

Q. 1. Please state your name, age, residence and occupation.

A. M. R. Whiffin; my age is forty-three years; occupation is superintendent of packing-houses, [749] Arlington, Riverside County, California.

Q. 2. What packing-houses are you superintendent of? A. I am superintendent of four.

Q. 3. Where?

A. Two situated at Arlington station at an orange and lemon house there and the same at Prenda under the same company, known as the Arlington Heights Fruit Company.

Q. 4. You attend here this morning in response to a subpoena served on you to testify? A. Yes, sir.

Q. 5. In the orange packing-house of the Arlington Heights Fruit Company, at Arlington Heights, what kind or kinds of fruit graders are you now using?

(Deposition of M. R. Whiffin.)

A. We are using the Stebler rope and roller grader.

Q. 6. In a general way can you describe that machine?

A. Well, it is, the fruit is carried on a rope and kept revolving by a series of independent rollers.

Q. 7. Each of the rolls is independently adjustable?

Mr. ACKER.—Objected to as leading.

A. Certainly.

Q. 8. Are you familiar with drawings, Mr. Whiffin? A. Not very, I am afraid.

Q. 9. I show you a copy of the patent in suit and call your attention to figure 1, and ask you to look that figure over and state whether or not the machines, so far as the grading devices are concerned are substantially like those shown on this drawing. When I say "the machines," I mean the ones in the packing-house [750] of the Arlington Heights Fruit Company at Arlington Heights, Riverside County, California.

A. It is practically the same thing.

Q. 10. Those machines were purchased from Fred Stebler of the California Iron Works of Riverside, California? A. Yes, sir.

Q. 11. Prior to using that machine, or those machines, had you used any other kind of machine?

A. We had used the old rope and roller, which was afterwards changed to this independent rope and roller.

Q. 12. Did that old rope and roller grader have

(Deposition of M. R. Whiffin.)

any particular name?

A. I think it was called the "All California" grader.

Q. 13. What kind of a roller did they have?

A. It was a roller probably five feet long with a graduated scale on it.

Q. 14. In other words, it was a stepped roller?

A. It was a stepped roller; yes, sir.

Q. 15. What was the reason, Mr. Whiffin, for changing from the California grader to the grader you have just referred to?

A. Because it was not practical in the sizing of our fruit.

Q. 16. In what respect was it not practical?

A. Because you could not set any independent size of roller.

Q. 17. Is the setting of each size of roller or grade, then, a desirable feature in the grading or sizing of oranges? [751]

A. Absolutely, more so now, because the eastern buyers insist on it.

Q. 18. That feature is particularly desirable in order to keep a uniformity of pack, is it?

A. Certainly.

Q. 19. And how long have you used this Stebler machine with the independent adjustment of each roller? A. This is our fourth season.

(At this point Mr. James W. Stevenson entered the room where these depositions are being taken and at the request of counsel for defendants is directed to retire out of the room and out of the hear-

(Deposition of M. R. Whiffin.)

ing of the testimony of the witness, and did so.)

Q. 20. I believe you stated, Mr. Whiffin, that these independently adjustable rollers of the Stebler machine that you have are rotated by means of belts?

A. Yes, sir.

Mr. ACKER.—The witness did not so state, but we will consider that as a fact.

Q. 21. What is the object, Mr. Whiffin, of using the belts to drive these rollers?

A. So that the revolution of the rollers will make it easier on the fruit. Oranges being a very delicate fruit, every care has to be taken so as not to injure them.

Q. 22. And what would injury of that kind to the orange cause? A. Decay.

Q. 23. Then, if I understand you correctly, in the packing [752] and handling of fruit it is absolutely necessary that every precaution be taken to prevent bruising or injuring the rind of the orange?

A. Certainly.

Q. 24. Have you ever had any experience with this Stebler grader in the use of any of the rollers with the belts off the rollers? A. Yes, sir.

Q. 25. To what extent?

A. At some times the belts will break and then the rollers stop revolving sometimes. Shall I go on and explain?

Q. 26. Go on, explain it in full.

A. Sometimes we do it, sometimes we don't, but the fruit keeps on going just the same.

Q. 27. When you say "the fruit keeps on going

(Deposition of M. R. Whiffin.)

just the same," do you mean that it does not clog in the run-way? A. I have never seen it.

Q. 28. You mean you have never seen it clog?

A. I have never seen it clog.

Q. 28. Have you ever noticed what the action of the fruit in passing by such a roller with the belt off is? A. I have noticed it; yes.

Q. 30. What is it?

A. Often the rope will carry the fruit over the dead roller, and if not, the following oranges will follow one another.

Q. 30. And does the roller remain stationary?
[753]

A. In such cases I have seen it often revolve.

Q. 31. In what direction did it revolve?

A. Outwardly.

Q. 32. That would be the same way as the rollers revolve when the belts are on?

A. In the ordinary way.

Q. 33. As the rollers *ordinary* rotate with the belts on? A. Yes, sir.

Q. 34. Based on your experience, then, would you say that it was practical to use such Stebler grader without the cross belts? A. No, sir.

Q. 35. Why not?

A. Because as I mentioned before, we have to take every care in the handling of fruit and the revolving of that roller makes it easier on the fruit.

Q. 36. Are you familiar with the Parker grader?

A. Not very.

Q. 37. Have you ever seen one in operation?

(Deposition of M. R. Whiffin.)

A. I have seen it operating; yes.

Q. 38. The rollers of that grader are not rotated?

A. No, sir.

Q. 39. I mean by belts?

A. No, sir, stationary.

Q. 40. From your experience can you state whether or not the same danger exists of pinching or bruising the fruit by the rolls in the Parker grader that would be if the rollers in the Stebler grader were not positively [754] driven?

Mr. ACKER.—The question is objected to on the ground that the witness has positively stated that he is not familiar with the Parker device, is not familiar with the character of its working or the working of his machine, and therefore testimony given by the witness is not based on his knowledge, and as leading.

A. I think that it is only fair to say that that was the objection I had in not buying it, just my own idea. I have watched them several times, but I will say right here that I have never seen them pinch an orange.

Q. 41. Do the rolls in the Parker grader remain stationary or do they revolve when the oranges are carried on to them by the belt?

Mr. ACKER.—Same objection.

A. When the orange rests on the roll the roller revolves.

Q. 42. And in what direction? A. Outwardly.

Q. 43. But you do not believe from your experience that a grader is as practical and commercially

(Deposition of M. R. Whiffin.)

utilizable where the rollers are not positively driven as where they are positively driven? A. No, sir.

Q. 44. In other words, that is your personal preference? A. Certainly; yes, sir.

Q. 45. In your investigation of the Parker grader were [755] there any other reasons than the non-driving of the Parker rollers why you did not purchase such machine?

A. My idea was that the sizing of the fruit was not so perfect as the rope and roller.

Q. 46. And why was that, in your opinion?

A. Because the rope traveling faster will revolve the orange and give it its size on every side of the orange.

Q. 47. You have referred to the fact that the Stebler graders which you have are provided with means for adjusting each roller so as to independently adjust each grade or size? A. Yes, sir.

Q. 48. Is that a matter which is often utilized in grading oranges?

A. Depends upon the kind of fruit. In some localities, where the fruit does not run even in size or shape, you may say, it is very often adjusted running different kinds of fruit, Jaffas, Malta Bloods, Valencias, we often had to change.

Q. 49. In considering the purchase of the Parker machines by you, as you have heretofore referred to, did you take into consideration the question of capacity of the Stebler machine and the capacity of the Parker machine at all? A. Yes, sir.

(Deposition of M. R. Whiffin.)

Q. 50. And what did you conclude in regard thereto?

A. I concluded that the Stebler had a larger capacity than the Parker.

Mr. LYON.—You may inquire, Mr. Acker.
[756]

Cross-examination.

(By Mr. ACKER.)

XQ. 1. During any given run of fruit, Mr. Whiffin, how often do you change the grader? Suppose you were grading various oranges for a week or ten days, how often would you change the grader?

A. In our own case, as the fruit is raised in one locality it is fairly evenly shaped—now, for instance, we will take for yesterday's run, we were running Valencias and we changed twice.

XQ. 2. How much fruit did you run yesterday?

A. We ran probably two thousand boxes.

XQ. 3. As long as the fruit is of substantially the same character do you make many adjustments of the graders? A. No, not if the fruit is the same.

XQ. 4. You stated that you had used, prior to the Stebler device, or the device of the patent in suit, which we have been terming the Stebler device, the California grader, and I will ask you to look at the drawing of the patent number 458,422 and state if that is the type of grader you had reference to.

A. That is the one; yes, sir.

XQ. 6. It has five steps on the roller?

A. Some had five and I think they went from three to five, if I remember rightly.

(Deposition of M. R. Whiffin.)

XQ. 7. As I understand, you stated that at times you would notice that a belt had broken, a drive belt, and when your attention was directed to the broken [757] belt, or you observed a broken belt, did you repair it? A. Yes, sir.

XQ. 8. And would do so at once?

A. We wouldn't if we were just at the point of a clean-up, but we would as a rule, would fix it, repair it.

XQ. 9. I believe I understood you to testify that the main objection you had to the Parker devices when you were looking into it was the fact that his rollers were not positively driven rollers?

A. Yes, and it seemed to me a little hard on the fruit.

XQ. 10. What would have been your impression if the Stebler device had been presented to you without any means for positively driving the rolls?

A. I would not have bought it.

XQ. 11. Then, you would consider it an impractical device?

A. Yes, impractical. Yes, I will say impractical.

Mr. ACKER.—That is all, Mr. Lyon.

Redirect Examination.

(By Mr. LYON.)

RDQ. 1. I neglected to ask you, Mr. Whiffin, if you were present at the packing-house at Arlington Heights on Wednesday, June 12th, 1912, and there met Mr. Stebler, Mr. Arthur P. Knight and myself?

A. Yes, sir.

RDQ. 2. At that time you showed us the Stebler

(Deposition of M. R. Whiffin.)

machines, did you not? A. Yes, sir. [758]

RDQ. 3. And at that time you took off one of the belts off of one or more of the rolls to show us the action of the grader in practical use without the belt? A. Yes, sir.

RDQ. 4. And your testimony in regard to the action of the rollers with the belt removed that you have heretofore given, that the fruit would rotate the rollers as it went along, was borne out by this demonstration on that day as well? A. Yes, sir.

RDQ. 5. Would you consider the Parker machine or the Stebler machine the most practical machine without either of them having means for positively rotating the rollers?

A. That is an impossible question to answer, Mr. Lyon, without seeing it and without trying it. They are practically the same thing, one is horizontal, the other perpendicular. Now, if one works horizontally, why won't the other work the same perpendicularly?

RDQ. 6. In other words, then, you see no difference between them without the belts?

A. Only the size, that is all.

RDQ. 7. In size, in what way?

A. Well, the rollers of the Parker are so much smaller.

Mr. LYON.—That is all.

Recross-examination.

(By Mr. ACKER.) [759]

RCQ. 1. Have you ever seen or tried a Strain or Stebler device of the character of the one in suit with

(Deposition of M. R. Whiffin.)

all the drive belts removed? A. No, sir.

RCQ. 2. You made mention of the fact that the rope in the Stebler or Strain device appealed to you in drawing a comparison between such device and the Parker device, and I will ask you to explain a little more definitely just what you meant.

A. With the rope and roller—if I had a model here I could explain it to you much better—but the rope traveling at a certain speed is revolving the orange round and round and the roller is keeping it eased up without injury to the fruit. Yet, when it comes to a certain size or certain bin it has turned through every form of that orange to get its exact size. Do you follow me?

Mr. ACKER.—I follow you.

RCQ. 3. And what was there in that feature that impressed you over the propelling feature of the Parker device?

A. Because it is not revolving as far as I could see.

RCQ. 4. In the Parker device?

A. In the Parker device. It is carried on the small belt to the rollers from the largest part to the smallest part and we do not get the rotation.

Mr. ACKER.—That is all.

Mr. LYON.—That is all. [760]

**[Deposition of James W. Stevenson, for
Complainant.]**

JAMES W. STEVENSON, a witness produced on behalf of complainant, being first duly cautioned and sworn to testify the truth, the whole truth and nothing but the truth, testified as follows, to wit:

(Deposition of James W. Stevenson.)

Direct Examination.

(By Mr. LYON.)

Q. 1. Please state your name, age, residence and occupation.

A. Well, James W. Stevenson; Riverside, California; I am fifty-two years old. I am working at carpenter work at present. I have been working packing-house machinery.

Q. 2. How long, Mr. Stevenson, were you engaged in the packing-house machinery business, either for yourself or others?

A. Well, it has been a little more than six years since I first worked for the California Iron Works.

Q. 3. California Iron Works of Riverside?

A. Yes, sir.

Q. 4. When you first went to work for that concern the partnership was Fred Stebler and Austin

A. Gamble? A. Yes, sir.

Q. 5. And after that Mr. Stebler succeeded to the firm, did he? A. Yes, sir.

Q. 6. And where did you work for them? I mean generally, what localities?

A. At Prenda packing-houses of the Arlington Heights Fruit Company. [761]

Q. 7. And elsewhere?

A. Well, at Victoria Avenue Citrus Association, at Casa Blanca—I don't know the name of the firm—and at Colton I put in some machinery for them.

Q. 8. You were foreman on those jobs?

A. Part of the time I was.

(Deposition of James W. Stevenson.)

Q. 9. What machines was it that you were installing?

A. They were the same machine he makes now with the big belt distributing system.

Q. 10. Fruit-grading machines? A. Yes.

Q. 11. How was the run-way in those machines formed?

A. Well, it was between a rope and a set of rollers, set of adjustable rollers.

Q. 12. By "adjustable rollers," what do you mean, Mr. Stevenson?

A. Well, that was to move the rollers either way to make the sizes larger or smaller.

Q. 13. Was it necessary to move more than one roller at a time or could each roller be separately moved toward and from the belt?

Mr. ACKER.—The question is objected to as leading.

A. Well, they could be adjusted as it was necessary to make the size right, as I understood it.

Q. 14. Well, what I meant was whether in the machines which you installed for the California Iron Works, was the mechanical construction such as to permit the adjustment of each roller separately or would such mechanical construction require the adjustment of more [762] than one roller at the same time?

A. You could adjust each roller separately.

Q. 15. Were the rollers positively driven?

Mr. ACKER.—The question is objected to as leading.

(Deposition of James W. Stevenson.)

A. Yes, sir.

Q. 16. By what means?

A. Well, there was a small shaft and a small separate belt from the shaft to each roll.

Q. 17. And in what direction were the rollers rotated?

A. The rollers rotated largely by gravity of the fruit.

Q. 18. That would be outwardly from the belt?

A. Yes, sir; outwardly from the belt.

Q. 19. Did you ever see any of these machines in commercial operation?

A. Oh, yes, a good many of them.

Q. 20. Do you know anything as to the requisite or nonrequirement of individually adjusting the several sizes in grading oranges?

A. I don't know that I quite get your question.

Q. 21. The question is directed as to whether you know whether there is or is not, in the commercial sizing or grading of oranges, any necessity or advantage in having each sizing aperture of the grader separately adjustable.

A. Yes, it is necessary to have them separately adjustable, I think.

Q. 22. Why?

A. Well, sometimes, of course, a certain size runs a [763] little too large or a little too small and oftentimes you find it necessary to change one size to make it pack right.

Q. 23. Do you know whether with the graders of the type that you put in for the California Iron

(Deposition of James W. Stevenson.)

Works such separate adjustment was used by the users of such machines?

A. Yes, it was used by their machine altogether.

Q. 24. Frequently, or infrequently?

A. Altogether.

Q. 25. You mean by "altogether," that it was often necessary to make such adjustment?

Mr. ACKER.—The question is objected to as leading.

A. Oh, it is quite often necessary to change the adjustment, because fruit sometimes is more round than others and the difference in the shape of the fruit sometimes makes a little difference in the way it packs up.

Q. 26. Did you ever see one of these California graders of the construction which you have referred to as having installed, used without the drive belts on the rollers?

Mr. ACKER.—I will ask counsel to explain what is meant by the term "California grader."

Mr. LYON.—Put in the California Iron Works graders.

Mr. ACKER.—I will ask counsel to explain whether he means by the term "California Iron Works graders," the grader of the patent in suit?

Mr. LYON.—I do, and it is understood that was what the witness testified he has put in for the Prenda and [764] other packing-houses.

Q. 27. Now, the question is, did you ever see any of these machines used without the use of the belts for driving the individual rollers?

(Deposition of James W. Stevenson.)

A. I never did but once, and that was when one of the little belts was broke.

Q. 28. Was the machine in use at that time?

A. The machine was in use; yes.

Q. 29. And how long did the belt remain broken?

A. Oh, probably half a day, until the next day. I had to get a new belt you know. I fixed it the next morning.

Q. 30. Do you know whether they shut down the machine or continued to operate it that day?

A. No, they did not shut it down.

Q. 31. What was the result in the grading?

A. I don't know that there was any difference. Of course, the fruit would travel slower over that roller than it would over the others.

Q. 32. Would the roller remain stationary?

A. It would turn once in awhile.

Q. 33. What roller was that in the machine?

A. I think about middle way. Possibly nearest the large sizes.

Q. 34. Was the fruit at that time running more to large or small sizes?

A. Well, I couldn't say as to that, but about the usual size.

Q. 35. You are familiar with the Parker grader like [765] those in the Riverside Heights Orange Growers' Association's packing-house at Riverside?

A. I saw those, yes.

Q. 36. Have you ever watched the rollers in that machine when they were grading oranges?

A. Yes, sir.

(Deposition of James W. Stevenson.)

Q. 37. Did the rollers in that machine remain stationary?

A. Oh, no, not when the fruit was running on them they didn't.

Q. 38. What was their action when the fruit was running on them?

A. Why, they would turn as the fruit went by.

Q. 39. In what direction?

A. They would turn the same direction, against the fruit.

Q. 40. You mean the same direction as the California Iron Works grader? A. Yes, sir.

Q. 41. Did you ever manufacture any graders of your own, Mr. Stevenson? A. I did.

Q. 42. Did you ever build any machine in which a belt was used as the longitudinally moving member for carrying the fruit along and rollers or rotating parts were not used on the opposite side of the runway but a stationary or nonmoving member used in place thereof?

A. Yes, that is the way I first made my machine. While the grade-way was adjustable, it did not rotate, it [766] was stationary—just a stationary rod.

Q. 43. I show you a photograph and ask you what this is a photograph of?

A. That is a photograph of the first machine I made.

Q. 44. This truly represents that machine?

A. That is just as it was, exactly.

Q. 45. The grading rods that you have just re-

(Deposition of James W. Stevenson.)

ferred to are located where?

A. Just near the outer edge of the belt.

Q. 46. And that was adjustable substantially vertically? A. Yes.

Q. 47. But it did not rotate or move otherwise?

A. No.

Q. 48. What was the result of the use of this particular machine, Mr. Stevenson?

A. Well, it would pinch the fruit; that is to say, when the fruit would roll against that stationary rod it would try to go under before it came to a place where there was quite room enough, and the consequence was that it would push the belt into the center and sometimes would force the belt high up in the center until the fruit would get off the run-way.

Q. 49. Where was this first machine installed?

A. In the Worthley and Strong packing-house at Riverside.

Q. 50. Was it accepted in the condition and construction shown in this photograph?

A. No, that was not accepted.

Q. 51. Was it afterwards accepted? [767]

A. Not until I put in a revolving shaft in there in place of the grade rod—stationary.

Q. 52. And in what direction did the shaft revolve?

A. The shaft revolved against the fruit, the same as the rollers in the other machines.

Q. 53. And what effect did the change from this nonrotating or nonmoving grading rod to the rotating rod make in the machine?

(Deposition of James W. Stevenson.)

A. That made a satisfactory machine, and they paid me for it.

Q. 54. Are you acquainted with George D. Parker, of Riverside, California, who is now present in the room? A. I am.

Q. 55. While you were working on this first machine did you have any conversation with Mr. Parker relative thereto? A. Yes, sir.

Q. 56. What was that conversation?

A. Well, I don't know that I can recall in any words, only that I was at his shop and I at that time inquired for Mr. Hewitt, and Parker answered me that he had bought that plant and he was working on an orange grader at the same time, and I told him about this machine of mine (referring to Complainant's Exhibit "Stevenson's Machine"). That is the way I had it at the time.

Q. 57. Well, after that conversation did you show him this machine? A. Yes, sir. [768]

Q. 58. And was there any conversation with regard to the stationary grading rods at that time?

A. Why, Mr. Parker tried to convince me that it would pinch fruit, and I did not believe that it would. I thought it was all right.

Q. 59. Why did he say that it would pinch fruit?

A. I don't know that he gave me the reason why. I don't think he did.

Q. 60. Was there any conversation with regard to using anything else instead of the stationary grading rods?

Mr. ACKER.—The question is objected to as lead-

(Deposition of James W. Stevenson.)

ing in the extreme, and I suggest that the witness be instructed to tell the result of the conversation without its being dragged out of him piecemeal.

Q. 61. In view of the objection, I will ask you, Mr. Stevenson, to give us all of the conversation that you remember.

A. Well, we took a box of fruit and run through the machine and I could not give the conversation, as I know of, but we talked about it and he said he thought it would pinch fruit, and I think he suggested putting a roller in place of the stationary rod.

Q. 62. Did you make any reply to such suggestion?

Mr. ACKER.—Same objection.

A. I think I said that I did not see how we could put a roller in there without interfering with Stebler's California Iron Works patent.

Q. 63. At that time, or thereafter, did you have any business dealings with Mr. Parker in regard to that [769] sizer?

A. Well, we talked at the time about he manufacturing these machines provided we got it completed and he said that he thought he could help me out on it.

Q. 64. Was that suggestion ever followed out in any manner?

A. Well, I told him about what I was willing to do, that I was willing to work for him for wages and he might pay me about twenty-five per cent of the profit as royalty on the machine, and that seemed satisfactory with him and me too, but I didn't get that

(Deposition of James W. Stevenson.)

machine completed, you know, and there was considerable delay, and I went to work on a little different line and he went to work on a different line so we did not have any more dealings together on the grader.

Q. 65. You say that at the time you went to this shop and inquired for Mr. Hewitt that Mr. Parker told you he had bought the shop, that he, Mr. Parker, was working on a grader? A. Yes, sir.

Q. 66. Do you know what kind of a grader it was?

A. Well, I don't know. It was a set of rolls; the rollers traveled in an endless chain in some way or other and the rolls came wider apart at each size and there was cross-belts that would take each size away as they dropped through.

Q. 67. Was this conversation prior to his having installed, so far as you know, any of the graders of the type that were installed in the packing-house of the [770] Riverside Heights Orange Growers' Association?

A. There wasn't any installed at that time, for there was none anywhere that I know of.

Mr. LYON.—You may inquire, Mr. Acker.

Cross-examination.

(By Mr. ACKER.)

XQ. 1. When did you work for the California Iron Works, Mr. Stevenson?

A. Well, as near as I can tell it was a little over six years ago I would say. It would be six years last March.

XQ. 2. That would be about 1906?

(Deposition of James W. Stevenson.)

A. Along about 1906. It would be 1905, possibly.

XQ. 3. Your familiarity with the use of grading or sizing machines dates from your experience with the California Iron Works?

A. That was my first experience. I hardly had ever seen an orange sizer before.

XQ. 4. And was it from your experience with the California Iron Works that you date your knowledge as to the value of the rotation of the roll in connection with the sizer?

A. No, I don't, not then. I didn't at the time see the necessity of that roll then. Of course, that was my first experience.

XQ. 5. When does your knowledge as to the value of the rotating of the rolls date? [771]

A. Oh, I never got the real value of that idea until after I tried this, you see, this stationary rod. (Referring to Complainant's Exhibit "Stevenson Machine.") I learned from that that it was necessary to have the rotation there.

XQ. 6. And when does that date from?

A. That, let me see, that has been, this makes the third year that has been in use.

XQ. 7. That would be 1908 about, approximately?

A. Yes.

XQ. 8. You testified that in connection with the machine installed for the Arlington Heights Fruit Company that you noticed at one time that a drive belt broke, that is one of the belts for rotating the rolls?

A. No, it was not at that place. It was at the

(Deposition of James W. Stevenson.)

Victoria Avenue at Casa Blanca.

XQ. 9. That was one of the machines that was installed for the California Iron Works?

A. Yes, it was one of their machines.

XQ. 10. And when was that?

A. That was about a year later.

XQ. 11. One year later? A. Yes, five years ago.

XQ. 12. About 1906? A. 1906, yes.

XQ. 13. I understood from your testimony, you did not become familiar with the value, if any, of the rotation of the rolls until after you tried out the device represented by this photograph exhibit? (Referring [772] to Complainant's Exhibit "Photo of Stevenson Machine.")

A. When that circumstance happened I thought I had learned something, that it was not necessary to turn the rollers.

XQ. 14. Then, in 1906, the value of imparting rotation to the rolls was not apparent to you, was it?

A. Well, I don't know whether I understand you correctly or not.

XQ. 15. You said it was not until after you tried using the device, until after you tried using the machine of the photograph, Complainant's Exhibit "Stevenson Machine," that you became familiar with the value of the rotation of the rollers?

A. Yes.

XQ. 16. And prior to that you did not appreciate the value of rotating the rollers?

A. No, sir, I thought it was not necessary.

XQ. 17. When was this photograph taken, do you

(Deposition of James W. Stevenson.)

know, of the Complainant's Exhibit "Stevenson Machine"?

A. This photograph here was taken, let's see, it was taken four years ago.

XQ. 18. Four years ago? That would be about 1908? A. No, 1908, I think.

XQ. 19. Did you give this photograph to Mr. Stebler, the complainant in the present action?

A. Yes.

XQ. 20. How long after the machine was built was the photograph taken? [773]

A. Oh, I couldn't say, possibly a couple of weeks.

XQ. 21. Still during the year 1907?

A. Yes, it was very close to the time it was built.

XQ. 22. Do you know when Mr. Parker purchased the iron works of which he is now the proprietor at the present time, the Parker Machine Works?

A. I couldn't give any date; no. The way I happened to think of it was the material I needed in making this machine I bought from Mr. Hewitt, you see. That was before Parker went there. Then when I called for Mr. Hewitt after I was this near, Mr. Parker answered me. I couldn't name any dates. I couldn't remember.

XQ. 23. Mr. Hewitt was the party from whom Mr. Parker purchased the iron works?

A. Yes, he had control there.

XQ. 24. That is Mr. Hewitt had control?

A. Yes.

XQ. 25. Don't you know as a matter of fact that

(Deposition of James W. Stevenson.)

Mr. Parker did not purchase from Mr. Hewitt until the year 1909? A. I don't know about that.

XQ. 26. You have no knowledge one way or the other on that? A. No.

XQ. 27. Under what name was the shop conducted prior to the purchase of the same by Mr. Parker?

A. It was the Riverside Foundry and Machine Works.

XQ. 28. Do you know when its name was changed to Parker Machine Works? [774]

A. No, I don't.

XQ. 29. Did you ever apply for a patent on the device represented by Complainant's Exhibit "Stevenson Machine"?

A. That is the machine, yes; that is that machine that is patented, just as it is.

XQ. 30. You procured a patent on that?

A. Yes.

XQ. 31. In this machine I understand that the member of the run-way opposing the traveling member consists of a series of adjustable nonrotating steps or members? A. Yes.

XQ. 32. And how are these members arranged?

A. They are arranged a good deal in the same position that the rollers are and they are adjustable a good deal the same way.

XQ. 33. Are they continuous throughout the length of the machine?

A. Just one section, one rod for each section and each rod is adjustable just the same as the roller is.

(Deposition of James W. Stevenson.)

XQ. 34. How close are these rods together?

A. You mean between? They are nearly four feet long.

XQ. 35. And how close are they together?

A. The ends come right close together, but don't touch, possibly one-eighth of an inch, just enough for the bearing surfaces. There is a bearing between the two. They don't conflict with one another in changing the sizes for adjustment.

XQ. 36. There is no intervening space between them? A. No, they come right together. [775]

XQ. 37. What do you mean by the grade rods being like the rollers?

A. The arrangement is the same.

XQ. 38. And how about the end-wise arrangement or end-to-end arrangement?

A. They are not adjustable endwise.

XQ. 39. Are they adjustable toward and from the traveling member? A. Yes, sir.

XQ. 40. Practically up and down?

A. Yes, sir.

XQ. 41. And how does the end-wise arrangement of these nonrotating steps compare with the arrangement of the rollers that you testified were driven by the belts?

A. Of course, there is a little more space then; any one pair. There is a double journal, that is, at each end of each roll.

XQ. 42. Otherwise the same, substantially the same arrangement?

(Deposition of James W. Stevenson.)

A. Well, let's see. I don't quite catch you, I guess.

XQ. 43. What I mean is, in this device, Complainant's Exhibit "Stevenson's Machine," as I understand it, the fruit passes from one nonrotating rod right onto another? A. Yes.

XQ. 44. And does the same hold good as to the machines with the adjustable rollers? Does it go from one roll onto another? [776]

A. In this machine I put a little telescope guide in there between the two different sizes. I didn't in this machine. That is a mistake. After I put the roll in the shaft, then I put in a wider belt and put in the telescope guides there, you know, so that I could carry the fruit.

XQ. 45. I am afraid we are at loggerheads. I am inclined to believe that you understand me to mean by the roller, the machine you made after this one. By the roller machine I referred to the machines which you set up for the California Iron Works. How were the rollers in that machine arranged?

A. Are you talking about this machine, "Stevenson Machine"?

XQ. 46. No. How were the rollers in the machine which was installed for the California Iron Works arranged?

A. Well, they were arranged along in the same position as I had this grade rod.

XQ. 47. In the same position as the rod in Complainant's Exhibit "Stevenson Machine"?

(Deposition of James W. Stevenson.)

A. Yes; only they did not extend all the way to the rear end of the machine. He had it also built as a distributing system that carried the fruit to the rear end.

XQ. 48. Up to the point of the distributing system they were arranged the same as the rods in your first machine? A. Yes.

XQ. 49. What change did you make in the machine of [777] Complainant's Exhibit "Stevenson Machine," after you found that the fixed rods or steps tended to pinch the fruit. I say, what change did you make?

A. Well, in the belt carrier underneath, I made that in sections, and I made a difference, that is the depth in each section, of about an eighth of an inch or the difference of one size in the belt underneath. That enabled me to use a straight shaft from there instead of an adjustable set of grade rods or rollers.

XQ. 50. And how did that work?

A. First rate, gave satisfaction.

XQ. 51. Is it still in use?

A. It is in use, yes.

XQ. 52. Did you have any rotating members on that shaft? A. The shaft itself rotated.

XQ. 53. And did it carry inner members of tubular sections?

A. I can't hardly understand what you mean.

XQ. 54. Was the shaft of uniform diameter throughout its length?

A. Throughout, yes, and the bearings were placed with the shaft so that it was a smooth surface so

(Deposition of James W. Stevenson.)

far as the shaft was concerned. It was a smooth surface all right.

XQ. 55. And how did you make changes as to different sizes of fruit?

A. That was by raising and lowering the shaft.

XQ. 56. Bodily? [778] A. Yes.

XQ. 57. And when was that device designed and built by you?

A. It has been in use three seasons.

XQ. 58. Starting would you say with 1908?

A. 1908, yes.

XQ. 59. Did you apply for a patent on that device? A. No.

XQ. 60. Are you still the owner of the patent that was granted on Complainant's Exhibit, "Stevenson Machine"? A. No, sir, I sold that to Mr. Stebler.

XQ. 61. Mr. Stebler present in the room and the proprietor of the California Iron Works?

A. Yes.

XQ. 62. When did you first install any of the machines of the changed type that you changed from the Complainant's Exhibit "Stevenson Machine"?

A. I installed them—well, in fact, I had this one Stevenson machine installed, and I just merely kept on rebuilding it and changing it until I made the new machine out of it and it has been in use three seasons.

XQ. 63. But in 1909 was the first season that you put it into use?

A. 1909? No, it would be 1908 to be ready for last season.

(Deposition of James W. Stevenson.)

XQ. 64. I don't know that I understand quite how you gauge your seasons.

A. Yes, 1909. This season began in 1911. [779]

Mr. LYON.—This is 1912, Mr. Stevenson.

WITNESS.—I am getting mixed on dates, I guess. Of course, I am, as Mr. Lyon says this is 1912.

XQ. 65. And when you say three seasons ago do you mean 1909?

A. That would be 1909, yes, because this season began in 1911, you know. I expect I get dates wrong because I am the poorest hand in the world to remember dates.

XQ. 66. When did you hold the conversation with Mr. Parker that you have testified to in your direct examination?

A. Let me see. I had this machine in use one year and the other three years. Oh, it has been five years ago.

XQ. 67. That would be in 1907? A. 1907.

XQ. 68. Do you think you held this conversation with Mr. Parker prior to his buying out the former proprietor of the Parker Machine Works?

Mr. LYON.—Objected to as indefinite and uncertain to fix a date, inasmuch as the witness has testified that he has no personal knowledge whether Mr. Parker bought out the former proprietor, or when.

A. I don't think so, because the first conversation I had with him I inquired for Mr. Hewitt and he answered that he had bought out that plant.

XQ. 69. You stated that in making a test of the

(Deposition of James W. Stevenson.)

machine illustrated in Complainant's Exhibit "Stevenson Machine," [780] that the fruit pinched and tended to lift the belt up?

A. That is, it pushed up from both sides into the center.

XQ. 70. And some of it escaped?

A. Yes, it raised the center of the belt until the fruit would get clear off.

XQ. 71. Did you ever try a machine with adjustable steps and used in that machine a rope for propelling the fruit through the grade-way?

A. No, I never tried that with a rope.

XQ. 72. You testified on direct examination that the independently adjustable rollers was a matter of importance in the grading of fruit. When did you acquire such knowledge?

A. Did I say that the independent adjustment of the rolls was necessary?

XQ. 73. I don't know whether you said it was necessary or not. I understood you to testify in reply to a direct question that you considered it a feature of importance. Maybe I am mistaken in your testimony on that point.

A. I think you are, because I don't think I said that, because in my machine I could have made the belt adjustable instead of the roller, instead of the shaft, I could do that.

XQ. 74. Then, do I understand you correctly as stating that you do not consider the individual adjustment of the rolls a matter of importance?

A. Well, it is important, but not probably abso-

(Deposition of James W. Stevenson.)

lutely necessary. [781]

XQ. 75. Will you please explain a little more fully just what you mean on that point? I don't quite understand you.

A. Well, you see, the belt or rope could be adjusted instead of the rolls if they wanted to.

XQ. 76. And that would accomplish the same purpose? A. I think so.

XQ. 77. And would produce just as good a machine?

A. It probably would not be as satisfactory.

XQ. 78. Why not?

A. Well, it is handier to adjust the rollers than *it* the belt or rope.

XQ. 79. Does your knowledge of the individual adjustment of the rollers date from your installation of the machine for the Victoria Packing-house?

A. The individual adjustment of the rollers, you say? No, it was from my first experience at the Prenda packing-house.

XQ. 80. And when was that?

A. That was six years ago.

XQ. 81. Have you ever had charge of a packing-house, Mr. Stevenson?

A. Have charge of the running of a packing-house?

XQ. 82. Yes, sir. A. No.

XQ. 83. Have you ever had complete control of the running of the grading machines or sizing machines of the Stebler or Strain type, which were in-

(Deposition of James W. Stevenson.)

stalled in the packing-houses to which you have referred? [782]

A. Nothing more than to start them up and get them in running order.

XQ. 84. Have you ever had complete control of the running of any machine in any packing-house, of the construction of the patent in suit?

A. Only just to get them started so that the packing-house people could go ahead with them.

XQ. 85. Then you would leave them alone?

A. Yes.

XQ. 86. You would have no further care of it?

A. No.

XQ. 87. Are you familiar with the patent in suit or do you know what machine is involved in the patent in suit?

A. I am familiar with the machine; yes.

XQ. 88. Please describe in detail the construction of the rotatable member of the run-way in such machine.

A. Well, they have a rope, there are two ropes down the center possibly three or four inches apart, and on the other side there is a set of adjustable rolls in a horizontal line on either side of the rope that rotates against the fruit, and as the fruit comes on the smaller sizes drop through and each roll is set further back from the rope, enough to make the difference in either size, and so on, until each size gets graded, until the last size comes out.

XQ. 89. Where would the fruit passed over the first roll of the series of rolls go to?

(Deposition of James W. Stevenson.)

A. If it was small enough to go through the first roller, [783] it would drop into the first bin.

XQ. 90. What position does the second roller occupy from the first roller?

A. It is further apart.

XQ. 91. How is it located as to the endwise position?

A. The two rolls come within about three-quarters of an inch of each other.

XQ. 92. And does that hold good as to the arrangement of each roller relative to each other?

A. Yes.

XQ. 93. When the rolls were fixed for the grading of fruit were they what might be termed in a stepped position relative to each other?

A. How is that? Stepped position? Yes.

XQ. 94. And being so stepped it formed a graduated run-way for the fruit? Is that true?

A. Yes.

XQ. 95. What would happen in the grading or sizing of the fruit if the second roll of the series was adjusted to practically the same position relative to the traveling belt as the first roll?

A. Why, you would get the same size in each bin. Not very much in the second bin. You would get most of it in the first.

XQ. 96. Would that cut out one bin, if they were set exactly? In other words, would it cut out one grade of fruit? A. It would cut out one size; yes.

XQ. 97. That would be one grade. When you

(Deposition of James W. Stevenson.)

say "size" [784] that would be one grade, would it not?

A. The grade and the size are two different things. Grade means quality and size means size. It would cut out one size.

XQ. 98. It would cut out one size? A. Yes, sir.

XQ. 98. If the sizer was arranged for nine different sizes of fruit and the rolls were fixed as I have mentioned, you would cut out one size of fruit? Is that correct? A. Yes.

XQ. 100. You stated that during the course of your conversation with Mr. Parker, that you ran a box of fruit through your machine, meaning the machine of the Complainant's Exhibit "Stevenson Machine." In the running of that box of fruit through the machine did you observe any pinching of the fruit?

A. I didn't. I don't think that I said a box of fruit. We just ran fruit through it. I couldn't say whether it was a box or a dozen oranges. We ran some fruit through it. I don't know how much.

XQ. 101. Can you state what led you to dispose of your patent covering the machine of Complainant's Exhibit "Stevenson Machine" to Mr. Stebler?

A. Why, yes. Mr. Stebler came out with another patent that I was apparently infringing on.

XQ. 102. Was that patent you refer to the patent in suit? A. No, it was another patent. [785]

XQ. 103. The patent in suit being the one to which I now direct your attention, Complainant's Exhibit "Reissue Letters Patent in Suit"?

(Deposition of James W. Stevenson.)

A. No, it was not this one.

XQ. 104. Did Mr. Stebler threaten to sue you as an infringer? A. Yes.

XQ. 105. And it was by reason of that fact that you disposed of your patent to him?

A. Yes. I went and got counsel and I decided that I was infringing and I thought it was no use to fight anything when I knew I was wrong.

XQ. 106. That was because you were infringing the patent to which he called your attention?

A. Yes.

XQ. 107. But not the patent in suit? A. No.

XQ. 108. Have you ever invented any other fruit grader other than the one you have testified to?

A. No other fruit sizer, no.

Mr. ACKER.—That is all, Mr. Lyon.

Redirect Examination.

(By Mr. LYON.)

RDQ. 1. When at the Victoria packing-house for this half day's run, this rope and roller grader with the individually adjustable rolls was permitted to continue in operation with one of the belts broken and removed, as you have testified heretofore, did you [786] observe whether the fruit clogged any on the roller where the belt was removed?

Mr. ACKER.—The question is objected to inasmuch as the witness has testified that he did not have control or charge of the running of the fruit through the machine, and did not operate the machine for the sizing of the fruit.

Mr. LYON.—To which objection the reply is made

(Deposition of James W. Stevenson.)

that it must be obvious to anyone that a man being present may observe without having actual control of the machine.

A. I noticed that it would go slower over that roller and sometimes one orange would lie there until another would come against it and then they would both go along together.

RDQ. 2. Did the oranges pile up on that roller?

A. Oh, no.

RDQ. 3. What was your purpose in being out there at that time, Mr. Stevenson?

A. I was putting in a new grader there, a new sizer.

RDQ. 4. I notice you stated in your cross-examination that your recollection as to dates was not good. Are we to understand from that that your *recollection vague* or poor as to the exact time when you had this conversation with Mr. Parker to which you have referred?

A. Well, to give the time of year or even the year and not make a mistake that far back.

RDQ. 5. Is your recollection clear as to the circumstances? [787]

A. Oh, yes. I don't forget circumstances like I do dates.

RDQ. 6. I show you Defendant's Exhibit "Hutchins Patent, being letters patent number 456,092, and ask you if you understand the machine therein shown and described?

Mr. ACKER.—Objected to the question as incompetent, irrelevant and immaterial and on the further

(Deposition of James W. Stevenson.)

ground that it is not proper redirect examination, and on the further ground that there has not been the proper foundation laid for this witness to testify.

Mr. LYON.—If counsel insists on his objection that it is not redirect examination, if that be his objection, we will ask counsel to now conduct any recross-examination which he may desire and we will then recall the witness for further direct examination.

Mr. ACKER.—I have no cross-questions to ask at this time. I have finished my cross-examination of the witness as based on the direct examination.

Mr. LYON.—And on the redirect examination so far as it has gone.

Mr. ACKER.—There has been no redirect examination up to the present time on which I wish to cross-examine the witness.

Mr. LYON.—The witness is then recalled for further direct examination:

JAMES W. STEVENSON, a witness produced on behalf of complainant, being recalled for further examination, [788] testified as follows, to wit:

Direct Examination.

(By Mr. LYON.)

Q. 1. I hand you Defendant's Exhibit "Hutchins Patent," being letters patent number 456,092. Mr. Stevenson, you understand the machine illustrated and described in this patent? A. I think I do.

Q. 2. Based upon your experience in building and your observation of the operation of orange-sizing machines, state whether or not such a machine, as

(Deposition of James W. Stevenson.)

described in said letters patent, would be practical in the sizing of oranges?

A. I don't think it would.

Q. 3. Why not?

A. Well, in the first place, to get the number of sizes there is in oranges, the machine would go so high that it would not be practical to use, too much drop.

Q. 4. What do you mean by "too much drop"?

A. Well, every different size drops down to a lower set of rolls and belt and the distance would be so great that it would not be possible. I don't think it would. I think that has been a sizing machine for apples. They used to make about three different sizes of apples as they barrelled them up in Michigan and Indiana.

Mr. LYON.—We move to strike from the record and exclude from consideration all that portion of the [789] answer following the words "I think," as not responsive to the question and not—

Mr. ACKER.—We object to the exclusion by counsel for complainant of any portion of any answer given by his own witness to his own question.

Q. 5. Did you ever see a machine like that shown in the Defendant's Exhibit "Hutchins Patent"?

A. No, I never did.

Q. 6. Then you have no knowledge as to whether such a machine was ever used or not? A. No, sir.

Mr. LYON.—We renew the motion to exclude.

Mr. LYON.—That is all.

(Deposition of James W. Stevenson.)

Cross-examination.

(By Mr. ACKER.)

XQ. 1. Why do you say that you believe the machine of the Hutchins patent to be a machine for the grading of apples?

A. Because I have seen them. That is, I have not seen the machine, but we could buy apples by the barrel in three different sizes. We could buy the medium or the small or the large size when we would buy a barrel at a time for domestic use.

XQ. 2. How are the grading members of the device of the Hutchins patent arranged?

A. It is apparently between an inclined belt and a roller.

XQ. 3. Is that all the answer? [790]

A. That is all.

XQ. 4. Have you carefully studied the Hutchins patent? A. Not very much.

XQ. 5. What has been the extent of your study of said patent?

A. Oh, I looked it over possibly for an hour or such a matter.

XQ. 6. Have you read the specifications all through? A. Yes.

XQ. 7. And you understand every part of it and the construction?

A. I wouldn't say that I do perfectly, no.

XQ. 8. And your knowledge of the orange industry dates from what year?

A. Of the orange machines, you mean?

XQ. 9. Yes.

(Deposition of James W. Stevenson.)

A. From the time I was at the Prenda packing-house, let me see, that was about '95, the latter part of '95. No, it was not '95, it was 1905.

XQ. 10. 1905?

A. Yes. A little more than six years ago.

XQ. 11. Have you examined *the* read the letters patent in suit? A. No.

XQ. 12. Is it your understanding that the letters patent in suit are confined solely to a machine for the sizing of oranges?

Mr. LYON.—Objected to as incompetent, not cross-examination, the witness not having been interrogated at all [791] as to the letters patent in suit and no foundation laid for any testimony by this witness as to what the patent in suit shows or covers, and further, on the ground that any understanding that this witness may have of said letters patent is incompetent, the question being for the Court to determine and not the witness.

A. I couldn't say about that.

XQ. 13. In connection with the Prenda packing-house, what were your duties?

A. To set up the new machine.

XQ. 14. That is the machine of the California Iron Works?

A. The sizing machine, yes, the grader. We call them graders but really they are sizing machines.

XQ. 15. And is that packing-house where you noticed the sizer in use with one of the belts broken for awhile?

(Deposition of James W. Stevenson.)

A. No, that was at Casa Blanca, Victoria Avenue Association.

XQ. 16. With the belt broken? You mean one of the little belts for driving the grade roller?

A. The little belt; yes.

XQ. 17. Was the carrying belt or the belt for propelling the fruit through the run-way in operation during that time?

A. Yes, the rope belt was running; yes.

XQ. 18. Does the Hutchins patent number 456,092 disclose a grader or sizer having independently adjustable and individually adjustable grading rolls?
[792]

A. Why, I couldn't state the adjustment of that machine, but I think they do.

XQ. 19. Does the Hutchins patent illustrate a rope and roller sizer or grader?

A. The Hutchins? No, that is a belt and roller.

XQ. 20. What distinction do you make between a belt and roller grader and a rope and roller grader?

A. I don't see any difference, only one is the round belt and the other is a flat one.

XQ. 21. Then, for all intents and purposes the Hutchins device may be considered as disclosing a rope and roller grader?

A. You couldn't call a rope and a flat belt hardly the same thing.

XQ. 22. Then you would not consider—

A. (Interrupting.) One is a round belt and the other is a flat belt. There is, of course, a good deal of difference between a flat belt, and a round belt.

(Deposition of James W. Stevenson.)

One is a rope and the other a belt.

XQ. 23. What difference in function exists between a rope belt and a flat belt?

A. Well, a rope belt running in a round track is more frequently in a certain position than a flat belt would be.

XQ. 24. Would you consider one to be the equivalent of the other? A. They do the same work.

XQ. 25. And in substantially the same way?

A. Yes, in substantially the same way, I guess.

[793]

Mr. ACKER.—That is all.

Redirect Examination.

(By Mr. LYON.)

RDQ. 1. Mr. Stevenson, in your first machine, as exemplified in Complainant's Exhibit "Stevenson Machine," how was the belt part of the machine constructed? A. The belt part?

RDQ. 2. Yes.

A. Well, the belt carries it in an inclined shape, that is high in the center and low on the side.

RDQ. 3. At the apex of the incline, what did you have?

A. Had a groove and a chain attached to the belt underneath, the chain running in the groove.

RDQ. 4. What was the object of the chain and the groove?

A. Well, I had two objects in view for it: to keep the belt in position, in the right position on the apex, as you call it, and also to make a positive drive so

(Deposition of James W. Stevenson.)

that the belt couldn't slip.

RDQ. 5. How did the chain and groove keep the belt in position?

A. Well, the chain running in the groove and the belt riveted to the chain, would keep it on a center, you know.

RDQ. 6. What was the necessity of such a means for keeping it in position?

A. Well, of course, if it was on an incline that way, [794] if there was nothing to hold it, it would probably work off to one side or the other. Had to have something to keep it in position, on the center.

RDQ. 7. Then, the groove formed a guide for holding the chain in position?

A. Formed a guide for the chain and the chain held the belt.

RDQ. 8. You referred to the Parker machines that are in the Riverside Orange Growers' Association's packing-house. Are these Parker machines provided with the chain and groove at the apex in this same way that we have just referred to?

A. Yes, except that he uses two belts and attached the two edges to the chain, where I only used one.

RDQ. 9. And at the apex there is a groove in which the chain runs? A. Yes.

Mr. LYON.—That is all.

Recross-examination.

(By Mr. ACKER.)

RCQ. 1. How is the belt, or rather the propelling belt, for the fruit in the Hutchins device, patent

(Deposition of James W. Stevenson.)

456,092, arranged, situated and carried?

A. That is the same as I got here, isn't it? (Referring to Defendant's Exhibit "Hutchins Patent.")

Mr. ACKER.—Oh, you have one there.

A. I don't know that I have been able to see what [795] holds that belt in position.

RCQ. 2. Do you mean by that that your study and examination of the patent has not been sufficient to enable you to state?

A. No, I have not studied it thoroughly.

RCQ. 3. Were you familiar with the device of the patent in suit when you designed your machine, Complainant's Exhibit "Stevenson Machine"?

Mr. LYON.—Objected to as not cross-examination. The witness has not been examined with relation to the patent in suit, and this objection will be understood as taken to all questions asked the witness in regard to the patent in suit and notice given to counsel for defendants that by examining the witness with regard to the patent in suit, he is thereby making the witness his own.

Mr. ACKER.—We will leave it for the Court to determine whether the question is properly put to the witness or not in view of the character of the so-called redirect examination of this witness.

A. I never studied that patent at all, just the machine.

RCQ. 4. You understood the machine?

A. I understood the machine but not the patent.

RCQ. 5. You understood the machine to be a patented device?

(Deposition of James W. Stevenson.)

A. Oh, yes, I understood it was patented.

RCQ. 6. Were you familiar with the fact that in that machine the propelling rope travelled within a groove [796] or a nonmovable agent?

A. Yes.

RCQ. 7. Was it your aim in designing your machine to keep as clear away from the patented machine as you could? A. Yes.

RCQ. 8. Did you consider when you placed a drive chain in the groove at the apex of the nonmovable guide and united to that chain your propelling belt for the fruit that you were making the same form of a drive device and the seating for the drive device as in the patent in suit?

A. I didn't think anything about that; no.

RCQ. 9. Did you consider it to be the same form of a drive means?

Mr. LYON.—Objected to on the ground that the witness has already stated that he did not consider the question at all.

A. No, I never thought anything about it at all.

RCQ. 10. And after you got the machine assembled and in working order, did you consider your form of device to be the same as the form of device in the chain drive as the machine of the patent in suit?

Mr. LYON.—Objected to as not cross-examination, the witness not having been interrogated at all as to the patent in suit, and on the further ground that it is incompetent, for the reason that the witness has testified that he has never seen the patent in suit

(Deposition of James W. Stevenson.)

and is not familiar therewith. [797]

A. I just supposed that I was altogether clear of that.

RCQ. 11. And in designing your machine it was your endeavor to provide a different form of drive and arrangement of drive to that of the machine which you had installed for the California Iron Works as you have testified to, is that correct?

A. I was trying to get everything different and original and clear of it or any other.

RCQ. 12. And you considered your arrangement of the drive chain propeller and belt to be a different form, did you not? A. Yes, I did.

Mr. ACKER.—That is all.

Re-redirect Examination.

(By Mr. LYON.)

RRDQ. 1. You were subpoenaed to testify in this case and subpoena served on you, were you not?

A. Yes.

Re-recross-examination.

(By Mr. ACKER.)

RRCQ. 1. Then, Mr. Stevenson, did you object to giving testimony in this suit? A. Oh, no.

RRCQ. 2. Did Mr. Stebler ask you whether you would testify in this suit?

A. Why, he asked me some questions, yes. [798]

RRCQ. 3. What were the character of the questions he asked you, Mr. Stevenson?

A. Well, let me see. He asked me about when I first built this grader (referring to Complainant's Exhibit "Stevenson Machine"), and he asked me

(Deposition of James W. Stevenson.)

whether I had ever shown it to Mr. Parker or not and when and where.

RRCQ. 4. And did he ask you whether you would appear and testify in his behalf? A. No.

RRCQ. 5. Was it necessary to serve a subpoena on you to get you to testify in this case?

A. He did say that he might have to take me to Los Angeles.

RRCQ. 6. You were willing to and would have appeared voluntarily, would you not?

A. I don't think I would because I had business at home.

RRCQ. 7. Other than having other business to attend to of your own you would have been willing to come and testify in this suit?

A. Oh, I had other business here to-day.

RRCQ. 8. And you would have been perfectly willing to have appeared here to-day without a subpoena?

A. Yes. I would have had to come here sometime, so that it did not make any difference.

RRCQ. 9. In other words, Mr. Stevenson, all I am trying to ascertain is that it was not necessary for Mr. Stebler to exercise the authority of the Court to get you to testify. *You would have testified without*

— [799]

* * * * *

[Complainant's Exhibit "Switzer Letter."]

F. A. Powell, President.
R. H. Maclay, Vice-President.

G. W. Switzer, Secretary.
C. D. Hubbard, Representative.
R. P. Waite,
H. P. Canby,
Executive Committee.

FERNANDO FRUIT GROWERS' ASSOCIA-
TION.

(Cut)

(Cut)

San Fernando, Cal., Oct. 4th, 1911. 191—

H. C. Harding, Manager.

Mr. Stebler,

Riverside, Cal.

Dear Sir:—

We are desirous of installing one of the Stebler sizers in our packing house. We have been using one of the New Parker sizers in our house but find that it will not handle the amount of fruit that a Stebler sizer will handle and, as our output is increasing steadily each year, we must be equipped with facilities for handling our fruit quickly, and wish therefore to replace our Parker sizer with one of your rope and roller style.

Kindly give us your best terms on one of these sizers, without the bins, and oblige.

Very truly yours,

FERNANDO FRUIT GROWERS ASS'N.

G. W. SWITZER, Secy.

(Endorsed.) [806]

[Complainant's Exhibit "Decision of Board of
Examiners-in-Chief."]

2-390.

UNITED STATES OF AMERICA.
DEPARTMENT OF THE INTERIOR.
UNITED STATES PATENT OFFICE.

To all to whom these presents shall come, Greeting:

THIS IS TO CERTIFY that the annexed is a true copy from the Records of this Office of the Decision of the Examiners-in-chief, dated October 24, 1904, in the matter of

Interference

Number 23,151.

Rayburn vs. Strain,

Subject-Matter:—

Fruit Graders.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this 12th day of October, in the year of our Lord one thousand nine hundred and ten and of the Independence of the United States of America the one hundred and thirty-fifth.

[Seal]

C. C. BILLINGS,

First Assistant Commissioner of Patents. [807]

Recorded Vol. 31½, p. 72.

E. C. C. Appeal No. 26,006. Paper No. 5.

No. 26,006.

Decision.

U. S. Patent Office, October 24, 1904.

Before the Examiners-in-chief, on Appeal.

In the matter of the Interference between the pat-

ent to Charles Rayburn, No. 726,756, granted April 28, 1903, on an application filed August 18, 1902, and the reissue application of Robert Strain, filed October 21, 1903, reissue of patent No. 730,412, granted June 9, 1903, on an application filed April 28, 1902. Interference No. 23,151.

Improvement in Fruit Graders.

Messrs. JAMES R. ROGERS and JOHN A. SAUL, for Rayburn.

Messrs. TOWNSEND BROS., for Strain.

The issue is:

1. In a fruit sizing machine, a runway for the fruit comprising cooperating parallel members, one of said members consisting of a series of rolls arranged end to end and disposed progressively at different distances from the other member, forming communicating fruit-discharging apertures of progressively different widths along the length of the runway, means for adjusting each roll independently to vary the size of the aperture formed thereby, and means for driving the rolls, substantially as described.
2. In a fruit sizing machine, a supporting frame, a runway for the fruit comprising cooperating parallel members, one of said members consisting of a series of rolls arranged end to end and disposed progressively at different distances from the other member, forming communicating fruit-discharging apertures of progressively different widths along the length of the runway, brackets carrying the rolls, means mounted upon the frame for moving each bracket and ad-

justing each roll independently to vary the size of the aperture formed thereby, and means for driving the rolls, substantially as described.

3. In a fruit sizing machine, the combination with a supporting frame, of a fruit runway formed by a relatively stationary member and a longitudinal series of rolls arranged [808] end to
26,006—2

end at different distances from said stationary member, thus providing communicating spaces of progressively varying sizes for the discharge of the fruit, means for independently adjusting the rolls with relation to said stationary member, means for driving the rolls, and means for positively feeding the fruit along the runway, substantially as described.

4. In a fruit grading machine, the combination with a supporting frame, of a fruit runway comprising a relatively stationary member and a series of rolls disposed in parallel relation to said member and arranged end to end at different distances from the stationary member, forming communicating passages of progressively varying sizes along the runway for the discharge of the fruit, means for adjusting the rolls with relation to the stationary member, means for driving said rolls and a travelling belt moving in parallel relation to the stationary member and rolls positively feeding the fruit along the runway, substantially as described.

5. In a fruit grading machine, the combination with a supporting frame, of a central longitudinal

divider, forming one side of each of two parallel runways, a series of rolls disposed on each side of the divider and arranged end to end at different distances from the divider, forming therewith a runway having progressively varying discharge spaces for the fruit, means for adjusting the rolls of each series toward and from the common divider, means for driving the rolls, and belts disposed on opposite sides of the divider for positively feeding the fruit along the runways, substantially as described.

6. In a fruit sizing machine, the combination with a supporting frame, of a longitudinal shaft, transverse shafts, one of which is adapted to be driven from a suitable source of power, a runway comprising a relatively stationary member and an adjustable member consisting of a series of rolls arranged parallel therewith and disposed end to end at different distances from the stationary member, means for independently adjusting the rolls with relation to the stationary member, means for driving the rolls from the longitudinal shaft, and a belt connected with the transverse shafts for positively feeding the fruit along the runway, substantially as set forth.
7. In a fruit grading machine, a runway formed of two parallel members, one of said members consisting of a series of end to end rolls, brackets carrying the rolls, guides for the brackets, and means for adjusting the brackets upon the guides, substantially as set forth.

Motions have been made by each party to suppress

portions of the depositions of the other. It is unnecessary to specifically pass upon these motions.

The examiner of interferences has justly criticized the manner of taking the testimony. Not only were needless and futile objections constantly made, particularly by Rayburn's counsel, who [809] was
26,066—3

himself the greater offender in the matter of leading questions, but the utter disregard of the rules of evidence almost precludes the possibility of arriving at facts upon which to base a satisfactory conclusion of the controversy.

The language of the Court in *Royal Metal Mnfg. Co. v. Hard Metal Works*, 130 Fed. Rep. 778, is applicable here:

“Counsel have vied with each other in padding the record, regardless of the rules of evidence and of their duty to the court.”

The Examiner of Interferences has reviewed at length the testimony in behalf of Rayburn, and it is not necessary here to go into such testimony. We agree with him that it proves no date of invention earlier than the date of his application.

The testimony for Strain shows that he had a definite conception of the invention as early as February, 1901. As he was the first to file an application, he was first to conceive and first to constructively reduce to practice.

Both parties assert that full-sized machines have been built and are in use. Strangely enough none was introduced in evidence, nor were photographs taken, nor was any attempt made to show what they

were except by testimony of witnesses, who were not allowed to describe the machines, but were shown copies of the interference drawings and asked whether the machines were such as were shown in the drawings.

Strain offers an exhibit model of his machine, but it does not appear when it was made or who made it, or that it is an accurate copy of the original machine. Manifestly, even if admissible, it is lacking in evidential value.

Neither party has proved an actual reduction to practice.

The decision of the Examiner of Interferences awarding priority of invention to Robert Strain was clearly right and is affirmed. [810]

26,006—4

Limit of appeal will expire November 23, 1904.

J. H. BRICKENSTEIN,

T. G. STEWARD,

Examiners in Chief.

3rd member absent.

WF.

E. E. G.

[Endorsed]: U. S. Patent Office Copy Made Oct. 11, 1910. 180,886/10. [811]

Riverside Heights O. G. Assn. et al. 783

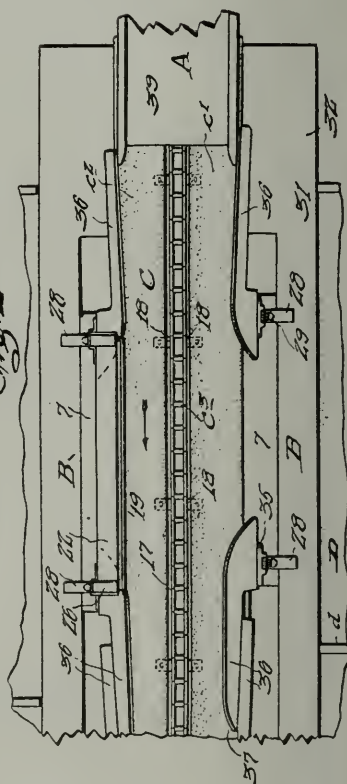
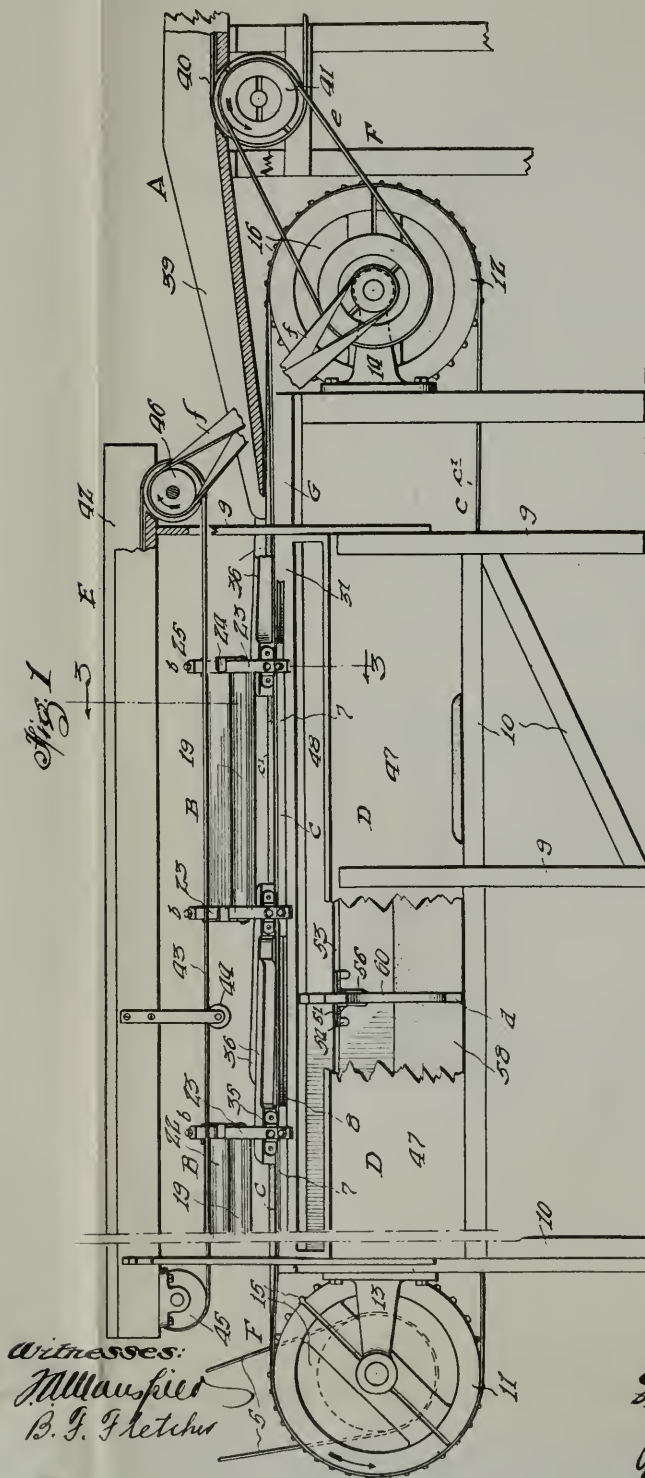
[Complainant's Exhibit "Parker Patent."]

G. D. PARKER.
FRUIT SIZER OR GRADER.
APPLICATION FILED MAR. 31, 1910.

997,468.

Patented July 11, 1911.

2 SHEETS—SHEET 1.



Witnesses:

William
B. F. Fletcher

Inventor,
George D. Parker;
by

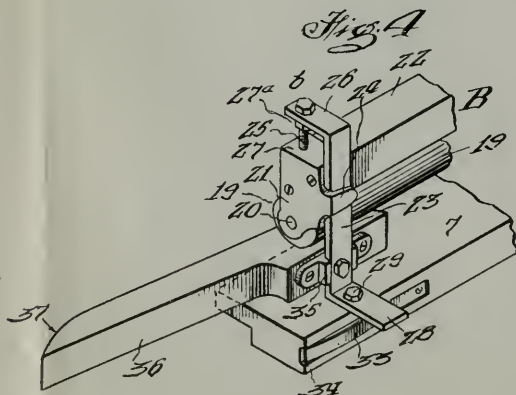
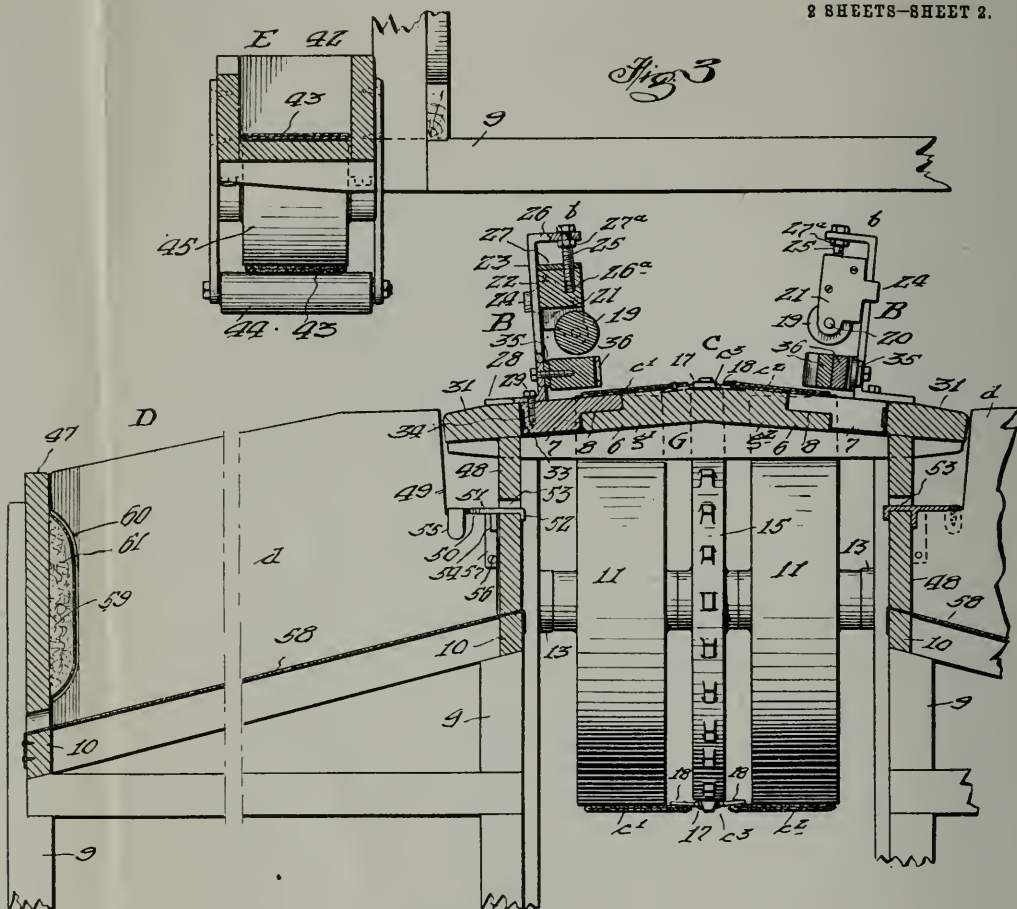
Becker & Chapin,
his Attorneys.

G. D. PARKER.
FRUIT SIZER OR GRADER.
APPLICATION FILED MAR. 31, 1910.

997,468.

Patented July 11, 1911.

2 SHEETS—SHEET 2.



Witnesses:

M. A. Fitch
B. F. Fletcher.

Inventor,
George D. Parker;
By *Beckert & Blaisdell*
his Attorneys.

UNITED STATES PATENT OFFICE.

GEORGE D. PARKER, OF RIVERSIDE, CALIFORNIA.

FRUIT SIZER OR GRADER.

997,468.

Specification of Letters Patent.

Patented July 11, 1911.

Application filed March 31, 1910. Serial No. 553,438.

To all whom it may concern:

Be it known that I, GEORGE D. PARKER, citizen of the United States, residing at Riverside, in the county of Riverside and State of California, have invented new and useful Improvements in Fruit Sizers or Graders, of which the following is a specification.

This invention relates to fruit sizers or graders; and it has for its object to provide improvements in sizers or graders for separating fruit into classes of various sizes and grades, which will be relatively simple and inexpensive in construction, and generally superior in point of positiveness and accuracy of operation, and facility of adjustment of parts and control in operation, and which will also be generally superior in efficiency and serviceability.

With the above general objects in view, the invention consists in the novel provision, construction, formation, combination, association and relative arrangement of parts, members and features, all as hereinafter described, shown in the drawings, and finally pointed out in claims.

In the drawings:—Figure 1 is a longitudinal side elevation, partly in section and partly broken away for clearness of illustration, of a fruit sizer or grader embodying the invention; Fig. 2 is a partial or fragmentary top plan view thereof; Fig. 3 is an enlarged detail transverse sectional view thereof, partly in full lines and partly broken away for clearness of illustration, the same being taken upon the section line 3—3, Fig. 1, looking in the direction of the appended arrows; and, Fig. 4 is a detail isometric view, upon substantially the same scale as that of Fig. 3, and illustrating in a fragmentary manner an essential feature of the invention consisting of an adjustable grading or sizing element.

Corresponding parts in all the figures are denoted by the same reference characters.

Referring with particularity to the drawings, the improved fruit sizer or grader comprises supply means A, sizing or grading members B, and feed means C by which the fruit is conveyed from the supply means to the sizing or grading members whence the fruit passes, in accordance with the sizes thereof, to points of deposit or receptacles such as bins D which, in accordance with the invention, are provided with adjustable side-walls *d* whereby the said bins may be en-

larged or contracted laterally, or longitudinally of the feed means C; and the sizing or grading members B are adjustably mounted to provide for variations of the sizes or grades of fruit of which they respectively permit passage to the bins D. I further provide imperfect fruit conveying means E to which is committed such of the fruit as is found to be unfit for use with the fruit 65 passed to the bins D; and the feed means C, supply means A and conveying means E are jointly actuated by operating means F, the feed means C being primarily actuated from a suitable prime mover or source of power, 70 as by a belt 5. Operative connections *e* and *f* extend respectively from the feed means C to the conveying means E and the supply means A.

The feed means C preferably comprises 75 two jointly operated members *c*¹ and *c*² which are both connected with a drive member *c*³ which co-acts with the operating means F; and said members *c*¹ and *c*² may each comprise an endless belt, said belts travers- 80 ing adjacent paths and in their upper courses overlying a table or support G having two lateral portions *g*¹ and *g*² slightly downwardly inclined in opposite directions, from a horizontal plane; and the sizing or grad- 85 ing members B are arranged in series adjacent to each of the belts *c*¹ and *c*², being supported upon adjuncts of the table or support G, which latter preferably consist of longitudinal portions 6, and base plates 7 90 for the sizing or grading members B, the same being lap-jointed, as at 8. The table or support G is mounted upon suitable uprights 9 which are longitudinally and diagonally braced, as at 10, the supports and 95 braces 9 and 10 being extended laterally to accommodate the bins D which are arranged at each side of the table or support G in a series longitudinally of the apparatus or mechanism. 100

A preferred form and construction of parts, members and features entering into the embodiment of the invention and the essential features thereof, together with a preferred combination and association thereof, is as follows:— 105

The endless belts *c*¹ and *c*² are trained over two pairs of pulleys, 11 and 12, which are suitably journaled, as at 13 and 14 respectively, at the opposite ends of the main 110 frame which includes the uprights 9 and braces 10; and the pulleys of each pair are

spaced apart sufficiently to accommodate a sprocket wheel, 15 and 16 respectively, over and around each of which sprocket wheels is trained an endless link belt 17 which is tied to the flat belts c^1 and c^2 at predetermined intervals, as at 18, insuring joint and equal movement of said flat belts and the intermediate link belt. In the upper courses taken by the flat belts they are brought into parallel relation with and above the said portions g^1 and g^2 of the table G so as to conform to the slight angular relation above described and clearly shown in Fig. 3, wherefrom it results that the fruit conveyed by either flat belt is directed laterally upon the same, by gravity, toward the sizing or grading members B of the series provided for the sorting of the fruit so fed.

Each of the sizing or grading members B comprises a grading roller 19 which is so disposed that its axis of rotation is substantially parallel with the course of travel of the flat belts by means of which the fruit is fed, and each grading roller is disposed partially above one of the flat belts, whereby fruit is directly fed to the respective sizing and grading member by the respective flat belt; and each of the rollers 19 is provided with end bearings 20 journaled in side plates or cheeks 21 of a carriage 22 adjustably mounted upon uprights 23 and maintained in connection therewith by fingers 24 which play vertically or substantially vertically upon the uprights 23; adjusting means b being provided for the regulation of the elevation of each grading roller 19 with respect to the plane of movement of the respective flat feed belt: said adjusting means consisting, as shown, of adjusting screws 25 passed through openings in the angularly directed upper portions 26 of the uprights 23 and entering internally threaded chambers 26^a in the carriages 22, or internally threaded openings in cap plates 27 upon said carriage: said adjusting screws 25 being provided with lock nuts 27^a bearing beneath the said upper portions 26 of the uprights 23. The lower end portions of the uprights 23 are angularly bent in directions opposite of that of the upper portions 26 and are bolted, as at 29, to the respective base plate 7, one base plate being provided for each pair of uprights 23; and each base plate 7 is adapted to be disposed between the respective table or support side section 6 and a side rail 31, one of which rails extends at each side of the table or support C, being connected therewith at its ends, as at 32, and spaced therefrom immediately, the base plates overlapping the adjacent table or support section 6, as at 8, as above described. Each of the base plates 7 is chambered at its outer edge portion, as at 34, to receive a curved leaf spring 33 which bears tensionally against the ad-

jacent rail 31, whereby each base plate and the sizing or grading member B organized as described and mounted thereupon may be adjusted longitudinally of the table or support C at one side thereof, and tensionally held in position of adjustment; and the angular end portions 28 of the uprights 23 bearing upon the rail 31 maintain the base plate in its vertical location, in combination with the over-lapping joint at 8.

Suitably socketed and bolted to the lower portion of each upright 23, as at 35, is a guide-arm 36 which projects laterally from the respective base plate 7 toward the next adjacent base plate, from which latter base plate a similar guide-arm 36 projects, both guide arms being joined in overlapping relation, as clearly shown in Fig. 2; and said guide arms slightly overhang the respective flat belt c^1 or c^2 , at the outer edge portions of the same, where said guide-arms overlap, being rounded, as at 37, so as not to impede the motion of the fruit as the same is advanced by the belt. The fruit passes beneath each grading roller 19 and between the inner ends of the guide-arms 36 which are connected with the uprights 23 supporting such grading roller; and similar guide-arms 36 project from the uprights 23 next adjacent to the supply means A and embrace between the same the side walls of a chute 39 embraced within the supply means A, which further comprise an endless belt 40 entering the chute 39 and trained about a pulley 41 journaled beneath the chute 39 and actuated by the operative connections or belt e . The guide arms 36 extend, in the main, parallel with the course of travel of the fruit as moved by the feed means C.

The conveying means E for imperfect fruit comprise a trough or chute 42 mounted upon frame members 9 above and at one side of the feed means C, and an endless belt 43 which in its upper course moves through said trough or chute and in its lower course beneath the same, passing over an idler pulley 44 beneath the trough; said belt being trained about pulleys 45 and 46 journaled beneath the trough, and the latter of which is actuated by the operative connections or belt f .

The bins D at each side of the machine and the feed means C thereof, comprise a continuous outer wall 47, a continuous inner wall 48, and a plurality of laterally adjustable bin walls d as above recited. Each side wall d is cut away, as at 49, to accommodate the adjacent rail 31 and to form a shoulder 50 which is provided with a hanger or sliding bracket 51 having two divergent or spaced arms 52 projecting through an elongated slot 53 in the respective fixed longitudinal wall 48 and engaging with the inner face thereof: each of the arms 52 being provided with a depending finger 54 engaging

the inner face of the wall 48 and a depending finger 55 engaging one side of the wall *d*; and spaced fingers 56 depend from the respective arms 51 so as to embrace the wall *d* at its vertical edge portion, and are secured thereto, as at 57. Each wall *d* may thus be adjusted longitudinally of the continuous longitudinal bin walls 47 and 48, the lower edge of the same resting upon the laterally slanting bin bottom 58, common to the entire bin construction; and the outer vertical edge portion 59 of each bin wall *d* being cut out, as at 60, to accommodate a buffer or padding 61 upon the respective continuous bin wall 47.

The operation, method of use and advantages of the improvements in fruit sizers or graders constituting the invention will be readily understood from the foregoing description, taken in connection with the accompanying drawings and the following statement:—The fruit, such as oranges, is conducted to the machine or apparatus by the supply means A, being led along a chute 39 in a continuous stream to the feed means C, the chute 39 overlying the flat belts *c*¹ and *c*² at the initial end portions of the upper courses thereof. The fruit stream divides into two parts at the respective sides of the drive member *c*³ of the feed means, and the opposite inclinations laterally of the table or support portions 6 and of the belts *c*¹ and *c*² lying thereon causes the fruit to roll toward the guide-arms 36 embraced within the sizing or grading members B. As each fruit unit in its movement upon its flat belt is brought to registration with one of the grading rollers 19 and the space between the same and the respective base plate 7, it passes beneath such roller and over the respective base plate and into one of the bins D, providing its diameter is sufficiently small to permit of its passage beneath the roller, the base plates 7 and the side rails 31 being inclined laterally in common with the table or base portions or sections 6. The carriages 22 and their grading rollers 19 are adjusted to different heights above their base plates 7 by the adjusting means *b* of each, and such adjustment is progressive from the supply means A toward the other end of the machine or apparatus, each grading roller on each side of the machine being adjusted to a slightly greater altitude above its base plate than the next adjacent grading roller in the direction of the supply means; whereby the smallest fruit enters the bins next adjacent to the supply means, and the successive bins along the sides of the base or table G receive successively larger and larger sizes of fruit. The number of sizes of fruit produced in the sizing or grading operation is manifestly equal to the numbers of grading members provided at both sides of the apparatus; and one or

more of such grading members B may be removed from the apparatus or machine or mechanism, the spaces between the same being taken up by the overlapping guide-arms 36 which confine the fruit to the proper courses of travel. Furthermore, each grading member may be set for the selection of the particular size or grade number of fruit, by utilizing the adjusting means *b*, and the size of each bin may be varied by the adjustment of its side bin walls *d* relatively, additional side walls *d* being provided when a large number of small bins are to be utilized in connection with an increased number of grading operations. The fruit as it falls into the bins D rolls or bounds along the bin bottom 58 and strikes against the yielding buffer 61 which prevents injury of the fruit.

The drive member *c*³ of the feed means C positively actuates both flat feed belts *c*¹ and *c*², jointly.

The sizing or grading members B are readily lifted out of their working positions, being sustained in the latter disposition yieldingly by the springs 33; so that each sizing or grading member may be readily removed from working position, and may also be adjusted longitudinally of the table or support G.

The conveying means E is utilized for the purpose of conducting to one end of the mechanism or apparatus such imperfect fruit as may be withdrawn from the apparatus and thrown into the trough 42 and upon the moving belt 43 therein.

The apparatus or mechanism operates positively and rapidly and with great precision, the fruit supplied thereto being automatically selected as to size or grade number and segregated from the fruit stream within the bin with which the corresponding sizing or grading member B is associated, all without injury to the fruit.

I do not desire to be understood as limiting myself to the specific provision, construction, formation, association and relative arrangement of parts, members and features shown and described, but reserve the right to vary the same, in adapting the improvements to varying conditions of use, without departing from the spirit of the invention and the terms of the following claims.

Having thus described my invention, I claim and desire to secure by Letters Patent:—

1. In a fruit sizer or grader, a plurality of adjustable sizing or grading members, means for feeding fruit successively to the same, and co-acting guide-arms between and connected with the sizing or grading members.

2. In a fruit sizer or grader, a plurality of adjustable sizing or grading members, means for feeding fruit successively to the same, and overlapping guide-arms between

and connected with the sizing or grading members.

3. In a fruit sizer or grader, means for feeding the fruit in a predetermined course of travel, a plurality of adjustable sizing or grading members arranged at one side of such course of travel, and guide-arms respectively connected with the sizing or grading members and extending between the same in overlapping relation.

4. In a fruit sizer or grader, means for feeding the fruit in a predetermined course of travel, a plurality of detachable adjustable sizing or grading members arranged at one side of such course of travel, and guide-arms respectively connected with the sizing or grading members and extending between the same in overlapping relation and substantially parallel with the course of travel of the fruit as moved by the feed means.

5. In a fruit sizer or grader, a table or support, means for feeding fruit along said table or support, a rail extending at one side of said table or support, a base plate detachably mounted upon said rail and upon said table or support beneath said feed means, means tensionally holding the base plate in position, and a sizing or grading member mounted upon said base plate.

6. In a fruit sizer or grader, a table or support, means for feeding fruit along said

table or support, a rail extending at one side of said table or support, a base plate adjustably detachably mounted upon said rail and upon said table or support beneath said feed means, a sizing or grading member mounted upon said base plate, and tension means yieldingly holding said base plate in position of adjustment.

7. In a fruit sizer or grader, a plurality of relatively adjustable sizing or grading members, means for feeding fruit successively to the same, and a plurality of bins arranged to receive fruit in accordance with the relative adjustment of the sizing or grading members; said sizing or grading members being mounted for adjustment longitudinally of the fruit feeding means.

8. In a fruit sizer or grader, a plurality of sizing or grading members, means for feeding fruit successively to the same, and co-acting guide-arms between the sizing or grading members laterally of the fruit feeding means.

In testimony whereof, I have signed my name to this specification in the presence of two subscribing witnesses.

GEORGE D. PARKER.

Witnesses:

RAYMOND I. BLAKESLEE,
F. A. MANSFIELD.

[Title of Court and Cause.]

Assignments of Error.

Comes now complainant and specifies and assigns the following as the errors upon which he will rely upon his appeal to the United States Circuit Court of Appeals for the Ninth Circuit from the decree dismissing complainant's bill of complaint, which decree was made and entered on September 30th, 1912:

1. That said United States District Court for the Southern District of California, Southern Division, erred in dismissing said Bill of Complaint.

2. That said United States District Court for the Southern District of California, Southern Division, erred in decreeing that the defendants, or either of them, had not infringed either claim one (1) or claim ten (10) of said reissue letters patent No. 12,297.
[818]

3. That said United States District Court for the Southern District of California, Southern Division, erred in not decreeing that each of said defendants had infringed claim one (1) and claim ten (10) of said reissue letters patent 12,297.

4. That said United States District Court erred in not decreeing to complainant the relief prayed in said Bill of Complaint.

In order that the foregoing Assignments of Error may be and appear of record, the complainant presents the same to the Court and prays that such disposition may be made thereof as is in accordance with the laws of the United States.

Wherefore complainant and appellant prays that

the said decree may be reversed and a decree entered in said cause in favor of complainant ordering, adjudging and decreeing that claims one (1) and ten (10) of said reissue letters patent 12,297 are, and each of them is, good and valid, and that the defendants, and each of them, have infringed upon the same, and ordering a perpetual injunction against defendants as prayed in said Bill of Complaint, and ordering an accounting of damages and profits.

FREDERICK S. LYON,

Solicitor for Complainant and Appellant.

(Endorsed.) [819]

* * * * *

At a stated term, to wit, The July Term, A. D. 1912, of the District Court of the United States of America, in and for the Southern District of California, Southern Division, held at the courtroom in the City of Los Angeles, on Wednesday, the eighteenth day of December, in the year of our Lord one thousand nine hundred and twelve. Present: The Honorable OLIN WELLBORN, District Judge.

[Title of Court and Cause.]

**[Order Directing Transmission of Exhibits to
Circuit Court of Appeals.]**

Good cause appearing therefor, on motion of Frederick S. Lyon, Esq., of counsel for complainant, it is ordered that the following exhibits shall be withdrawn and transmitted to the United States Circuit Court of Appeals for the Ninth Circuit, to be used upon the hearing of the appeal in said Court, viz.:

Defendants' Exhibit Photograph Upland Sizer; Defendants' Exhibit Photograph Upland Machine, Knight's Cross-examination; Defendants' Exhibit Model California Sizer; Defendants' Exhibit Photograph of Parker Early Roll Machine; Defendants' Exhibit Photograph of Parker Sizer, installed in packing-house of Riverside Hts. Assn.; Defendants' Exhibit Original Parker Grade Unit; Complainant's Exhibit Second Style Parker Bracket; Complainant's Exhibit Sketch by Edward S. Cobb; Complainant's Exhibit Illustrated Machine; Complainant's Exhibit, Model of Defendants' Machine in [824] Pioneer Fruit Company Case; Complainant's Exhibit Rayburn Overhead System Patent, Letters Patent No. 741,928; Complainant's Exhibit Photo. of Rope Grader; Complainant's Exhibit Photograph Stevenson Machine; Complainant's Exhibit Photo No. 1; Complainant's Exhibit Photo No. 2; Complainant's Exhibit Photo No. 3; Complainant's Exhibit Photo No. 4; Certificate showing public record of Bailey Patent. [825]

[Endorsed]: No. 2232. United States Circuit Court of Appeals for the Ninth Circuit. Fred Stebler, Appellant, vs. Riverside Heights Orange Growers' Association, a Corporation, and George D. Parker, Appellees. Transcript of Record. Upon Appeal from the United States District Court for the Southern District of California.

Filed December 30, 1912.

F. D. MONCKTON,
Clerk of the United States Circuit Court of Appeals
for the Ninth Circuit.

No. 2232.

United States
Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

Fred Stebler,

Complainant and Appellant,

vs.

Riverside Heights Orange Grow-
ers Association and George D.

Parker,

Defendants and Appellees.

APPELLANT'S OPENING BRIEF.

This is an appeal from a decree of the District Court of the United States for the Southern District of California, Southern Division, dismissing on the ground of non-infringement appellant's bill of complaint.

The bill of complaint is based upon re-issue letters patent number 12,297, granted for the invention of Robert Strain. The invention is a machine for grading or separating fruit according to its sizes.

The District Court decree that appellant was the sole owner of the letters patent in suit and that said letters patent were good and valid in law and that the claims upon which the suit was founded, to-wit: claims one (1) and ten (10) thereof, were both good and valid claims and that Robert Strain was the original, first and true inventor thereof.

The assignments of error, therefore, bring before this court only the question of infringement and the first and last claims of the patent are the only ones involved.

The subject matter of this litigation relates to machines for "*grading*" fruit,—particularly oranges,—and the term "*grading*" as herein used refers to the separation of the oranges in accord with their sizes and has nothing whatever to do with questions of quality.

In order to secure a uniform pack of the oranges in the box it is necessary that all the oranges packed therein should be as near the same size as possible. If there be much difference in size an uneven pack results. Oranges, being customarily sold by the dozen, are packed in boxes containing even dozens, thus the sizes run 96's, 144's, 196's, etc., indicating the number of oranges packed in the box.

From the orchards oranges are taken to the packing house as they are cut from the trees, the various sizes being commingled. Oranges are seldom true spheres and their odd shapes render difficult exact comparisons of their sizes. Before wrapping in paper and packing in boxes it has been found necessary to have the oranges assorted according to sizes and the evenness of the pack being dependent upon the selection of oranges of closely corresponding dimensions rendered it essential that the selection should be closely predetermined. Assortment by hand was too slow and inaccurate.

Prior to Mr. Strain's invention two machines had been utilized for this purpose. These two types of devices were known in the art as the "*rope*" grader, exemplified in patents to Woodward, dated January 12,

1892 [Transcript, page 519], and Cerruti, dated February 26, 1895 [Transcript, page 535], and the "*rope and roller*" grader, also referred to as the "*Ish*" or "*California*" grader, exemplified in the patent to Ish, dated August 25, 1891 [Transcript, page 509]. As we shall see, slight modifications were made in the device of this Ish patent, but its principle of operation remained the same and the objections to it remained until Robert Strain produced the invention here in issue. We shall also see that Robert Strain's invention displaced all the other machines and was immediately recognized as a most important and vital improvement in the art.

THE "ROPE" GRADER.

The principle of this device is best illustrated in the patent to Cerruti, and is most readily comprehended by reference to Fig. 2 of the drawings of that patent [Transcript, page 536]. The oranges in this device were delivered upon two ropes spaced apart, the ropes supporting or holding up the oranges. These ropes travel lengthwise of the machine, being supported at suitable intervals. As the ropes travelled from the end of the machine, where the oranges were delivered onto the ropes, they diverged, thus making the distance between the ropes progressively greater and the opening formed between the ropes was thus continuously growing larger. As the ropes carried the oranges along, the travel of one rope being more rapid than the travel of the other, the oranges were turned over and over on the ropes and whenever the distance between the two ropes was equal to or slightly greater than the size

of the oranges presented between the ropes, the oranges fell through off the ropes. To receive the oranges bins were arranged beneath these traveling ropes. The difficulty with this principle of machine was found in the inability of the operator to place the bins in such relation to the fruit runway formed by the ropes as to secure in a given bin only oranges of approximately the same size. As the ropes were constantly diverging, the size of the opening between the ropes was constantly increasing and it was difficult to predetermine the position of the bins. A good many machines of this type were used prior to Robert Strain's invention, but the machines were only partially satisfactory. They were substantially all displaced by the rope and roller grader type.

THE ROPE AND ROLLER GRADER.

In the patent to Ish, No. 458,422, granted August 25, 1891, this type of machine is illustrated. The patent shows a flat belt arranged at a slight inclination to the horizontal and a stepped or graduated roller arranged opposite this belt. The runway thus formed by this belt and roller presented graduated openings through which the oranges could be delivered. The oranges were delivered to that end of the machine where the roller was of largest diameter and consequently the opening between the belt and roller was the smallest. The belt was moved in a straight line horizontally and longitudinally along parallel with the roller, one side of the oranges resting on the roller, one side of the orange resting on the belt, and the other side of the orange resting on the

roller, the point of contact with the roller depending upon its position with relation to the belt. If the roller projected high above the belt then the point of contact would be below the center of the roller and likewise if the roller were mounted low with respect to the belt the point of contact came high on the roller or above its center. This was simply the preference of the builder or user. The orange being carried along longitudinally of the roller by the belt, and resting on the roller, which did not move longitudinally, caused the orange to be turned, thus presenting between the belt and the roller successive portions of the fruit and eventually the smallest diameter of the orange. When the smallest diameter of the orange was slightly less than the opening between the belt and the roller, the oranges dropped through there between. The form of belt shown in the Ish patent is flat but in the machines placed on the market the longitudinally moving belt was ordinarily a round belt or "rope," as it is generally known, for short. The Ish patent shows the flat belt supported in a groove [see Fig. 4, Transcript, page 511], "to prevent the belt from sagging in order to maintain the graduated opening between the belt and graduated roller uniform" [specification, lines 84-86; Transcript, page 512]. When the "rope" form of belt was used it was likewise supported in a groove for this purpose, the "rope" and "flat" belts being full equivalents for this purpose.

This rope and roller grader had then one side of the gradeway formed of a traveling belt and its co-acting side of a single one-piece roller. The roller was graduated, *i. e.*, viewing the roller from the intake end of the

machine there was a cylindrical portion of a large diameter, then a portion of the roller was turned down to a smaller diameter, and progressively there were as many steps, graduations or reductions in diameter as it was desired to make separations as to size. It is thus apparent that the mere adjustment of this roller toward or from the longitudinally moving belt would simultaneously and correspondingly vary the distance between the belt and each step or graduation of the roller and no means whatever were present or provided by which the operator could control one grade or size independent of the adjacent sizing or separating apertures.

With the machine of this Ish patent the relation of the various sizes to each other was fixed. This relation was predetermined by the builder of the machine and the operator thereof had no control whatever thereover. The operator could vary all the sizes simultaneously but the relation of the sizes to each other remained constant and what is referred to as very "fine" grading could not be accomplished. This fault in the "Ish" machine is the impelling reason for Mr. Strain's invention.

It is of course apparent that it was impractical to make a long grader with a stepped or graduated roller in one piece. In the first "Ish" or "California" graders the roller was about eight feet long and contained eight graduations or steps, thus making the length of each grading surface about a foot long. In order to lengthen out the machine and lengthen the grade surfaces the "Ish" or "California" graders were then made of two or more rollers, each with two to four different and

successively smaller steps or diameters, each successive roller, however, having its largest step or diameter smaller than the smallest diameter or the roller next contiguous thereto. These rollers were so connected together as to rotate as one piece or one roller and in effect comprised a single continuous roller, and the fault still remained embodied in the machine of having the difference in sizes or grades predetermined by the manufacturer and set with respect to each other and not changeable or adjustable one with respect to the other by the user or operator of the machine.

In the packing of oranges for shipment the fruit is necessarily selected by hand as to quality and it must after being separated as to sizes be wrapped in paper wrappers and packed by hand in the shipping boxes. This requires the employment of a large number of packers and consequently room at the side of the bins, into which the fruit is delivered by the grader, for access by the packers to the fruit. As each size of fruit is handled separately it is evident that one problem is to give access to the bins receiving the separated fruit and where the fruit runs comparatively uniform in size, as often happens, to distribute the packers equally to the several sizes and bins results in the loss of time by the packers at some bins and the overcrowding of others and an inability to handle and pack certain sizes of the fruit, with sufficient rapidity to prevent the clogging of the machine.

A second but less vital objection then to this "Ish" or "California" grader was found in actual practice to exist in the fact that it was impossible to vary the point of delivery of a given grade. For example, suppose

the bin to which the second size of oranges delivered from the machine became full and practically none of the oranges were (in the given orchard run) of the third or next succeeding size. The third bin would remain empty. Still it was impossible with such machine to deliver to that bin the second size. The evidence shows that often the oranges from a given orchard run to three or four sizes. Although the old "Ish" or "California" graders were built to separate nine or ten different grades or sizes, the packers at the second bin were unable to handle the second size oranges as fast as they came from the machine while the packers at the third bin were idle, it being of course impossible in a given space to accommodate more than a given number of packers.

There had been many other attempts made from time to time to produce a fruit grader which could be commercially utilized but none of them were found practical. The record shows many of the paper conceptions of inventors to produce a successful device for this purpose. No witness in this case has testified that any of these other paper conceptions could or would prove successful or practical and there is no evidence which even tends to prove a single attempt bordering on a successful use of any of them. The "rope" and the "rope and roller" graders were the only practical machines prior to Robert Strain's invention, and each of these had this inherent objection that the separations as to size were in fixed relation to each other and the operation had no control over each size individually.

With this state of the art before him, Robert Strain conceived the invention in issue. He was the foreman

of the E. K. Benchley packing house at Fullerton, California, and using an "Ish" or "California" grader.

He was the first to recognize the necessity of individual control of each sizing or grading aperture and the first to produce a practical machine which enabled the operator to regulate at will each grade or size and this was the distinguishing characteristic of the machine produced by Mr. Strain and the vital essence of his invention. This feature has been found to be the reason for the Robert Strain invention superceding in use both the "rope" and the "rope and roller" graders.

The distinguishing feature of Mr. Strain's invention was the principle of using to form the grading opening, an independently mounted roller for *each* sizing or discharging opening and mounting *each* roller so as to be independently adjustable to and from the longitudinally moving belt, *thus rendering each of the operative portions of the machine in separating as to size independent of the other and completely within the control of the operator.* By thus enabling the operator to independently control the operative portion of the grader very fine or accurate separation could be accomplished.

No practical form or construction of machine had ever been devised prior to Robert Strain's invention in which each individual grading or sizing opening of the machine had been composed of a belt and an individual and independently adjustable roller, the oranges resting upon both belt and roller and passing along if of greater size than this grade opening and passing through if of the size of the grade opening. One such grade opening does not make a complete grader or sizing machine but it does make up a complete grading

element and it very distinctly illustrates the basic feature of Mr. Strain's invention. The several grade openings need not be absolutely contiguous to secure the novel result secured by Mr. Strain's invention. Each grading member, however, must have its grading opening independently regulable or adjustable and to be a practical machine these grade openings must be arranged end-to-end,—not one above the other or superimposed. It is, however, immaterial whether every portion of the travel of the orange is a grading opening if such grading openings be sequential along the line of travel of the fruit and the fruit be supported at all times during such travel. Thus from the grading opening for the smallest size the remaining oranges may, if desired, be conducted by a belt and co-operating non-grading surface to the point where it is desired to provide the second grading opening for the next larger size of fruit. This intervening space would not alter the principle of action of the Strain invention or machine, nor would it alter the means employed in separating according to sizes nor the interrelation of the parts forming the grading openings.

The "nub" of the Strain invention was the use of a separate and individual roller for each size or grade: the object was to give individual and independent control to the operator of the individual grading opening. In Mr. Strain's machine in which he embodied his invention the belt (either "flat" as Ish first showed and used it, or the round or "rope" form as used in the later "Ish" or "California" graders), formed one side of this individual grading opening and the individual and independently adjustable roller the other side of

this grading opening. This roller was adjustable toward and from the belt to vary the width of this grading opening. This, we repeat, was the real kernel of Mr. Strain's invention and as we shall see this kernel of the invention is appropriated bodily by the defendants and for that reason defendants infringe.

In the machine Mr. Strain adopted the only construction which is practical in a fruit grader: that in which the fruit is supported until it finds its sizing opening and is not subjected to a series of bruising by successive droppings and strikings as proposed in some of the paper forms of the prior art. To be practical the machine must support and carry along the fruit until it is separated according to its size and then discharged with as little chance for bruising as possible.

As is well known, the patent statutes require that the inventor in making application for patent for his invention "shall explain the principle thereof, and the best mode he has contemplated applying that principle." (R. S. U. S., Sec. 4888.)

It was not the intention of this requirement that the inventor be limited to the exact construction described in such application or shown in his drawings thereof but such showing was his preferred construction and in accordance with this statute in his application for letters patent Mr. Strain set forth in his specification and showed in his drawings, a description and illustration of the machine as he preferred to construct it to embody his invention in what he considered the best form thereof.

He showed the usual belt (a "rope" belt being indicated in the drawings), supporting its entire length in

a suitable guiding and supporting groove to prevent the sagging of the belt or its displacement sidewise by the weight or travel of the fruit. In his drawings Mr. Strain shows this guiding and supporting groove as of such form to correspond with the shape of the round or "rope" belt shown in his drawings and if he had desired to show a flat belt such as shown in the Ish patent he might have shown the well known groove therefor, such groove being shown in the Ish patent. Mr. Strain showed and described means for causing the belt to travel horizontally the length of the machine, this being the only practical arrangement then or yet known to the fruit grading art. This belt is the carrying means on which the oranges rest and by which they are carried along until they reach the grade opening corresponding to their size. As the object of carrying the fruit along could not be accomplished by the belt alone, without means to hold the oranges thereon, and as it was necessary to turn or rotate or revolve the oranges as they were carried along in order to insure the presentation of the smallest diameters of the respective oranges to grading openings, another surface of some kind opposite the belt was necessary against which the oranges might rest. It is obvious that the grading openings might be arranged one right after the other or might be spaced somewhat apart. As Mr. Strain preferred to make all portions of this co-operating surface opposite the belt adjustable toward and away from the belt and to divide this surface up into small sections each independent of the other, he described in his specification and showed in his drawings a series of rollers, each mounted in its own brackets or

bearings and each independently adjustable with respect to the belt. He describes and shows these individual rollers as arranged in longitudinal extension or end-to-end to correspond with the horizontally moving belt. By thus making all of the surface, co-acting with the belt, adjustable, he secured the maximum control thereof by the operator and if the operator desired to close any portion of this surface close enough to the belt to form idle or non-grading or mere carrying space, he could do so with the same effect as though Mr. Strain had spaced his rollers apart by said means or surfaces arranged in fixed relation to the belt, and when so positioned would perform no function or effect in the machine other than to assist and co-operate with the belt in carrying the fruit to the succeeding grading opening.

In the embodiment of his invention shown in the re-issue patent in suit, Mr. Strain showed and described means for rotating the sizing or grading rollers. This means is the short belts L, and they are so arranged as to rotate or revolve the rollers upwards and against the tendency of gravity to impel the fruit down between the roller and belt. This rotation lifts the fruit and gives the maximum protection against tendency to pinch between roller and belt. It is not essential to positively rotate the rollers by mechanical driving means, although experience has shown it is necessary that one side of the grading opening be in a freely rotating form.

It is not claimed that there was any novelty *per se* in any one of the mechanical devices utilized by Mr. Strain. His invention resided broadly in the use of the

individual rollers, each mounted independently of the other, and each separately and independently adjustable toward and away from the carrier belt. This was the inventive idea conceived and produced by Mr. Strain and he was the first to produce a fruit grader in which the successive grading openings were independently adjustable to give the operator absolute control of the size of each grading opening without effecting the next succeeding or next preceding grade or size.

As the court below found against appellant solely on the ground of non-infringement, appellant will first compare the machines made and used by defendants with the Strain invention.

In defendants' machines the conveying and supporting belt is of the "flat" type. Its function, however, is identically the same as the function of the "rope" belt illustrated in the drawings of the patent in suit, and it performs its function in identically the same manner. In both instances the function of the belt is two-fold,—to support one side of the fruit and to positively carry the fruit along through the machine.

In defendants' machine the functions of the rollers are identical and while the mechanical form of the supporting and adjusting brackets differs in detail, yet the result sought and accomplished is identical and it is performed in identically the same manner. In defendants' machines the oranges rest on the belt, which is inclined slightly toward the rollers, and as the belt moves longitudinally of the machine the oranges are carried along one side resting on the belt and the other contacting with the rollers, if the space between the belt and given rollers is smaller than the diameter of

the orange. The rolling contact of the oranges on the rollers cause the rollers to rotate upward and away from the belt in the same direction and manner as in the machine shown in the patent in suit. The space between the belt and the roller determines the size of orange discharged by or through any given grading or sizing opening formed by such belt and roller. Each roller is individual and it is mounted independently of each of the other rollers and it is adjustable toward and away from the belt without affecting the adjustment of any other roller.

A difference between the machine shown in the drawings of the patent in suit and defendants' machine is the difference in the position of the rollers with respect to the belt, the rollers being positioned higher up with respect to the belt than as shown in the drawings of the patent in suit, but this difference is one which, while it attracts the eye, in substance makes no alteration whatever in the idea or means utilized, or in operation of the machine, or in the co-operation of the belt and rollers, or in the principles of co-operation of the parts. They operate in identically the same way and are the same thing. The fruit rests on belt and roller in both instances in the same manner and for the same purpose and passes between the roller and belt when the opening is of sufficient size to permit such passage. Gravity is the impelling force in each instance to cause the fruit to pass out between the belt and roller. In each machine each grading opening is composed of a belt on one side and a roller or rotating surface on the other and each roller is an individual roller and mounted independently of the other rollers

and adjustable toward and away from the belt to vary at the will of the operating of the grading opening formed thereby without affecting another grading opening.

It is clear that in defendants' machines the same result is sought and accomplished as in the Strain invention and that the idea of means for accomplishing such result has not been changed. The grading openings are formed of the same elements. These elements are the same. And the manner of their co-operation is identical. The roller is an individual roller and it is mounted adjustable toward and away from the belt and such adjustment is not dependent upon any coincident adjustment of any other grading opening or member.

As said by the court in *Moore Carving Machine Co. v. Lucas Machine Company* (200 Fed. 77, 79):

"The patentee's conception was to put the head-piece within the belt, pressing it down upon the belt, to achieve the desired result, and this conception was by him for the first time embodied in a practical machine."

As said by this court in *Norton v. Jensen* (49 Fed. 859, 866):

"It is well settled that a copy of the principle or mode of operation described in the prior patent is an infringement of it. If the patentee's ideas are found in the construction and arrangement of the subsequent device, no matter what may be its form, shape, or appearance, the parties making or using it are deemed appropriators of the patented invention, and are infringers. An infringement takes place whenever a party avails himself of the invention of the patentee without such a variation as constitutes a new discovery."

Judge Nelson in *Blanchard v. Beers* (2 Blatch. 416) said that:

“The sure test, and one the jury should be guided by in all cases of this kind, is whether or not the defendant’s machine, whatever may be its form or mechanical construction, has incorporated within it the principle, or the combination, or the novel ideas which constitute the improvement to be found in the plaintiff’s machine.”

The same learned judge in *Tatham v. Le Roy* (2 Blatchf. 486) said:

“Formal changes are nothing,—mere mechanical changes are nothing; all these may be made outside of the description to be found in the patent, and yet the machine, after it has been thus changed in its construction, is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation.”

The Circuit Court of Appeals for the 7th Circuit, in *Idé v. Trorlicht etc. Co.* (115 Fed. 137), has said:

“Mere changes in the form of a device, or of some of the mechanical elements of a combination, will not avoid infringement, where the principle or mode of operation of the invention is adopted, except in those rare cases in which the form of the improvement, or of the element changed is the distinguishing character of the invention.”

The Circuit Court of Appeals for the 8th Circuit, in *Lourie Implement Co. v. Lenhart* (130 Fed. 122), says:

“One may not escape infringement by adding or subtracting from a patented device, by changing its form, or by making it more or less efficient, while he retains its principle and mode of operation, and attains its result by the use of the same

or equivalent mechanical means. (Walker on Patents, 347, 348; Sewell v. Jones, 91 U. S. 171, 183; Coupe v. Weatherhead, 16 Fed. 673, 675.)”

The fact that it is the policy of the law and the spirit of the courts to construe patents so as to fully cover the real invention produced by an inventor, and to give patent claims such an interpretation as to give the patentee a monopoly over what the inventor has actually produced, is fully and comprehensively set forth in the decisions of the Supreme Court of the United States in *Hobbs v. Beach*, 180 U. S. 383, and *Paper Bag Co. v. Bag Co.*, 210 U. S. 405.

As said in *Eck v. Kutz*, 152 Fed. 758:

“The question is whether *the inventive idea expressed in the patent* has been appropriated; and, if it has, infringement has been made out.

“But with all this the operation is essentially unchanged, not only the whole, but of each part: and this is the significant thing.”

In *Clough v. Gilbert & Barker Manufacturing Co.* (106 U. S. 166), Mr. Justice Blatchford says:

“The combination of the first claim of the Clough patent being new, and, consequently, there never having been any valve arrangement applied to regulate the flow of gas in such a combination, the premises on which the decision of the court below proceeded fail. Clough is entitled to the benefit of the doctrine of equivalents as applied to the combination of the burner, surrounding-tube, and regulating-tube, covered by the second claim of his patent. The regulation in the defendant's burners was by a tubular valve on the outside of the perforation instead of on the inside, and performing its work by being screwed up or down, as in Clough's. Although in the Clough structure

the burner and surrounding-tube revolve together in adjusting their position in reference to that of the tubular valve, so as to let in or turn off the supply of gas through the perforations, and although in the Clough structure the flame revolves by the revolution of the burner, and although in the defendant's burners the revolution of the surrounding-tube regulated the supply of gas through such perforation, and neither the burner nor the flame revolved, the defendant's valve arrangement must be held to have been an equivalent for that of Clough to the full extent to which that of Clough goes, involving, perhaps, patentable improvements, but still tributary or subject to the patent of Clough. It is true that that patent describes the tubular valve as being inside of the burner-tube. But Clough was the first person who applied a valve regulation of any kind to the combination to which he applied it, and the first person who made such combination, and he is entitled, under decisions heretofore made by this court, to hold as infringements all valve regulations, applied to such a combination, which perform the same office in substantially the same way as, and were known equivalents for, his form of valve regulation. The record shows that prior to the existence of the appellant's burner it was common in gas burners to check the flow of gas out of the burner by applying an obstruction operated by a screw indifferently outside or inside of the burner. It follows from these considerations, that the defendants infringed the second claim of the Clough patent."

The Court of Appeals for the Eighth Circuit, in *Lewis Blind Switch Co. v. Premium Mfg. Co.* (163 Fed. 950), says:

"A patent for an invention, which is neither primary nor a slight improvement on the prior art, but possesses substantial patentable novelty, covers a reasonable range of equivalents.

“In interpreting the claims of a patent, proper regard should be had to the natural import of the terms in question, the context and the specification.

“The question of infringement turns upon the character of Lewis’ invention. We regard it as neither primary nor a slight improvement on the prior art, but as possessing enough of patentable novelty to command a reasonable range of equivalents. The defendants’ machine embodies every element or its equivalent, of the claims which we sustain, and accomplishes substantially the same result in substantially the same way.”

In *Brown Bag-Filling Mach. Co. v. Drohen* (140 Fed. 97, 100) it is said:

“The Cummings patent in suit, in my opinion, is for a new machine or combination which produces a new and useful result, entitling the patentee to invoke the doctrine of equivalents. The claims secured by the patentee are such that in the determination of the question of infringement by defendant’s apparatus the forms and dissimilarities of construction are not controlling. As was stated in *Kinloch Tel. Co. v. Western Electric Co.*, 113 Fed. 652, 5 C. C. A. 362:

“‘The similarities and differences of machines and combinations are to be determined by the offices or functions which they perform, by the principles on which they are constructed, and by the modes which are used in their operation. A device which is constructed on the same principle, which has the same mode of operation, and which accomplishes the same result as another by the same or by equivalent mechanical means, is the same device, and a claim in a patent of one such device claims and secures the other.’ Citing *Machine Co. v. Murphy*, 97 U. S. 120, 125, 24 L. Ed. 935.”

The Supreme Court of the United States has repeatedly held that a charge of infringement may be made out though the letter of the claims is avoided.

Machine Co. v. Murphy, 97 U. S. 120;

Ives v. Hamilton, 92 U. S. 426-431;

Morey v. Lockwood, 8 Wall. 230;

Elizabeth v. Pavement Co., 97 U. S. 126-137;

Sessions v. Romadaka, 145 U. S. 29;

Hoyt v. Horne, 145 U. S. 302.

In the specification of the patent in suit [Transcript, page 166, lines 13-16], Mr. Strain says:

“By having short grade-rollers separately adjustable very fine grading may be done and more than one roller may be adjusted to the same grade, if desired.”

This extract is to be read in connection with the whole specification and particularly having in mind Mr. Strain's previous statement [page 165, line 64]:

“Below the grade-rollers are as many bins as there are grade-rollers, which are adapted to hold the fruit which will pass between the grade-roller and the belt.”

These extracts show conclusively that Mr. Strain did not intend to limit himself to one grade-roller for each size of fruit, but may provide a multiplicity of grade-rollers and bins.

In the defendants' machine every alternate roller of Mr. Strain's “short rolls” has been removed and the intervening space filled with a stick or arm along which the fruit travels, being supported and moved along on one side by the belt and supported on the other by this stick or arm. *No grading or sizing of the fruit is accomplished at the points where these sticks or arms are positioned and the result is to lengthen out the*

machine but not to change in any manner the function or mode of operation of the grading openings thus formed by the belt and respective rollers, which still co-operate together and are adjusted in the same manner and for the same purpose as in Mr. Strain's invention.

In defendants' machines these intervening arms have been made telescopic so that each roller may be moved longitudinally of the machine, varying the point at which separation of a given grade or size may be made. This longitudinal movement of the separate rollers is an added feature and forms the subject matter of the Parker patent granted to the defendant George D. Parker long subsequent to Mr. Strain's invention and after Mr. Parker had for years been familiar with the machines in general use involving the Strain invention. The granting of a patent to Mr. Parker upon this longitudinal adjustment of the rollers does not grant to him any right to use the Strain invention without the consent of the owner of the Strain patent. Nor is the grant of this Parker patent any evidence of defendants' machine not infringing the Strain patent. The Parker patent simply secures to Mr. Parker the exclusive right to utilize this longitudinal movement of the rollers to and from given positions and the consequent lengthening out of the machine. This is an added function and improvement and does not change or alter the fact that such a machine embodies in it the inventive idea produced by Mr. Strain and embodied in the patent in suit. The grant of the Parker patent does not show that the Commissioner of Patents has ever considered the question of such infringement.

Where the defendant accomplishes the same function by substantially the same means as the patentee, the fact that such means performs an additional function does not avoid the infringement.

Powell v. Leicester Mills Co., 108 Fed. 386, 47 C. C. A. 416;

Morrison v. Sonn, 111 Fed. 172;

Letson v. Alaska Packers' Ass'n, 130 Fed. 129;

American Can Co. v. Hickmot Co., 142 Fed. 141, 146;

Columbia Wire Co. v. Kokomo Co., 143 Fed. 116;

Comptograph Co. v. Mechanical Acc't Co., 145 Fed. 331, 337;

Corrington v. Westinghouse Co., 173 Fed. 69, 81.

Even though the structure of the defendant contains patentable improvements over the structure of complainant's patent, if the defendant in making those improvements has taken and used *the invention* covered by complainant's patent, he is guilty of infringement.

Weston Elec. Inst. Co. v. Whitney Co., 131 Fed. 280.

The existence of a patent under which an alleged infringer is operating is no protection, if he invades the terms of the one in suit, even though he may improve on it. Mere improvement even to the extent of patentable novelty involving invention does not protect against the charge of infringement.

Diamond Match Co. v. Ruby Match Co., 127 Fed. 341;

Benjamin Elec. Co. v. Dale Co., 158 Fed. 617;

O'Leary v. Utica & Mohawk Co., 139 Fed. 330;

L. J. Muller Co. v. Groeschel, 166 Fed. 917;

Miller v. Walker Pat. Piv. Bin Co., 139 Fed.

134.

The Circuit Court of Appeals for the Sixth Circuit, in *Herman v. Youngstown Car Mfg. Co.*, 191 Fed. 579, considers this question fully, saying:

“Defendant’s device is manufactured under patent No. 765,406, issued July 19th, 1904, to J. H. Wagenhorst, and the court below gave to this fact some force in reaching his conclusion that the device did not infringe. We think that the granting of the later patent and defendant’s conformity thereto are not of importance in this case on the infringement issue. There are expressions in some of the reported cases implying that by later patents the government has granted a right to make and use the article so patented, and that such grant is inconsistent with any construction of the earlier patent which would forbid the manufacture of the later structure. Such implication rests on a fundamental error. A patent is not the grant of a right to make or use or sell. It does not, directly or indirectly, imply any such right. It grants only the right to exclude others. The supposition that a right to make is created by the patent grant is obviously inconsistent with the established distinctions between generic and specific patents, and with the well-known fact that a very considerable portion of the patents granted are in a field covered by a former relatively generic or basic patent, are tributary to such earlier patent, and cannot be practiced unless by license thereunder.

“Another reason sometimes advanced for supposing that the structure of the second does not infringe the claim of the first patent is that the Patent Office has declared that a patentable difference exists. The premise is sound, but not the

conclusion. *In examining the second application, the Patent Office has no concern with the scope of the claim of the first, and does not and must not pay any attention thereto. It is concerned only with the early disclose by the specification and drawings. Patentable difference does not of itself tend to negative infringement. It may be as well based upon infringement, plus improvement; and improvement may lie in addition, simplification, or variance.*"

As said by the Circuit Court of Appeals for the Second Circuit, in *Cimiotti Unhairing Co. v. American Co.*, 115 Fed. 504:

"The mere fact that there is an addition, or the mere fact that there is an omission, does not enable you to take the substance of the plaintiff's patent. The question is not whether the addition is material, or whether the omission is material, but whether what has been taken is the substance of the invention."

See also:

Long v. Noye Mfg. Co., 192 Fed. 570.

The substance of the Strain invention, as we have heretofore pointed out, was the formation of the grading openings of a co-operating longitudinally moving carrying belt and an individual roller mounted independent of the other rollers and separately and independently adjustable toward and from the belt to regulate the size of the grading opening, thus giving the operator individual or independent control of each grading opening. This was the novelty of the Strain invention and this has been appropriated bodily in the defendants' machines.

The interposition between respective grading open-

ings of a non-grading space formed by fixed means, such as telescopic arms, has served to lengthen out the machine and permit an added adjustment to the grading openings, *i. e.*, the point of delivery may be adjusted with respect to the longitudinal extension of the belt, *but the principle of the individual rollers independently mounted and independently adjustable with respect to the belt and for the same purpose as in the Strain invention remains identical.* It is definitely ascertained, therefore, that the defendants' machine have not altered the function of the individual rollers, their independent mounting or their independent adjustment, or their relation to the belt in forming the grading opening or in separating the fruit as to sizes. It is immaterial then whether the added longitudinal adjustment of the rollers in their supporting brackets is an improvement or a mere colorable variance of the means for accomplishing another purpose.

A slight variation existing between the defendants' machines and the machine shown and described in the patent in suit resides in the omission of positive driving means for rotating the individual rollers. Mr. Strain has shown his rollers positively driven by belts and such positively driving the rolls has been made an element of all the claims of the re-issue patent except claims one (1) and ten (10), the only ones in controversy in this litigation.

To limit either claim 1 or claim 10 to the means for positively rotating the rollers is to make such claims practically identical and of the same force, effect and scope as other claims in the re-issue patent and the fact that no mention is made in either of these claims

shows the intention not to limit them to such driving or rotating means. This is particularly emphasized by the inclusion of such means in the other claims wherein they are definitely called for by the term "means to revolve each of said rollers, etc." in claim 3, and "means for driving the rolls," claims 4, 5, 6, 7, 8 and 9. In fact the reason for not including others of the claims as infringed by defendants' machines is solely because of the limitation thereof to such "means for driving the rolls."

The defendants' machines embody and utilize *rotating* rollers to form the grading openings. Rotation of these rollers is caused by the oranges being propelled along by the belt, the position of the belt being slight under the horizontal axis of the roller the fruit is carried along by the belt as an upward movement against the surface of the roller causing it to revolve.

Removal of the driving belts of the Strain machine demonstrates that the action is the same, the rollers rotating under the advancing action of the fruit in the same manner and direction as where the driving belts are used, the difference being merely one of degree. The testimony of the witnesses on this point is definite and certain.

Mr. Stebler, the complainant and appellant, testifies in this regard:

"I have visited quite a number of packing houses using my independent roller sizers and endeavored to demonstrate by actual experiment to my own satisfaction whether or not it is a fact that the positive driving of these rollers was necessary in order for the machine to perform its function and in no case have

I been able to find where the discarding of the belt from any one of these rollers seemed to make any material difference in the operation of grading fruit on this machine, either as to the sizing of fruit or the general operation of the machine. In no case have I been able to find where the machine would choke up from the non-driving of these rollers, but on the other hand I did find that on the removal of the belt from any one of these rollers, the roller would continue to rotate when the fruit was run over it through the action of the fruit itself and thus enable the machine to perform its function which it is intended to perform in grading fruit.

Q. 6. You have used in your last answer the term 'choke up.' What do you mean by that term?

A. By this I mean, as I suppose Mr. Parker meant, that there was no choking or crowding on the grade-way and that the fruit would carry on by this non-driven roller through the action of the solid belt or rope.

Q. 7. Machines in what packing houses did you examine?

A. I examined machines in the packing house of the Mountain View Orange and Lemon Growers' Association, at Upland, and the Stewart Citrus Association at Upland, and the packing house of the Upland Citrus Association, where I believe Mr. Parker testified he got negative results, and the packing house of the Arlington Heights Fruit Company at Prenda.

Q. 8. Where is Prenda?

A. It is about three miles from the city of Riverside in Riverside county.

Q. 9. In this last packing house, were they engaged in commercially packing oranges at the time?

A. Yes, sir.

Q. 10. What did you do in order to demonstrate the commercial practicability of the individual adjustable independent roller grader of the patent in suit without the use of means for mechanically turning or rotating the rollers, in this last packing house?

A. I simply removed the small driving belt from the pulley on the driving shaft and also removed from this belt the automatic weight tightener so that while

the belt itself was in contact with the roller, it was slack and free from the driving shaft, thus permitting the roller to freely rotate from the slight action of the fruit against it as it passed over the grade-way.

Q. 11. In this particular packing house what rollers in position along the grade-way did you so try in the commercial grading of oranges?

A. It was about the second or third roller from the free end, that is the end from which the fruit is fed into the machine.

Q. 12. Who was present during such trial?

A. Yourself, Mr. Arthur P. Knight, who has previously testified in this case, also a Mr. Whiffin, the packing house manager.

Q. 13. To what extent did such roller with the belt removed rotate during the commercial use of such machine?

A. Why it rotated continuously when the fruit was in contact with it. It would only stop when the fruit was not in contact with it.

Q. 14. Did you see any difference in the rate of rotation with or without the belt?

A. Almost the same as when it was positively driven.

Q. 15. And at Uplands, what roller in the length of the run-way did you try without the belt thereon?

A. Well, at the Mountain View house I think it was the second or third roller from the feed end of the grade-way and at the Upland Citrus Association it was about the third or fourth roller from the entrance to the grade-way and at the Stewart house we tried rollers at both ends of the machine.

Q. 16. What was the object of trying different rollers on these different machines?

A. Merely to determine the proportionate rate of rotation.

Q. 17. Did it make any difference in the various operations of the machine which ones of the rollers were mechanically driven?

A. We could not see that it did.

Q. 18. If I understand the operation of a fruit grader, Mr. Stebler, the larger amount of fruit passes

over the rollers at the feed or intake end, is that correct?

A. That is correct.

Q. 19. And if there were to be any crowding of the fruit it would be more apt to appear at that end?

A. It certainly would.

Q. 20. Have you seen any of the defendant's machines in operation?

A. Yes, sir.

Q. 21. Have you seen any of them in operation at the Riverside Heights Orange Growers' Association's packing house at Riverside, California?

A. Yes, sir.

Q. 22. When did you last see them in operation?

A. A week ago today I believe it was, which would be the twelfth.

Q. 23. In the presence of whom?

A. In the presence of yourself and Mr. Knight.

Q. 24. What was the object of such inspection?

A. Well, this inspection was made with the idea of verifying to our own satisfaction the comparison between defendant's machine and my own.

Q. 25. Were they commercially packing oranges at that time?

A. Yes, sir.

Q. 27. At the Riverside Heights Orange Growers' Association's packing house at Riverside, to which you last referred, at one end of the packing house they also have one of your graders built under the patent here in suit, have they not?

A. Yes, sir.

Q. 28. Did you observe the operation or rate of rotation of the rollers in your machine with that in the Parker or defendant's device at that time?

A. Yes, to this extent that taking my machine with the belt off the roller, that is with the roller non-positively driven, the rotation of the roller in my machine and the rotation of the roller in Parker's machine at approximately the same given point, or near the intake end, the rate of rotation was approximately the same.

Q. 29. Referring now to the Parker machine which you say you saw in operation on Wednesday, June

12th, at the Riverside Heights Orange Growers' Association's packing house at Riverside, California, did you notice particularly the action of the individual independent adjustable rollers in that device?

A. Yes, sir.

Q. 30. Were these rollers stationary or in motion?

A. They were only stationary when there was no fruit running against them.

Q. 31. And what did you observe in regard to the first two or three rollers toward the intake end?

A. They were in continuous rotation as long as there was any fruit running over them.

Q. 32. In what direction was this rotation with reference to the axis of the rollers and with respect to the longitudinally traveling belt?

A. The top of the roller turned outward or away from the traveling belt, the same as in my machine.

Q. 33. You say, 'the same as in my machine.' Do you mean the machine of the patent in suit?

A. Yes, sir.

Q. 34. And the same as the rollers are driven in such machine when the little cross belts are used?

A. Exactly. [Transcript, pages 597-602.]

Q. 61. Why, then, if the tendency is to force the orange down, why does not the roller tend to rotate downward when it has no belt on it?

A. Because the pressure of the orange is above the axis of the center of the roller.

Q. 62. And in practical operation, according to your observation, this tendency results in the rotation of the rollers, where no belt is used?

A. Yes, sir.

Q. 63. And that rotation was upward and away from the belt?

A. Yes, sir.

Q. 64. Is that also true of the defendant's grader?

A. Yes, sir.

Q. 65. Did you observe in the (*defendant's machines*) Riverside Heights Orange Growers' Association's packing house, at Riverside, on June 12th, 1912,

any tendency of the oranges to pinch between the belt and the rollers?

A. Yes, sir.

Q. 66. To what extent?

A. To the extent that it rotated the rollers. [Transcript, page 608.]

Q. 67. What reason have you for continuing to provide the rollers of the patent in suit with the belt means for positively rotating the rollers?

Mr. Acker: By the use of the word 'continuing,' Mr. Lyon, in your last answer, do you mean to imply that the complainant, at any time, ceased to supply the machines with the drive means referred to?

A. We have always built them with the power driven rollers.

Q. 68. Now answer my question with regard to the reason for so doing.

A. We prefer to employ this means for the reason, if for no other reason, that it takes away the excessive friction or pressure on the oranges necessary to turn the rollers. As a whole we are positive that the power or positive driving of these rollers reduces to the minimum all tendency to pinch the fruit.

Q. 69. Then, if I understand your answer correctly, based upon your experience, the positively driven roller is superior in its action?

A. Yes, sir, I so testified.

Q. 70. But that it is not a necessity in either the commercial or mechanical operation of the machine?

A. No, not necessary.

Q. 53. What, Mr. Stebler, is the reason for using a moving or rotating member as one side of the fruit run-way in an orange grader?

A. To prevent pinching the fruit.

Q. 54. Will you explain a little more what you mean by preventing pinching the fruit?

A. Well, in all fruit graders of this type, having a traveling longitudinal conveyer, the object of which is to carry the fruit longitudinally along the machine, the

action of this conveyer, or rather the action of the fruit on the conveyer is through the mere force of gravity itself to wedge under or between this traveling conveyer and the opposing member. I suppose the correct way to state it would be this: The conveyer being in contact with only one side of the oranges, tends to roll them lengthwise of the machine and naturally this rolling motion if carried far enough must either crush the fruit in its attempt to work down and under or between the grading members or something else has to give way, but the rotative motion imparted to it by a rotating member in opposition to the traveling conveyer tends to prevent this crowding or pinching, hence, *either a positively driven rotative member or a member free to rotate through this squeezing action itself is necessary.*"

This testimony is fully corroborated by appellant's expert, Arthur P. Knight, who testifies:

"Since giving your former testimony have you had occasion to make any further investigation of the fruit graders in actual operation?

A. Since that time I have seen the Parker grader as well as the Stebler grader in actual operation.

Q. 4. When you refer to the Stebler grader, in your last answer do you mean the machine embodying the construction and interrelation of parts illustrated by the patent in suit?

A. Yes, sir.

Q. 5. Where did you see each of these kinds of graders and when?

A. On Wednesday, June 12th, 1912, I saw both of these graders at Uplands and at Riverside, California.

Q. 6. Did you not also see the Parker grader in operation at Pomona on that date?

A. Yes, sir.

Q. 7. The Parker graders that you saw at Riverside were in the packing house of the Riverside Heights Orange Growers' Association at Riverside?

A. Yes, and at another place in the southern part

of the city. I do not recall the names of the packing house.

Q. 8. At the Riverside Heights Orange Growers' Association you also saw one of the devices of the patent in suit in operation?

A. Yes, sir.

Q. 9. And at the Arlington Heights Fruit Company at Arlington Heights, a few miles out of Riverside, on June 12th, 1912, you also saw the device of the patent in suit in actual commercial operation, did you not?

A. That is the building with which Mr. Whiffen is connected?

Q. 10. Yes.

A. Yes.

Q. 11. Mr. Knight, who was present at Pomona with you?

A. Yourself.

Q. 12. And at Uplands and Riverside and Arlington Heights who was present with you?

A. Yourself was present at each of these places and as I remember it Mr. Tucker was also present at Uplands and Mr. Stebler was present at each of these places.

Q. 13. Except Pomona, you mean?

A. Well, the last three.

Q. 14. Did you observe the manner of operation of the defendant's or Parker machine particularly at the places named by you?

A. I did.

Q. 15. With respect to the functions performed by the rollers of the defendant's or Parker machine, can you state their manner of operation or how they operated?

A. They operated, of course, as the sizing member or limiting member at one side of the grade-way. Further than that, operating as rollers, they turned more or less under the action of the fruit as it passed along in the case of the Parker machine and also in the case of the Strain or Stebler machine whenever the belt was removed.

Q. 16. At what end of a fruit grader is the fruit the heaviest?

A. You mean—

Q. 17. I mean by 'heaviest' in this question as to the quantity and amount of work to be done by the machine.

A. There is more fruit passing necessarily at the initial end of the machine since some of the fruit passes off from time to time as it passes along the grade-way.

Q. 18. Did you particularly observe the action of the rollers in the defendant's or Parker machine at the initial or intake end of the machine?

A. Yes, sir, at that end I noticed on several occasions where the fruit was coming along close together there would be a large number of oranges in contact with a single roller, and under this condition, the roller would turn substantially continuously in a direction upwardly on the side toward the rope or belt.

Q. 19. Did you notice particularly the operation of the Stebler or Strain sizer at the Riverside Heights Orange Growers' Association in this regard, with the belts on?

A. Yes, sir, both with the belts on and with the belts off.

Q. 20. And did you compare the rate of rotation of the rollers with the belts off on such Strain sizer with the initial two or three rollers of the Parker machines as they were in commercial operation in the Riverside Heights Orange Growers' Association's packing house at Riverside, California, on that day?

A. I compared them in a way as far as my memory would serve me to compare them, not by actual measurement, but by judgment.

Q. 21. And what was that comparison, so far as it was capable of being determined by observation?

A. That they revolved substantially at the same speed in these first few rollers as if they were driven by belts under the same conditions in the Strain machine.

Q. 22. You say that you saw the Strain or sizer of the patent in suit operated without the belts. Please

explain how that was done, where and what were the results?

A. At Arlington Heights we threw off the belt from the first section of roller and supplied fruit liberally to the machine and also sparsely and in such case when there was any fruit passing over the roller it would rotate and the amount of rotation was increased as the amount of fruit delivered to the roller was increased.

Q. 23. What was the direction of the rotation of the roller?

A. Outwardly toward the other side of the grade way.

Q. 24. Compared with the direction of the rotation when the belt was on, what was the direction of the rotation with the belt off?

A. It was the same.

Q. 25. And at the Uplands houses did you make any demonstration of the Strain or the graders of the patent in suit by removing any of the belts?

A. Yes.

Q. 26. And what were the results of such demonstrations?

A. The same as at Arlington Heights.

Q. 27. To what extent were these demonstrations carried on as to enabling you to testify from actual experience in the grading of oranges and as to the operation of the Strain device without the use of the belts or other means for mechanically rotating the rollers?

A. To a sufficient extent to satisfy myself that it could be so operated.

Q. 28. If I understand you correctly, this visit was made in view of your previous testimony in this case and the somewhat contradictory character of the evidence of some of the defendants' witnesses in regard to this fact, is that correct?

A. Yes, sir.

Q. 29. Can you give us the mechanical reason why both the rollers of the Parker or defendant's sizer and the rollers of the grader of the patent in suit rotate in the manner described by you without mechanical means for mechanically driving the rollers?

A. It is very evident from the fact that they do rotate that there must be a component of rotary motion at right angles, I should say, transverse to the longitudinal movement of the belt or rope. While I have never investigated the thing mathematically, I should judge that this is due to the oblique rotation of the oranges with reference to the longitudinally moving member, due to the tangential impulse imparted to the orange in longitudinal direction, results in rotation around an oblique axis and this in turn has a component in the transverse plane, tending to turn the orange in such a manner as to raise the adjacent side of the roller. The whole thing could be worked out by graphic analysis if a person cared to do it, but the operation speaks for itself." [Transcript, pages 671-681.]

This is also fully corroborated by the testimony of M. R. Whiffin, the superintendent of several packing houses at Riverside county, Cal. [Transcript, pages 728-738.]

The use of the individual and independently mounted and independently adjustable rollers in defendants' machines is explained in the history of the development of the infringing machines. Another infringement was attempted by Mr. J. W. Stevenson, after a failure with a machine which would not have infringed. Mr. Stevenson attempted to do away with a rotating roller as part of the grading opening. Without such a rotating surface forming one side of the grading opening the machine was found impractical. George D. Parker, one of the defendants, and the manufacturer of the infringing machines made by defendants, had full knowledge of this failure and adopted the rotating rollers of the Strain invention to avoid this difficulty shown up by Mr. Stevenson's failure. Mr. Stevenson's

testimony in regard to these facts is found on pages 739-779 of the transcript. Appellant has introduced in evidence a photograph of this impractical Stevenson machine. It is known as "Complainant's Exhibit Stevenson machine." It forms a very interesting link between success and failure and between the use of the Strain invention and the avoidance of the use thereof.

This Stevenson machine employs the same flat belt construction that is employed in the defendants' machines, and the belt is mounted and driven in almost identically the same manner. In fact, except as to the individual rollers and the telescopic arms between the rollers the Stevenson machine and the Parker or defendant's machines, the two are identical. Mr. Stevenson says he attempted to avoid infringement of the patent in suit by the use of non-rotating rods, but that this caused such a pinching of the oranges as to so severely injure the fruit as to render the machine impractical. Another fault was that "when the fruit would roll against that stationary rod it would try to go under before it came to a place where there was quite room enough, and the consequence was that it would push the belt into the center and sometimes force the belt high up in the center until the fruit would get off the runway." [Transcript, page 745, answer to Q. 48.] It is thus apparent that the use of rotating rollers as one side of the grading opening is the *sine qua non* of success.

This testimony also emphasizes the substance of the Strain invention, as we have heretofore determined it. Mr. Stevenson tried individual and independently ad-

justable rods to form the grading openings, but the result was failure. This testimony also emphasizes the fact that the Strain invention was not necessarily a continuous roller surface the length of the machine, but that the necessity for a roller surface existed at the grading openings through which the fruit was to pass. But this attempted use by Mr. Stevenson of the rigid stationary non-rotating rods proved the necessity of a rotating surface at the grading opening only. It clearly shows that, when considered as to whether it involves the Strain invention, whether with or without an improvement, defendants have adopted and used the vital essence of Mr. Strain's invention, and so far as Mr. Strain's invention is concerned the use of the telescopic arms and the longitudinal movement of the rollers and their brackets is a mere subterfuge and evasion, not changing in any manner the real interrelation of the parts or their mode or principle of co-action and co-operation.

THE CLAIMS IN SUIT.

Infringement is claimed of claims 1 and 10, the other claims of the patent being limited, as heretofore pointed out, to a fruit-grading machine in which the sizing or separating rollers are mechanically rotated or driven.

Claim 1 is as follows:

"In a fruit-grader, in combination a plurality of independent transversely-adjustable rotating rollers; a non-movable grooved guide lying parallel with the plane which passes vertically and longitudinally through the center of said rollers; said rollers and guide forming a fruit-runway; a rope in the groove in said guide and means to move said rope."

In the drawings of the Strain re-issue patent these elements may be pointed out as follows: the plurality of independent transversely-adjustable rotating rollers, represented at M; the non-movable grooved guide lying parallel with the plane which passes vertically and longitudinally through the center of said rollers, represented at I, the groove being the groove in which the rope belt H is mounted and the means for moving the rope consisting of the driven pulleys G and J over which the rope belt travels. The rollers are transversely-adjustable, *i. e.*, cross-wise of the belt. The grooved-guide lies in an extended horizontal plane, which plane cuts the rollers vertically and longitudinally substantially at the centers of the rollers.

In the defendant's machine the belt is mounted in a grooved guide, referred to as a "table or support G" in "Complainant's Exhibit Parker Patent" [Transcript, page 787, lines 75-85], the groove anchoring the belt in place being at the apex, and the two parts of the flat belt being mechanically connected to the small belt or chain, termed a "drive member c3" in the Parker patent. The relative arrangement of this grooved guide or "table or support" is the same, with respect to the individual and independently adjustable rollers, as shown in the Strain patent, lying parallel with the plane which passes vertically and longitudinally through the center of said rollers. The belt is driven by passing over pulleys at each end of the machine. It is thus seen that the defendants' machine corresponds absolutely with the terms of this claim. The only distinction that can be made is the separation of the several grade-openings and the non-grading space between

such grade-openings. This, however, has not changed the principle of the machine in separating fruit according to its size nor has it omitted the use of individual rollers, nor the use of rollers forming with the belt the grade-openings, nor the provision of independent adjustment of the width of such grade-openings by transverse adjustment of the individual or independent grade rollers.

It is of course to be noted that this claim 1 describes a machine in which the several grade-openings are in longitudinal extension in a horizontal plane and not superposed. This alone was not a novelty of the Strain invention, but it is one of the features, also present in the defendants' machines, which have permitted the construction of a practical machine in place of such an impractical form and mode of operation as that disclosed for example in the Hutchins patents, in which each grade-opening is arranged one above the other and the fruit is caused to drop through the successive steps until it finds its proper size, causing such a bruising of the fruit as to be impractical.

Claim 10 differs from claim 1 in its reference to the means for supporting the rolls, and in some respects is more in detail. It is:

"In a fruit-grading machine, a runway formed of two parallel members, one of said members consisting of a series of end-to-end rolls, brackets carrying the rolls, guides for the brackets, and means for adjusting the brackets upon the guides, substantially as set forth."

In the Strain machine one of the parallel members is the belt and the other the series of individual rolls;

in the defendants' machines there are also present the belt forming one member and the individual rolls forming the other grading members. The only distinction so far as this claim is concerned is the separation of the rolls and the telescopic arms between the rolls, thus not utilizing any portion of the separation of the rolls apart for the purpose of grading, but simply carrying the orange by that much space, thus lengthening out the machine for the added purpose of the Parker invention, without changing the spirit of the machine in separating the fruit as to sizes or the idea of means employed for securing the grading-openings or the manner of securing the independent adjustment of each grading opening without affecting the other grading openings, utilizing the substance of the Strain invention without in reality changing the mechanical form of the grading members or the interrelation of the parts forming such independently adjustable grading openings, thus as we claim coming directly within the line of decisions hereinbefore referred to and which may be summed up in the words of the Circuit Court of Appeals for the Second Circuit (*Cimiotti Co. v. America Co., supra*):

“The mere fact that there is an addition, or the mere fact that there is an omission, does not enable you to take the substance of the plaintiff's patent. The question is not whether the addition is material, or whether the omission is material, but whether what has been taken is the substance of the invention.”

The testimony of Mr. Knight, appellant's expert, in comparison of the Strain invention and defendants' machines, shows conclusively that every element of

claims 1 and 10 are present in the defendants' machines and that the latter have not varied whatever the mode of operation or principle of the Strain invention but have adopted and used it bodily. Mr. Knight testifies:

"Q. 12. Have you examined and are you familiar with the construction and mode of operation of the device of Complainant's Exhibit Parker Patent Number 997468?

A. Yes sir.

Q. 13. Will you please take the Complainant's Exhibit Patent in Suit and explain the mode of operation of the device of that patent, so far as the grading is concerned, and by that I mean eliminating from consideration the matter of the adjustable bottoms for the bins, and then compare the construction, elements and mode of operation of the device of this patent with the same in the Complainant's Exhibit Parker Patent, and in making this comparison you may make such reference as you desire to Complainant's Exhibits Photos 1, 2, 3 and 4.

A. In the grader shown in the Strain patent in suit, the fruit is supplied upon one end of the runway, one side of which is formed by the traveling rope or round belt and the other side of which is formed by the grading rolls so that by the motion of the rope or traveling belt the fruit is successively brought in contact with the successive rollers. These rollers are spaced in relation to the traveling belt so as to present an aperture between each roller and the belt, the width of these apertures increasing in the case of the successive rollers so as to increase sequentially from the beginning to the end of the series of rollers. When the fruit reaches an aperture which is sufficiently large it will pass through this aperture, and in this respect the operation is that of any successful grader, but the distinguishing characteristic in the operation of the Strain machine as shown in this patent is that the width of these apertures may be adjusted individually and independently for the different rollers so that any

desired variation along the length of the series may be obtained. Thus, in case an even grading of the fruit is desired, the rolls may be set so that each roller is spaced a definite distance further from the rope than the preceding roller, and if any variation is desired, these rollers may be set so that the excess of difference from the rope is less in some cases than in others, and in fact, as pointed out in the patent, page 2, lines 13 to 21, the rollers may be adjusted so that more than one of said rollers is adjusted to the same grade. While the operation of this machine, in a broad sense, is similar to any grader in which the fruit is presented successively to apertures of increasing width between the longitudinally movable member and the transversely movable member, it carries out this operation in a peculiar manner, in that it enables the width of the apertures to be adjusted independently of one another throughout the length of the series of rollers, so as to provide for any desired distribution of the grading by the rollers.

In the Complainant's Exhibit Parker Patent, and the Photos one to four, Complainant's Exhibits, the operation of the machine is as follows: The fruit is fed by a suitable supply means into the runway, one member of which consists of a longitudinally traveling belt and the other member of which comprises a series of rotatable rolls. These rollers are mounted adjustably, so that the distance between each roller and the other member of the runway, viz.: the traveling belt, can be adjusted independently and individually with the different rollers. As the fruit is carried along in the runway by the traveling belt, it is presented successively to contact with the successive rollers and passes through the aperture between the roller and the belt when an aperture is presented of sufficient width to permit of such passage. The adjustable mounting of the several rollers is such that the width of this aperture may be adjusted independently and individually for the several rollers so that any desired distribution of the grading may be provided for along the length of the grader. *In respect, therefore, to the characteristic feature of the Strain Patent, which I*

have above referred to, the manner of operation of the Parker machine is the same as that of the Strain machine. The Parker machine, however, includes an additional feature, viz.: the provision of what are called "guide arms," shown in the drawing by the numeral 36, which are affixed to the supports for the several rollers and overlap one another so as to form fixed walls between successive rollers. By means of these guide arms the adjustable rollers may be spaced farther apart or nearer together and may be shifted longitudinally of the machine, thereby providing for certain alleged advantageous results in distribution. These guide arms, however, do not affect the operation of the rotating or rotatable rollers per se, the operation of said rollers in connection with the traveling belt coming into play only when the fruit is in contact with the rollers and the fruit at that time being out of contact with these guide arms, so that the two operations are non-current and independent.

In other words, the guide arms serve the purpose of conducting the fruit from each roller to the next roller and are therefore idle as far as the grading operation is concerned; their function in connection with the longitudinally adjustability of the rollers along the runway is to provide for the determination of the several locations at which the fruit shall pass from the runway, thus the adjustment of the rollers is entirely by these guide arms, and the longitudinally adjustability of the rollers is therefore a question of location of discharge, in other words, distribution and not of size or determination of the grade or the several grades."
[Transcript, pages 117-122.]

In this connection we call attention to the testimony of M. R. Whiffin, who is superintendent of a number of orange packing houses and familiar with both the defendants' machines and the machine of the Strain patent. He summarizes his testimony in regard to the similarities of the two machines when the Strain machine does not have its independently-adjustable grad-

ing rollers power driven, as follows: "They are practically the same thing, one is horizontal, the other perpendicular." [Transcript, page 737.]

In the District Court the defendants contended that claim 1 had been limited in the prosecution of Mr. Strain's application for his original patent in response to the demand of the Patent Office. On pages 175-176 of the transcript the original six claims presented on behalf of Mr. Strain are set forth. Original claim 1 calls for a single roller. This was the construction shown in the "Ish" patent and used in the "Ish" or "California" machines, and as seen on page 178 of the transcript this original claim 1 was properly rejected and withdrawn in view of the "Ish" patent. Its cancellation has no bearing upon claim 1 of the re-issue patent in suit, as the substance of Mr. Strain's invention, as we have heretofore pointed it out, is not defined in this original claim 1, which do not call for a plurality of independent transversely-adjustable rollers such as shown by Mr. Strain and used by defendants. This original claim 1 does not call for such elements as embody Mr. Strain's real invention. Original claim 2 included "*a fruit-retaining bin below each roller, having an apron therein to break the fall of the fruit.*" This element is totally lacking in claim 1 of the re-issue and this omission shows that claim 1 of the re-issue and original claim 2 are for totally *different combinations*. Clearly present claim 1 of the re-issue is broader in terms than original claim 2, and the cancellation of said claim 2 did not amount to an abandonment of the combination thus expressly claimed in broad language in the substituted claim 1 of the re-issue. The com-

binations are different,—they are distinct entities in Patent Law. Original claim 3 called simply for making a roller transversely and independently adjustable regardless of all other elements utilized to make up a machine. Such a claim would cover the “Ish” or “California” machine, in which both ends of the stepped roller were mounted in adjustable bearings. Thus we again see that what we have heretofore found to be the substance of the Strain invention is not expressed in this claim, as the novel result sought and attained by Mr. Strain is not present in a machine in which one roller is adjustable.

Original claim 4 also calls for “a fruit-retaining bin below each roller.” In substituting claims for these original six claims Mr. Strain did not limit present claim 1 of the re-issue to “a fruit-retaining bin below each roller” or to any fruit bin or bins, and therefore a claim which calls for such bin beneath such roller has no bearing upon the scope of a claim for a different combination, expressed in a substitute claim, of which such bin construction forms no part or element and which is not limited by its terms to such a bin element. This original claim 4, like original claim 2, has no bearing whatever on the present claim 1 of the re-issue patent in suit.

Original claim 5 was drawn to embrace the bin construction *per se*, and has no bearing whatever on either claim 1 or 10 of the re-issue. Original claim 5 was not drawn to even the same general subject matter.

Original claim 6 is claim 3 of the re-issue patent and was allowed by the Patent Office on its first action or inspection of the original Strain application.

In substitution for these original claims 1-5, Mr. Strain, by his first amendment [Transcript, pages 180-181], redrafted three new claims. The first of these was claim 1, now under consideration as claim 1 of the patent in suit.

Is it not as fair to say that Mr. Strain submitted present claim 1 in substitution for his original claim 1 as that it was in substitution for any other of such claims? The essential difference between the original claim 1 and the claim 1 of the re-issue patent in suit is the limitation of the latter to a machine using a plurality of grading openings each having its individual and separately adjustable roller, thus setting forth in such substitute claim the substance of the Strain invention. Such substance was found to be patentably novel by the Patent Office.

That the foregoing construction of the action of the Patent Office in rejecting said original claims and of Mr. Strain in making the substitution of the new claims, including present claim 1, is correct, is definitely proven by reference to the "Remarks" of Mr. Strain's attorneys in submitting the substitute claims. They say: "Examiner cites Ish to show *a* stepped roller and Hutchins of 1891 to show an adjustment of *a* roller and Ellithorpe to show *a* soft bottom for a fruit bin. We desire to call Examiner's attention to the following points of difference between applicant's device and the references. If you apply Hutchins' adjustment to Ish's roller *you do not produce the same effect as can be produced with applicant's independently adjustable rollers.*" This is a recognition and affirmation of the very distinction which we have heretofore

brought out and an assertion that the substance of Mr. Strain's invention is as we have heretofore pointed out. These attorneys add: "In the first place Ish's rollers must have the steps thereof arranged with reference to the difference between the grades of the fruit being graded, and the roller will only grade that particular kind of fruit. If the roller is stepped for grading oranges it will not grade nuts. * * * *You can not apply Hutchins' adjustment to Ish's rollers and produce the same effect as can be produced with applicant's device.* Suppose that a closer adjustment *between the grades* is desired, *with applicant's device each roller can be adjusted to make that difference.* With Ish a new roller must be made. Suppose that one of the grades is all right in Ish and a change in the others is desired. One end or the other must be moved, which will throw the edges of the rollers out of line parallel with the other side of the guide and will make a guideway of the V-shaped steps." These remarks clearly point out as the substance of the Strain invention the individual and independent control of the various grading-openings and cannot consistently be claimed to indicate any intention on the part of Mr. Strain to limit himself to any details of construction but to claim broadly this substantive difference in the machines. We cannot find a peg on which counsel can consistently hang an argument that Mr. Strain has in any manner intentionally limited himself or estopped himself from asserting that he is entitled to a liberal construction of claim 1 of the patent in suit.

The contention in reference to claim 10 rests, we believe, on even less ground. Robert Strain made his

application for the original patent and after he had filed his application a man by the name of Charles Rayburn, of Visalia, Cal., also filed an application for patent on a fruit grader embodying precisely the same principle of operation, although showing somewhat different form of some of the mechanical devices utilized, the differences residing more particularly in the design and form of the brackets and adjustments for the individual rollers. By the inadvertence of the Patent Office Examiner [see Transcript, pages 211 and 212] no interference proceeding was instituted to determine whether Strain or Rayburn was entitled to the patent, and each patent was issued upon the claims as drawn by the different attorneys and showing the usual difference in phraseology found in the dictum of different men describing the same thing. Thereafter Robert Strain filed an application for a re-issue for the purpose of contesting the question of priority of invention with Mr. Rayburn, and in his re-issue application adopted, in addition to the claims already granted him, Mr. Rayburn's claims, to form the basis for the interference suit. The result of that suit or proceeding was a judgment of priority of invention in favor of Mr. Strain and the grant of the re-issue patent here in suit, embodying claim 10, which was one of the claims of the original patent to Rayburn. We contend that so far as this suit is concerned such claim must have the same liberal interpretation and construction placed upon it as contended for by Mr. Strain's attorneys in the "Remarks" just quoted, and that this claim 10 must be construed to cover broadly the substance of Mr. Strain's invention.

If we understand defendant's contention in regard to this 10th claim, it is that it must be limited to a machine in which the ends of the rollers are substantially abutting. This contention resting wholly upon the use of the term "end-to-end" as applied to the position of the rollers.

We do not believe that this contention has anything whatever to do with the fact that in the printed copy of this claim in the re-issue patent the three words of this phrase are hyphenated, for in the use of the term in the original Rayburn application [Transcript, page 575, claim 7] the phrase is written "end to end." The contention is based, as we understand it, upon an alleged estoppel by the proceedings in the Patent Office in the matter of the Rayburn application. As originally filed the Rayburn application contained six claims. [Transcript, page 567.] The original claim 1 simply calls for "*a series of sizing rolls independently adjustable to regulate the size of the discharge apertures.*" It does not express any relation of a belt and a roll forming a separating or grading opening and did not point out even this as the substance of the invention. So far as this original claim 1 of Rayburn's application is concerned the claim did not express a complete structure and called for no means whatever to co-operate with the rolls. This is of the utmost importance, as we shall see that Mr. Rayburn redrafted his whole set of claims in order to put them into better form and to express complete combinations, and it is not fair to compare the complete combination of claim 10 of the re-issue patent in suit with an incomplete combination

in which an attempt was made to claim something different from the substance of the Strain invention as it actually existed.

The criticism which we have already made of Rayburn's original claim 1 applies with equal force to his original claims 2, 3 and 4, in which no mention whatever is made of a longitudinally moving member or belt for carrying the oranges along, or any other device whatever; thus these original claims 1, 2, 3 and 4 of Rayburn's patent were not limited to a machine in which a traveling belt is employed, but the oranges might be permitted to roll down an inclined surface. All the claim calls for is a series of rolls independently adjustable, etc. The claims were entirely too nebulous to point out an operative or practical machine. They have, however, in appellant's opinion, no bearing whatever upon the limitation which defendants seek to read into claim 10 of the re-issue patent in suit.

Rayburn's original claims 5 and 6 are open to the same objections as before noted.

A more fatal objection, however, to all six of these original claims is that they did not point out whether the machine was to have these independent rollers mounted one above the other, so as to embody the principle of operation of the impractical machine shown in the prior patent to Hutchins, or whether the machine was to be one in which the rollers were mounted in longitudinal alignment or extension and in combination with elements to embody the mode of operation of the Strain invention.

In his first amendment Mr. Rayburn redrafts seven claims, which are claims four to ten of the Strain re-

issue patent in suit. These seven claims were immediately allowed by the Patent Office and the Rayburn patent issued.

It is to be noted that the Rayburn patent was granted by the Patent Office with the direct statement therein that Mr. Rayburn did not intend to limit himself. The specification says:

“Various changes in the form, proportion and the minor details of construction may be resorted to without departing from the principle or sacrificing any of the advantages of this invention; and I therefore reserve to myself the right to make such changes as fairly fall within the scope thereof.” [Transcript, page 593, lines 60-66.]

As said by this court in *Kings County Raisin & Fruit Co. v. U. S. Consolidated Seeded Raisin Co.* (182 Fed. 59, 64):

“Not only is there nothing in the specifications or claims to indicate that Pettit intended to limit his claims to the precise form described, but the contrary is indicated by the terms of claim 18, and by the language of the specifications, in which it is said that:

“‘Various modifications may be made in the construction shown in the drawings and above particularly described, within the purview of my invention.’”

But there is still another light to be thrown upon the term “end to end” as applied to the rollers by claim 10 of the re-issue patent in suit. Granting for the sake of argument that all that is contained in the proceedings in the Patent Office in the matter of Rayburn’s application is binding upon Mr. Strain and his successors in interest, a proposition of law to which ap-

pellant does not accede, but controverts, inasmuch as the alleged estoppel runs against Rayburn and was not the action of Strain and Strain was held to be the prior inventor and was entitled to a liberal interpretation of his claims, unless he has indicated his intention to limit his claims to the precise form,—still, why did Rayburn use the term “end to end”? It is a descriptive term. What did it describe and by contrast what did it exclude as not within the claim as formulated by him? The patent before him was the patent to Hutchins. [Transcript, page 506.] In the drawings of this patent Mr. Hutchins illustrated a theory of a machine in which the largest size of orange or fruit was first separated. If the fruit were smaller than this size they dropped through this grading opening onto a grading opening below, if of that size they rolled along to the end of the machine, if smaller they continued to drop through until they hit a runway of less opening than their diameter. Rollers are shown in this Hutchins patent, but such rollers are arranged one above the other. Mr. Rayburn then adopted the term “end to end” to distinguish between this arrangement of one above the other. Mr. Rayburn did not mean to limit himself by this term to the rollers abutting. That was not essential or any part of his invention. His invention embodied a mode of operation in which the oranges were carried in a horizontal plane on a belt and the extension of the rollers for his purpose must be end toward end as contradistinguished from superimposed or arranged one above the other. This is the true intendment of the use of this term, and in this same sense the term is equally apt when applied to the

disposition of the individual and independently transversely adjustable rollers of defendants' machines.

The most careful research of both the Rayburn and the Strain applications will fail utterly to disclose any necessity for narrowly construing either claim 1 or claim 10, and these claims should be construed to save to Mr. Strain and his grantees the substantial monopoly of the invention produced by him.

"The claims of a patent are to be fairly construed, so as to cover, if possible, the invention, and thus save it, if it be a meritorious one. In approaching a patent we are to look primarily at the thing the inventor conceived and described in his patent."

Mossberg v. Metter, 135 Fed. 99.

As to the rule in interpretation of claims of patents the Supreme Court says:

"The court should proceed in a liberal spirit so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language he has employed."

Klein v. Russell, 19 Wall. 466.

"Patents should be construed in a liberal spirit, to sustain the just claims of the inventor. This principle is not to be carried so far as to exclude what is in it, or to interpolate anything which it does not contain. But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether or not the inventor shall hold or lose the fruits of his genius and his labors."

Rubber Co. v. Goodyear, 9 Wall. 795.

As said by the Circuit Court of Appeals for the Seventh Circuit in *Columbia Wire Co. v. Kokomo Co.* (143 Fed. 116, 124):

“The object of the law authorizing the grant is to stimulate invention by this reward to the inventor. It must be administered in conformity with this liberal policy, as a wise exception from the common law against monopolies. So the exclusive privilege of the patentee must be protected to the full extent of his invention and grant.”

As said by the Circuit Court of Appeals for the Seventh Circuit in *Ide v. Trorlicht etc. Co.* (115 Fed. 137):

“Mere changes in the form of a device, or of some of the mechanical elements of a combination, will not avoid infringement where the principle or mode of operation is adopted.”

The most that can be said for defendants' machine is that one element of the combination has been improved, in that the individual and independently adjustable rollers can be also adjusted or slid longitudinally to vary the point at which the given grading opening is arranged, but this does not avoid infringement. The rule is:

“Where an element in a combination is improved, and yet performs the same function in the same way, the use of the combination is infringed.”

Foster v. Moore, 1 *Curtiss* 279.

It seems to appellant that the facts of this case fall squarely within the decision of the Court of Appeals for the Fourth Circuit in *Crown Cork & Seal Co. v. Aluminum Stopper Co.* (108 Fed. 866), in which it is said:

“The court will look through the disguises, however ingenious, to see whether *the inventive idea* of the original inventor has been appropriated,

and whether the defendant's device contains the material features of the patent in suit, and will declare infringement even when those features have been supplemented and modified to such an extent that the defendant may be entitled to a patent for the improvement."

Walker on Patents, section 349, says of combination claims:

"Such a claim is infringed by him who, without ownership or license, makes, uses, or sells any apparatus made up of enough of the described devices to produce the specified result, by the specified mode of operation."

As said by this court in *Los Angeles Art Organ Co. v. Aeolian Co.* (143 Fed. 880, 887):

"If the change introduced by the defendant constitutes a mechanical equivalent in reference to the means used by the patentee, and if besides being an equivalent, it accomplishes something useful beyond the effect or purpose accomplished by the patentee, it will be an infringement as respects what is covered by the patent, although the further advantage may be a patentable subject as an improvement on the former invention."

Mr. Strain's invention was not a mere improvement in detail. It involved an added principle and immediately after he made the invention it went into general use and was immediately adopted by the trade and public and has in fact totally superceded all the old machines. This is set forth strongly in the testimony of all the witnesses.

Mr. Stebler, the complainant, testifies:

"Q. 28. And to what extent since the introduction of the machine of Complainant's Exhibit Patent in Suit

have you been in and throughout the packing houses of California?

A. I have been passing to and fro between all of them either in consultation in my capacity as expert or actually furnishing them these improved machines.

Q. 29. Are you then sufficiently familiar with the orange grading and sizing machines which have been in use in California since 1902 to enable you to state what kinds of machines have been in general use?

A. Yes, sir.

Q. 30. To what extent then, since the introduction of the machine of Complainant's Exhibit Patent in Suit has the machine of said patent gone into use?

A. To the practical exclusion of all others.

Q. 31. When you say 'to the practical exclusion of all others,' what has been your own business experience in the placing of machines of this patent?

A. We have placed them in almost every packing house, not only in California, but elsewhere.

Q. 32. What became of the machines which had been in such packing houses?

A. If they had machines prior to that time they were discarded or thrown away almost invariably.

Q. 33. Have you yourself removed any of such old machines?

A. A great many of them.

Q. 34. What machine has become the standard machine in use in orange packing houses for sizing or grading oranges?

A. Machines of the type shown in Complainant's Exhibit Patent in Suit, having a separately and independently adjustable sizing member for each size or grade of fruit packed.

Q. 48. And to what extent have you put in graders or sizers of any other construction or mode of operation?

A. We have practically put in no others, since we began building these machines.

Q. 49. And based upon your observations on your various trips through the packing houses, what would you say in regard to the number of machines of other constructions which have been installed and used which

did not involve the independent, individual adjustment of the grades as set forth in the patent in suit?

A. There are practically none."

M. R. Whiffin testifies to the displacement of the California or "Ish" machines with machines embodying the Strain invention. He says:

"Q. 15. What was the reason, Mr. Whiffin, for changing from the California grader to the grader you have just referred to?

A. Because it was not practical in the sizing of our fruit.

Q. 16. In what respect was it not practical?

A. Because you could not set any independent size of roller.

Q. 17. Is the setting of each size of roller or grade then a desirable feature in the grading or sizing of oranges?

A. Absolutely, more so now, because the eastern buyers insist on it.

Q. 18. That feature is particularly desirable in order to keep a uniformity of pack, is it?

A. Certainly."

Defendants produced a number of the packers and superintendents of packing houses and the testimony of every one of them shows that *the Strain invention* has entirely driven the old style "Ish" or "California" graders and the old "rope" graders out of use. It is to be noted that although the Ish patent expired in 1908 and it became a free machine in August of that year, yet there has never been a single installation of one of those machines since that date by anyone. A few, less than half a dozen, have been shown to be still in existence. These are used as makeshifts when the regular equipment of Strain machines is for some reason inadequate to handle all the work or these old

California graders are used to size the "culls" which are not packed for the market. There never was a more complete case of an invention driving all other machines out of use than in the case of this Strain invention.

L. E. Tucker says he is the foreman of the packing houses of the Upland Citrus Association, at Upland, Cal. He is called by the defendants. They have one old California grader which is the only one left, *all the others have been displaced with Strain graders. They put in seven of these Strain machines.* The reason was "*it was better to set each size separate*" and they could not do this with the California grader. [Transcript, pages 235-6.] The one California grader that they have is not used in the packing house. It is outside of the packing house and used only for grading "culls,"—the oranges of a quality which are not shipped. [Transcript, page 238.]

T. C. Jameson, called on behalf of the defendants, testifies that the California graders that he originally had have all been displaced with machines embodying the Strain invention. [Transcript, pages 240-251.]

F. K. Adams also testifies to the displacement by the Strain invention of the California graders. [Transcript, page 258.] He testifies that it is advantageous to be able to adjust each grading opening independently. [Transcript, page 263.]

H. E. Walcott, called by the defendants, is a manager of orange packing houses at Pomona, Cal., for the Pomona Fruit Growers' Association; that said association and exchange have not put in any new California graders since 1902; that all the equipment they have

bought since that date has been graders employing the individual and independently adjustable rollers. These machines have all been made either by the appellant, under the Strain patent, or by the defendant, George D. Parker. He testifies that he has been around through the packing houses of California to a great extent and *that from 1902 to 1910 he does not know of a single instance of the installation of a California grader.* [Transcript, page 297.] The Pomona exchange alone has purchased either eight or nine graders during that time.

Each one of these witnesses for defendants testify that an individual or independent adjustment of the several grading openings could not be secured in the Ish or California grader.

In connection with the immediate adoption and general use of the Strain invention and the great utility of this independent and individual adjustment of the several grade openings, attention is called to Mr. Stebler's testimony:

"Q. 112. Will you now describe to us the mode of operation of the device of the patent in suit?

A. You refer to the Robert Strain patent, of course?

Q. 113. Yes, sir.

A. Well, in packing fruit for market, especially oranges, it has been found advisable to assort them for sizes as they come from the orchard, of course, greatly varying in size and I suppose for a number of years prior to my advent into it mechanical devices of various kinds had been employed for this purpose. I have already described the machine that I went to work with and pointed out one of its chief objections, which was inability to adjust and regulate the sizes of fruit as sorted by this machine, owing to its inherent construction. I have also noted the desirability of finding

some means to overcome this objection and when it was presented to me I was not slow in recognizing its value and availing myself of it. To describe the construction of this particular machine I will say that the fruit is fed in to it at one end from some suitable means and as it is carried along the machine the machine itself assort it into varying sizes which is accomplished by allowing the fruit to drop, roll or pass through the graduated apertures between the grading members. All prior machines of this character so far as I know employed this principle but it was the possibility of more completely regulating the sizes as produced by this particular machine that gave it its value and it was the only machine that had ever been placed up to that time in which these sizes could be separately regulated independent of each other, a *fact which was at once recognized by every orange packer. I might say its value in this respect was recognized at the same time also, so much so that it at once became not only the leading machine but about the only machine there was any demand or sale for and it has so continued to the present time.*

Q. 114. What, Mr. Stebler, is the reason for the requirement that the different grades be independently adjustable?

A. The reason is the different varieties of fruit will pack or fill a receptacle differently through a given sized aperture, hence the necessity of regulation here. This is not always equally true on all adjacent sizes and some will require more regulation than others. Then again, each and every packer being engaged in operating his own individual business, has his own caprices as to how his fruit is to be packed and he prefers means whereby he can control this absolutely himself rather than being bound by the caprices of the manufacturers of some given machine in which he is limited to the adjustments provided in this particular machine by the manufacturers and of which he cannot, of course, avail himself as far as he would like.

Q. 121. You say that you are familiar with the defendant's machine. Will you now compare its interrelation of parts and mode of operation of this machine

with the device of the Complainant's Exhibit Patent in Suit?

A. Having previously described the mode of operation of the patent in suit I will say that defendant's machine operates in practically the same manner. The fruit being fed onto that from one end from some suitable means and is carried along the grade-way until it comes in contact with an aperture between the grading members which will allow it to pass through. The grading members in defendant's machine, as in the patent in suit, being composed of a traveling belt and a series of end to end independently adjustable rollers.

Q. 122. Calling your particular attention to the parts marked '36' in Figure 4 of the Exhibit Parker Patent, and also illustrated and shown in Complainant's Exhibit Photo #3, what function do these parts perform in defendant's machine?

A. They merely close up the aperture in the grade-way between the grading elements.

It has been the utilization of Robert Strain's conception that the independent adjustment of the grading openings would give the operator the necessary control of the separation or grading that has caused the Strain and the Parker machines to go into such extended use and to thus totally supplant all other machines.

This proof conclusively shows that the Strain invention was not a mere improvement in detail but was an invention of far-reaching effect and striking novelty, and it should appeal to the court as entitled to liberality at its hands, and in view of the widespread utility and adoption of the invention the court will without question give the patent in suit such degree of liberality in its interpretation of the terms as will secure to the owner of the Strain patent the substantial monopoly of the invention produced by Mr. Strain. This is the

true rule of law, and tested by this rule the defendants' machines are infringements.

The best proof that Robert Strain's invention was not obvious resides in the fact that although from 1891 to 1900 the Ish or "California" graders were in general use and likewise the "rope" graders were in use, no one produced this now seemingly simple but extremely valuable invention, yet the record in this case shows numerous unsuccessful attempts of inventors to produce a successful and practical grader. Appellant himself was engaged for years prior to Robert Strain's invention in the manufacture of the "rope" and of the "Ish" or "California" graders, and is an inventor as well as a skilled mechanic and manufacturer, and it was not apparent to him and he never discovered this invention until Robert Strain produced it, although Mr. Stebler was familiar with all the patents set up by defendants and had been familiar therewith prior to Mr. Strain's invention and none of them suggested it to him. [Transcript, pages 612-619.]

Consideration has been given to the "rope" grader, both as exemplified in the Woodward and Cerruti patents, and to the "Ish" or "California" grader, both as illustrated and shown in the Ish patent and as modified by manufacturers. The only other "prior art" introduced by defendants is contained in copies of letters patent describing the theories of inventors, which theories have never proven practical and which have never had any real standing in the art. Their machines have never been commercially used and the patents are most purely mere "paper" patents. They are entitled to little, if any, consideration, but even if

they were given full credit as practical machines no one of these prior patents either illustrates the principle of the Strain invention or described the substance of the Strain invention. None of these prior patents has any bearing on the scope of claims 1 and 10 as construed by appellant. There is nothing in such paper art to require or justify this court in narrowly construing said claims and limiting them to the exact construction shown by Mr. Strain in his drawings.

Appellant's expert, Mr. Knight, in his testimony, summarizes these patents, in brief, as follows:

"Defendants' Exhibit 'Nelson Patent,' being Letters Patent Number 713,484: This is a machine for sorting fruit according to quality, and the sorting operation is performed by an attendant, the machine not being an automatically operating sizing machine. I find nothing in this patent bearing on the principle of operation of either the Strain machine or the Parker machine.

Defendants' Exhibit 'Hutchins Patent,' being Letters Patent Number 456,092. This is called an assorting machine, but it is actually a sizing machine, and it sizes by passing the fruit along between a longitudinally moving member and a roller, the roller being provided with ribs. The machine comprises a series of superposed elements, two being shown, there being a grading element for each size of fruit. In regard to the operation of any of these elements, the principle of operation is similar to that of the rope and roller graders in general, for instance, the California grader, the Strain grader and the Parker grader, but as a complete machine, comprising a series of end to end elements, the machine is different in that the elements are arranged one above another instead of end to end. This is a good point in regard to compactness, in fact is what the man is driving at, but it is fatally defective on one important requirement of a successful grader, viz.: longitudinal extension in such machine so as to

provide for delivery to packing bins. I therefore conclude that in regard to any single element the principle of this machine is similar to that of the Strain and Parker graders, but in regard to the machine as a whole, *its distinctive principle is different*. I would add that this machine would not be adapted to grading oranges for the reason that the ribs on the rollers would mutilate the fruit so as to render it useless, but in so far as it would work with anything its principle would be the same.

Q. 39. You have referred to the fact that in this exhibit, Defendants' Exhibit "Hutchins Patent," the grading elements are superposed one above the other, while, as you have stated, the grading rollers, constituting the grading element of the patent in suit and of defendants' machine, are arranged end to end. Does this construction illustrated in this Hutchins Patent throw any light, in your opinion, upon the meaning of the term "end to end," as used in the patent in suit?

A. Yes sir. I think that this construction is an example of a construction other than end to end; that is to say, the successive grading elements are not displaced endwise in relation to each other, but transverse; this is to say, one above another. I would like here to call attention to another defect in this construction of Hutchins, which is overcome by the end to end construction. Each grading element of the Hutchins device discharges a portion of the fruit over the end and another portion passes through between the two members of the grading element. Now the portion that passes over the end in the Hutchins device is the separated portion sized by that element and the portion which passes through to the next element is the portion which is not sized or graded by that element. Consequently, if a large number of such elements were used, such as is required in orange packing, the fruit which passes onto the last grading elements would have to pass through all of these grading devices, that is to say, between each set of rollers and belts successively, being subject to a correspondingly great amount of wear and tear in the operation, whereas, with the end to end arrangement, the fruit which passes

through between the two members of each grading element is immediately removed from the machine and does not have to undergo this grading operation again and the other fruit, which does not pass through simply runs to the next grading element.

Q. 40. The oranges would drop by gravity through from one grading element to another in this Hutchins device, until it found the roller and belt which formed an opening slightly less than its size, would it?

A. Yes, sir.

Q. 41. And in your opinion, the successive falls of the oranges in that machine would be a deteriorating agent inducing decay in the oranges?

Mr. Acker: Objected to as leading in the extreme, furthermore, this witness has repeatedly testified that he is not qualified to testify as an expert in regard to the orange industry.

A. Yes, sir.

Defendant's Exhibit "Bailey Patent," being Letters Patent Number 671,646. This is a fruit grader comprising a series of grading elements, each element being double and one member on each side consisting of a vertically adjustable plate carrying a series of discs, the other member of each grading element consisting of the corresponding portion of a rotary disc or ring having inclined or beveled edges so that as the fruit is delivered up onto the ring it is carried on by the ring into contact with the discs "12" of the successive sections and the supporting plates of these discs are adjusted so that the aperture between the rotating carrying discs and the disc carried by the adjustable plates increases in steps, the fruit passing through as soon as it reaches an aperture of sufficient size. In regard to the broad principle of operation, this machine is similar to the California, the Strain and other rope and roller graders. It has, however, inherent defects, which, in my opinion, prevents it from being an equivalent for any of these other straight line graders, its rotary motion leading to inherent difficulties in operation. To secure any considerable capacity in the machine, it would have to be given a considerable angular velocity and this would result in an appreciable cen-

trifugal action on the fruit, tending to increase the outward pressure on the outer side of the machine and decrease the discharging pressure on the inner side; furthermore, this circular shape renders it necessary to use a large number of discs "12" for each section and this does not give a smooth bearing face for the fruit.

Q. 43. In your opinion, Mr. Knight, based upon your observation of fruit graders and your knowledge of oranges and the orange industry, as heretofore testified by you, would or would not a device built in accordance with defendant's exhibit "Bailey Patent," be a practical commercial machine for sizing oranges?

Mr. Acker: Objected to as incompetent, irrelevant and immaterial and on the further ground that the witness has not been shown to possess the qualifications necessary to testify to such fact.

A. My opinion is that it would not be a practical commercial machine.

Defendant's Exhibit "Hutchins Patent No. 2," being Letters Patent Number 465,856. This is similar in construction and operation to the Hutchins patent, above described, and open to the same comments.

Defendant's Exhibit "Huntley Patent," being Letters Patent Number 538,330. I find no special similarity between the construction shown in this patent and that of either the Strain or the Parker machines. The fruit runs by gravity along a guide-way under a roll which is spaced from the guide-way so that the space gradually increases and the fruit is ejected from the guide-way by the friction of the roll moving in such direction as to lift the fruit over the side of the guide-way. This is not the principle of operation of either the Strain or the Parker machines.

Defendant's Exhibit "Burke Patent," being Letters Patent Number 482,294. In this machine the grade-way is formed by two stationary members, each of which is stepped and the fruit is drawn along between said members by a belt carrying fingers, which extend up into the grade-way and push the fruit along. This is not the principle of operation of either the Strain or the Parker machines.

Defendant's Exhibit "Jones Patent No. 2," being Letters Patent Number 442,288. This is strictly a roller machine, the grade-way being formed on one side by a roller, a rotating roller having a series of stepped sections and on the other side by a stationary member which serves as a fixed wall. There is no longitudinally moving member for conveying the fruit along the grade-way and presenting it successively to the different sections or rotating members and the principle of operation is therefore different to that of either the Strain or the Parker machine.

Defendant's Exhibit "Jones Patent," being Letters Patent Number 430,031. This is similar to the Jones Patent Number 442,288, and the same remarks apply.

Defendant's Exhibit "Ish Patent," being Letters Patent Number 458,422. This is the typical rope and roller grader, Ish showing a belt, but stating that he may use a rope. The principle of operation of this patent is that of carrying the fruit by the operation of the longitudinally moving member along the grade-way and presenting it successively to contact with successive roller sections of different diameters so that as soon as it reaches an aperture of sufficient size it will pass through. As far as concerns the act of grading the fruit in any one section, the Ish operation is similar to that of the Strain and Parker machines, but as regards a complete machine providing for the grading of a number of sizes, the machine is different in that the several grades are provided for on a solid roller having stepped sections which sizes are predetermined and invariable. In the machine as illustrated then, there is no provision for individual or independent adjustment or variation of the sizes of successive sections so as to give any desired variation of the grading along the grade-way.

Defendant's Exhibit "Ellithorpe Patent," being Letters Patent Number 399,509. I find nothing in this patent requiring comment as it is of the gravity table type in which the fruit is sized by passing over a table with differently sized holes.

Defendant's Exhibit "Maull Patent," being Letters Patent Number 673,127. This is a rotary grader hav-

ing a central wheel forming the inner member of the grade-way and an outer curved gauge, preferable of volute shape, which forms the outer member of the grade-way, a series of spouts being arranged directly below the grade-way so that as the fruit is carried around by the rotation of the wheel it will fall through between the inner and outer members of the grade-way as soon as it reaches a point where the space is sufficiently great and will fall into the corresponding spout. This is somewhat similar to the Bailey Patent in general principle of operation but it does not have separate sections of the outer member and does not appear to me of any special interest in this connection.

Defendant's Exhibit "Fleming Patent," being Letters Patent Number 475,497. The principle of operation of this machine is entirely different from that of the Strain or Parker or any rope and roller grader, the fruit being carried along by a belt and falls through apertures whose size are controlled by tilting flaps which are let down gradually by passing over an incline.

Defendant's Exhibit "Jones Patent of 1894," being Letters Patent Number 529,032. This is a machine of the rotary type operating by gravity, the grade-way being formed by two concentricly mounted rotating members and the weight of the fruit causing the members to turn so that the fruit is carried through the grade-way from the portion of less width to portions of greater width. I see no special resemblance between this and the Strain or Parker machines.

Defendant's Exhibit "Woodward Patent," being Letters Patent Number 466,817. This is a rope grader, the grade-way being formed by two ropes mounted so that the space between them diverges gradually and the fruit being carried along by the ropes and falling through as soon as it reaches a point of sufficient separation. There is no provision for individual or independent adjustment or variation of successive portions so as to provide for variation in grading and the machine is in that respect different from the Strain and Parker machines as well as in the general respect of being a rope grader instead of a rope and roller grader.

Defendant's Exhibit "Cerruti Patent," being Letters Patent Number 534,783. This is also a rope grader and the same remarks apply to it as to the Woodward patent."

This testimony clearly shows that the substance of Mr. Strain's invention is not disclosed in any of these paper patents and that from none of them would any manufacturer nor did any manufacturer or fruit packer secure the slightest hint of the substance of Mr. Strain's invention. The profert of these patents in this case is aptly characterized by the Supreme Court in *Carnegie Steel Co. v. Cambria Iron Works* (185 U. S. 425):

"This defense presents the common instance of a patent which attracted no attention and was commercially a failure, being set up as an anticipation of a subsequent patent which has proved a success, because there appears to be in the mechanism described a possibility of its having been, with some alterations, adaptable to the process thereafter discovered."

These paper conceptions which have never been practically used are in fact nothing more than mere abandoned experiments. They are experiments which have never gone even beyond the paper stage. It is well settled that

"The unsuccessful experiments of others tend to show the exercise of inventive genius by the one who first produced a successful result."

Ham Co. v. Deitz, 13 C. C. A. 690.

Mr. Knight's testimony is not contradicted by any witness in this case. It stands unimpeached. On the other hand it is corroborated in essential matters and

details by the testimony of Mr. Stevenson [Transcript, page 765]. and Mr. Stebler [Transcript, pages 612-619, 721-723].

In urging Your Honors to protect Mr. Strain's real invention according to the true scope thereof and to construe the claims according to their terms and thus embrace the substance of Mr. Strain's invention, we submit, in the language of this court, in *Parker v. Stebler* (177 Fed. 214):

“We think, in view of the prior art, that the Bryan (Strain) invention marked a distinct step in advance, whereby a notable success was achieved, and that its claims are entitled to a fairly liberal construction.”

His Honor Judge Wellborn, in the District Court, announced his decision orally at the conclusion of the argument and, although counsel for the parties for their use had the decision taken stenographically and reduced to typewriting, no copy thereof has been filed in the case or appears in the record. If counsel for defendants wishes we will not object to the presentation of such report of Judge Wellborn's decision. We do not quote it, not having had an opportunity to consult with opposing counsel in regard thereto. It was very short and did not discuss in detail the issues of the case, simply announcing His Honor's conclusions.

A careful consideration of the defendants' machines demonstrates that they embody every element of each of the claims sued upon. The only difference existing between defendants' machines and the Strain invention, as illustrated in the patent in suit, is the lengthening

out of the machine by the interposition between the grading openings, formed by the individual and independently adjustable rollers and belt, of the telescopic arms which are provided in defendants' machines for what the Parker patent asserts to be an added patentable function, but it is clear that in the separation of fruit, in the control of the grading openings as to size of fruit to be separated thereby, as to the mode or principle of operation in the separation as to sizes, the defendants' machines are practically identical in mechanical elements and in the interrelation of such elements and are identical in the way they co-operate, employing only well known equivalent forms of the adjusting devices and roller-supporting brackets.

For these reasons the defendants' machines infringe the claims and it should be so decreed.

FREDERICK S. LYON,
Solicitor, and of Counsel for Complainant-Appellant.

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

FRED STEBLER,

Appellant,

VS.

RIVERSIDE HEIGHTS ORANGE
GROWERS ASSOCIATION (A
CORPORATION) AND GEORGE D.
PARKER,

Appellees.

No. 2232

BRIEF AND ARGUMENT ON BEHALF OF APPELLEES.

At the outset we desire to state that the appellees, defendant below, introduced in evidence in the case a large number of exhibits showing the prior art as disclosed by the patent records, and structures exemplifying certain devices admitted to have been in use for many years prior to the date of the invention covered by the letters patent in suit.

STATEMENT OF THE CASE.

The present appeal is from an order of dismissal on Final Hearing made and entered on the 30th day of September, 1912, by the United States District Court, Southern District of California, Southern Division, in the suit entitled Fred Stebler (appellant herein) vs. Riverside Heights Orange Growers Association and George D. Parker (appellees herein), No. 1562, adjudging claims 1 and 10 of United States Reissue Letters Patent No. 12297, granted Robert Strain, December 27, 1904, for an improved Fruit Grader, not to have been infringed by the Fruit Grader manufactured and sold by George D. Parker (one of the appellees herein) and placed into use by the Riverside Heights Orange Growers Association (the other appellee herein).

The appellees admit title to the letters patent in suit to be vested in appellant.

The assignments of error on appeal (page 791 of the record), though four in number, are referable to two general errors, to wit:

A. Error in dismissing the Bill of Complaint.

B. Error in not holding claims 1 and 10 of the Reissue letters patent in suit or either of said claims to have been infringed by the appellees herein.

The defenses raised in the lower court were:

1. Invalidity of the inventions involved in claims 1 and 10 of the Reissue letters patent in suit by reason of anticipation of the combination called for by said claims.

2. Non-infringement on the part of the defendants (appellees herein) of the invention called for by

either of the mentioned claims of the Reissue letters patent in suit.

The decision of the lower court was rendered by his Honor Olin Wellborn, after an extended argument, four days having been allowed for argument, viz.: September 12th, 13th, 16th and 17th. The Court, after having heard the pleading and proofs and arguments of counsel, and having duly considered the same and being fully advised in the premises, rendered an oral decision on the 17th day of September, 1912. While the decision of the Court does not appear in the record of the case, the following is a true copy of the same as taken down by the stenographer present in Court for such purpose.

DECISION OF THE LOWER COURT.

“Mr. Lyon has made things clear to me, as he always does, and I may say further, from a number of years’ experience with him as a patent lawyer, I find that he combines to an uncommon extent fine mechanical ingenuity and skill with a broad and accurate knowledge of patent law principles, and for that reason his conclusions, when reached after consideration, always demand my most respectful attention. Sometimes I agree with him and sometimes I do not. This is one of the instances where I do not agree with him as to the question of infringement.

“To my mind, the device constructed under the Strain Patent and that under the Parker Patent, or rather the Parker device, the Parker Patent not being involved in this suit, are different substantially, are mechanically different. I am satisfied that it might be said that the con-

struction is different, growing out of this fact, that Mr. Lyon's last remark called my attention to: that it is true that these guide arms in a Parker machine perform exactly the same function in the Parker device that they do in the Strain Patent, that is, so far as constituting one member of the runway, but there is something more to that guide arm. It is a part of Parker's invention by which he gets an enlarged bin capacity. It is a part of the end adjustability of the guide arms and they perform a function in the machine that Parker manufactures which in my mind differentiates it very materially from the Strain Patent. That feature, the end adjustability by reason of the spaces between the rolls in the Parker device and that in the Strain device, it seems to me makes them different and prevents the latter from infringing upon it.

"I think it is all described here in the first claim of the Strain Patent: 'In a fruit grader, in combination a plurality of independent transversely-adjustable rotating rollers; a non-movable grooved guide lying parallel with the plane which passes vertically and longitudinally through the center of said rollers, said rollers and guide forming a fruit runway.' (The Court emphasizing the words 'said rollers and guide forming a fruit runway.') That is the fixed member and the roller form a runway. That, in my mind, cannot be fairly said of the Parker Patent. Parker has introduced these guide arms, which Mr. Stebler and Mr. Lyon denominate here 'the space fillers.' They are something more than that. They are a part of the device for getting that increased room where there is an excess of oranges of one size.

"I don't think that feature—in the Strain Patent one element is that the roller and guides shall form a fruit runway. That is not true in the Parker invention. He has introduced the guide arm in that machine and they have an

apparent function to perform aside from forming a part of the runway.

“Claim 10 recognizes the rollers to be end to end rollers, but in that particular I don’t see that there is any difference between 1 and 10, because one contains the expression that the rollers and guide form the fruit runway.

“I will not take further time to express my opinion on that. I have listened to both of you with a great deal of pleasure. The bill will be dismissed. Fortunately, the record is in such shape, however, that it will be easy to have a review of my opinion and I am always glad to have my opinions reviewed and will do anything I can to assist you in this case.”

From the above it will be noted that the lower court differentiated the device claimed to be an infringement (hereinafter termed the Parker Machine) by reason of the fact that—

(A) The Parker Machine performed a function entirely different and distinct from that accomplished by appellant’s patented machine.

(B) The Parker Machine does not embody the principle of operation called for by the grader of the Reissue letters patent in suit.

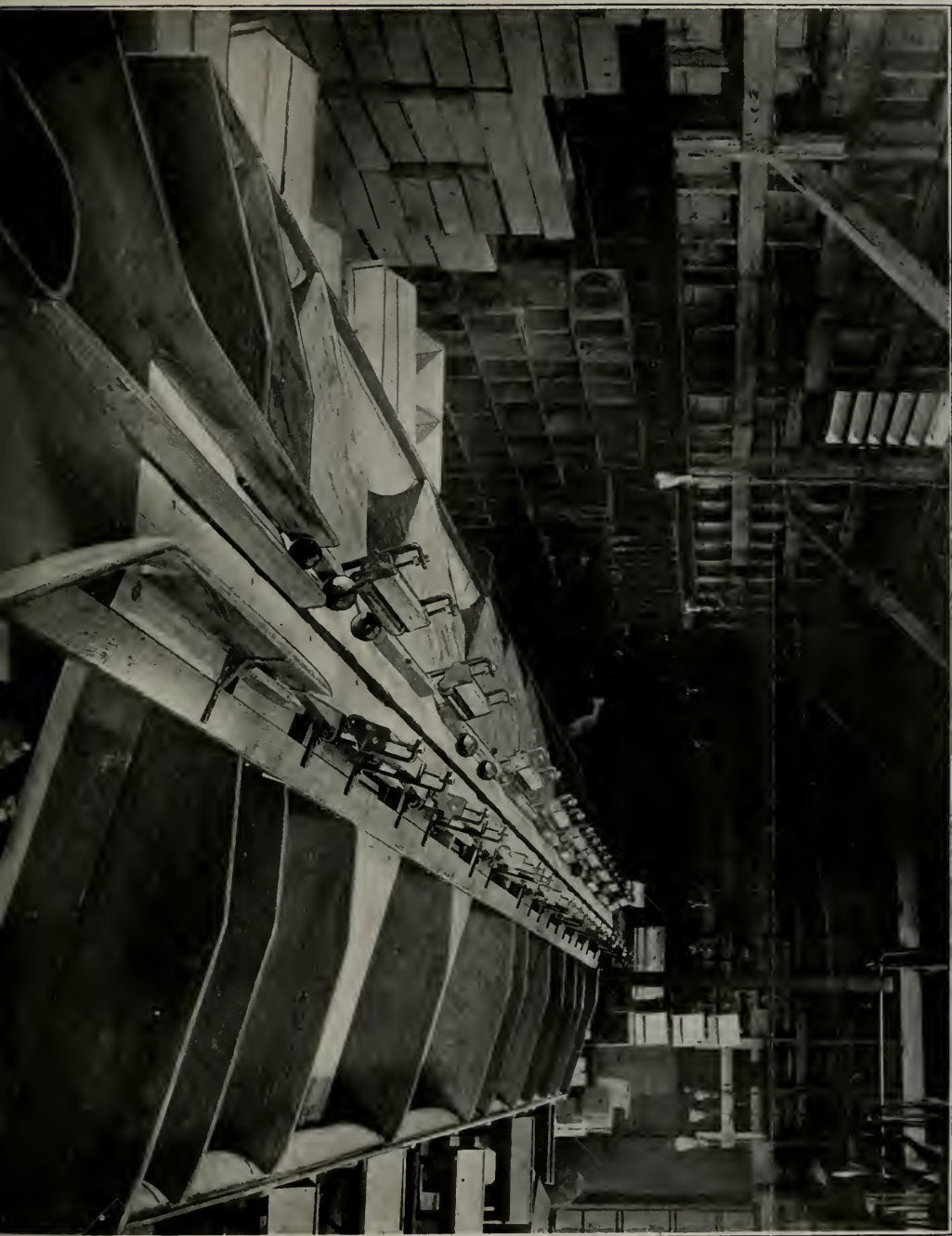
(C) The Parker Machine does not embody in its structural arrangement and working parts the combinations of inter-working elements called for by the combination embraced in claims 1 and 10 of the Reissue letters patent in suit.

(D) That claims 1 and 10 of the Reissue letters patent in suit are restricted in their scope to the end to end arrangement of the rollers forming the rotary member of the fruit runway of the grader.

Before giving consideration to the patent in suit, we deem it advisable, at this time, as matter of interest and in order that the position which the fruit graders occupy in connection with the fruit packing houses, to present a cut of each machine involved herein, and on the opposite page is a cut illustrating one of the appellee's machines situated within one of the fruit packing houses of Southern California, the cut being made from a photograph of the grader as actually installed and placed into operation.

This cut clearly illustrates a series of aligned non-rotary grading units, which constitute the outer wall of the runway for the fruit and against which the fruit impinges as carried through the machine, the traveling belt for propelling the fruit, the bins for receiving the sized fruit as discharged from the controlled openings of the grading units, and the guide arms extended from each of the separated grade units. It will be noted that this Grader (known as the Parker Machine) is not provided with a continuous substantially unbroken outer rotary wall member for the fruit runway; that in the structural arrangement of its working parts there is no provision for a rotary member composed of *end to end* grading rollers constituting an outer parallel member of the fruit runway; in fact, no such rollers being utilized in the machine, and further there is no provision made for a non-movable grooved guide, mentioned in the patent in suit as constituting one of the parallel members of the fruit runway.

The only rotary element employed in the Parker machine consists of the small roller situated within the discharge opening of each grade unit frame, the



Stebler machine

NO
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same being adjustably held therein, and serving as an elastic buffer or cushion for preventing injury to the fruit as passed through the sized opening of the grade unit frame. This machine is protected by United States Letters Patent, and the working and construction thereof will be fully considered later on.

We also illustrate by cut from a photograph taken of one of the Stebler graders of the patent in suit as installed by appellant in one of the packing houses in Southern California. A mere glance is sufficient to show that the machine is constructed exactly as called for by the drawings, description and claims of the letters patent. There is present the non-movable grooved guide called for by the letters patent in suit, the rope working in the groove thereof, the outer rotary member consisting of a plurality of *end to end* rollers, and the individual belts for positively driving each of the rollers for imparting rotation thereto. The non-movable grooved guide lies parallel with the plane which passes vertically and longitudinally through the center of the series of end to end rollers comprising the outer rotary member of the fruit runway, and the said grooved guide and the parallel series of end to end rollers constitute the fruit runway of the machine, each of the end to end rollers being positively driven by the drive belts disclosed in the cut.

Comparing the cut of the Stebler (appellant's) machine with that of the Parker (appellees) machine, it is noticeable that the latter differs structurally from the former in every respect. There exists no similarity between the machines, neither do they operate on the same principle. However, these fea-

tures will be considered more fully hereinafter, the cuts being given at this time merely that the general arrangement and appearance of the machines may be understood.

PATENT IN SUIT.

The alleged invention of the letters patent in suit relates to an apparatus for the grading of fruit, and before attempting an analysis of claims 1 and 10, we must fully understand the specification of the letters patent in suit in order to comprehend the meaning and import of the said claims.

The Reissue letters patent in suit—complainant's Exhibit "Patent in Suit"—is found on pages 164-168 of the printed record. The apparatus therein disclosed relates to an improvement in graders, and the invention covered thereby as we are told by the specification "relates to that class of graders designed to assort fruit, vegetables, such as potatoes, and nuts into lots of different sizes; and the objects thereof are to provide a machine for that purpose which is adjustable to a number of grades and which will prevent the fruit from bruising or being crushed."

The invention is thus set forth for the grading of fruit generally, its use not being restricted to any given class of fruit. Attention is directed to this phase of the case at this time, due to the fact that throughout the whole course of the case there has been a studied effort on the part of appellant to build up a claim of invention for the patented grader by reason of the fact that its use has been applied to

the grading of oranges, and by such claimed use for the machine the endeavor is made to dispose of any prior patent designed for the grading of fruits, vegetables, and nuts into lots of different sizes, where such prior patented devices are not shown as being employed for the grading of oranges. Such was the main contention in the lower court against the pertinency of many of the references as anticipatory matter, and we apprehend the same line of argument will be followed at this time. An answer to any such contention is found in the fact that the patentee Strain did not so restrict the use of his alleged invention, for, as above pointed out, he wished the machine to apply to the grading of all kinds of fruits, vegetables and nuts. In fact, the only mention of the word "oranges" is found in the statement, "In orange grading there are usually nine grades," and this statement is only expressed to advise as to the usual number of grades into which one class of fruit is usually divided.

The patent itself defines the fruit grader as being composed of two parallel members, viz.: an inner non-movable grooved guide in the groove of which works an endless rope for propelling the fruit through the runway of the grader, and an outer rotary member comprising a series of longitudinally disposed rollers. The non-movable grooved guide and the series of longitudinally disposed rollers form the fruit runway of the grader. The rollers constituting the outer wall or outer member of the parallel members of the fruit runway, are known as power driven rollers, that is, each roller is driven from a power shaft by means of a power

transmitting belt, the power shaft being driven from the drive means which actuates the endless conveyor rope working in the grooved non-movable guide member of the fruit runway. It is essential that the rollers of the grader of the patent in suit be power driven in order to force the fruit passing through the runway into and through the proper grade space, and it is absolutely essential for the proper working of the patented machine to conform to the disclosure of the patent in suit that the rollers constituting the outer member of the runway be disposed end to end, in order to produce substantially an unbroken rotary outer wall member for the runway.

For convenience, a cut of the drawings forming a portion of the Reissue letters patent in suit is herewith presented.

A description of the grader illustrated is set forth in the specification as follows:

Fig. 1 is a perspective view of a fragment of my machine arranged for grading oranges or lemons. Fig. 2 is a cross-section.

In the drawings, my machine is designed as a double grader—that is, two graders arranged side by side on the same frame, one side being a duplicate of the other side.

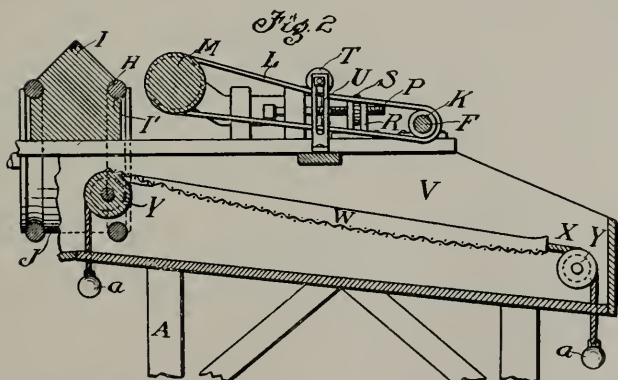
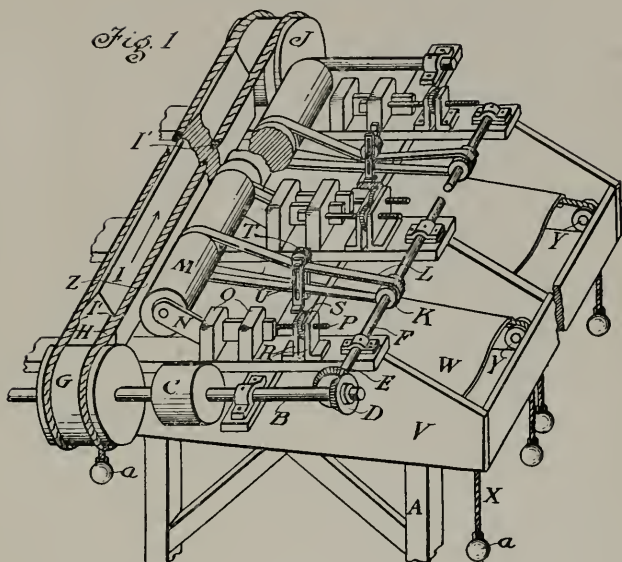
A represents the frame of the machine, on the top of which at one end of the machine, preferably at the upper end, is transversely mounted the driving-shaft B, carrying the driving-pulley C, by means of which motion is imparted thereto. When arranged as a double grader, on each end of the driving-shaft is rigidly mounted driving bevel-gears D, which mesh with driven bevel-gears E, rigidly mounted on the longitudinally-extending driven shafts F. On the driving-shaft is rigidly mounted the rope-

No. 12,297.

REISSUED DEC. 27, 1904.

R. STRAIN.
FRUIT GRADER.

APPLICATION FILED OCT. 21, 1903.



Witnesses:

William H. H. H.

Fredrick H. H.

Inventor:

Robert Strain

by *Townsend Bros*
Attys.

driving drum G, which imparts motion to ropes H, which travel in the direction indicated by the arrow in Fig. 1, that is, from head to the foot thereto, in grooves I¹ in guide I, which forms one side of the fruit runway. These ropes pass over pulley J at the lower end of the machine. On the driven shafts F are rigidly mounted a number of driving-pulleys K, which drive belts L, that pass around the grading-rollers M, which are revolvably mounted in adjusting-arms N, which have a longitudinal movement in guide-blocks O, affixed to the top of the frame. To each of these adjusting-arms is affixed a threaded bolt P, which passes through two stop-blocks R, between which is an adjusting-nut S on bolt P in threaded contact therewith, by the rotation of which the grade-rollers are moved toward or from the guide. Affixed to the top of the frame are band-tighteners to tighten the bands when the grade-rollers are moved away from the guide. These band-tighteners are formed of a pulley T, adjustably mounted in slotted uprights U, affixed to the frame. Below the grade rollers are as many bins V as there are grade-rollers, which are adapted to hold the fruit which will pass between the grade-roller and the guide. In order to prevent the fruit from being bruised, in each bin is mounted an apron W, of strong cloth, the inner end of which is higher than the outer, so that the fruit will roll to the outer end of the bin, where it has but a short distance to fall to reach the bottom of the bin. Each edge of these aprons is fastened to a rope X, which passes over small pulleys Y, affixed to the side of the bin, and each end thereof has a weight *a* to hold the apron taut and to keep it in position. In the operation of my machine the first roller, or that nearest to the shaft B, is adjusted so as to permit the smallest grade of fruit to pass between the roller and the guide. The next roller is adjusted for

the next larger grade, and so on for each successive grade. In orange-grading there are usually nine grades. Motion is imparted to the driving-shaft to cause a rope H to travel in a groove I¹ in guide I in the direction indicated by the arrow. This causes the grade-rollers to revolve so that the top of the roller travels away from the guide. The fruit is fed into the runway between the guide and the grade-rollers by any suitable device (not shown) in the usual manner.

It will be observed that as the grade-rollers are adjustable the distance between the roller and guide can be made small or large to adapt the machine to grading small nuts or fruits or large nuts or large fruits. It will also be observed that the ropes carry the fruit toward the lower end of the machine and at the same time the grade-rollers are revolving, so as to keep the fruit from sticking in the runway, thereby avoiding any tendency to crush the most delicate fruit. It will also be observed that the inner end of the apron gives a soft yielding surface for the fruit to fall upon a short distance below the roller, thus preventing any danger of its bruising. As the fruit rolls to the outer end of the apron it falls into the bottom of the bin, and as the end fills up the apron can be moved toward the inner end of the bin, the weights providing for such adjustment. The fruit is packed from the outer end of the bin. By having short grade-rollers separately adjustable very fine grading may be done and more than one roller may be adjusted to the same grade, if desired. If there should be a large quantity of the fruit of a single grade intermixed with a small quantity of fruit of different grades, this feature is very desirable, as a number of bins may be filled with fruit of the same grade.

THE CLAIMS, BASED ON THE PATENT ALONE.

The said Reissue letters patent contain ten claims, but in the present action infringement is alleged only as to claims 1 and 10, which read as follows:

1. In a fruit-grader, in combination a plurality of independent transversely-adjustable rotating rollers; a non-movable grooved guide lying parallel with the plane which passes vertically and longitudinally through the center of said rollers, said rollers and guide forming a fruit runway; a rope in the groove in said guide and means to move said ropes.

10. In a fruit-grading machine, a runway formed of two parallel members, one of said members consisting of a series of end to end rolls, brackets carrying the rolls, guides for the brackets, and means for adjusting the brackets upon the guides, substantially as set forth.

Taking each of these claims separately, we find claim 1 calls for the following elements in combination:

1. A plurality of independent transversely adjustable rotating rollers.

2. A non-movable grooved guide lying parallel with the plane which passes vertically and longitudinally through the center of said rollers.

3. That the rollers and guide shall form the fruit runway.

4. That a rope shall travel in the groove of the non-movable guide and means be provided for moving said rope.

Claim 10 calls for a fruit grading machine comprising the following combination:

1. A runway formed of two parallel members.
2. One of said members is required to be formed of a series of end to end rollers.
3. Brackets carrying the rollers.
4. Guides for the brackets.
5. Means for adjusting the brackets.

Referring to the drawings of the specification of the letters patent, we are told that the rotating member forming the outer member of the fruit runway mentioned in claim 1 as a "plurality of independent transversely adjustable rotating rollers" comprise a series of end to end rollers, that is, the end of each successive roller substantially abuts the end of a preceding roller so as not to leave what has been termed in the testimony "a non-available grading" space between the rollers. In other words, the arrangement is such that fruit leaving one roller of the rotary member of the fruit runway immediately moves onto the next roller, and so on throughout the length of the grade or fruit runway. The specification states that there is a roller for each grade of fruit, consequently, where employed in connection with the grading of oranges nine end to end grading rollers are employed. Without question, from the disclosure of the letters patent themselves the first requirement of the first element of claim 1 is that the series of grading rollers shall be arranged end to end, also that said rollers shall be transversely adjustable, and it is required that the "rotating" rollers shall be power driven, for the specification states "On the driven shaft F are rigidly mounted a number of driving pulleys K, which drive belts L,

that pass around the grading rollers M, which are revolvably mounted in adjusting arms N," lines 43 to 47, p. 1, of the printed specification, also "Motion is imparted to the driving shaft to cause a rope H to travel in a groove I¹ in guide I in the direction indicated by the arrow. This causes the grading rollers to revolve so that the top of the roller travels away from the guide * * *." "It will also be observed that the ropes carry the fruit toward the lower end of the machine and at the same time the grade rollers are revolving so as to keep the fruit from sticking in the runway," lines 82, p. 1 to 1, p. 2, of the printed specification.

The second element of claim 1 is the non-movable grooved guide. This element of the combination with the plurality of *end to end* rollers is limited to an exact arrangement, viz.: that it shall not only lie parallel with the grade rollers, but parallel with a plane which *passes vertically and longitudinally through the center of said rollers*.

It is the limitation in claim 1, that the *end to end* arrangement of the rollers and the non-movable groove guide parallel to the said rollers and in plane which passes *vertically and longitudinally through the center* of the rollers shall constitute the fruit runway which the appellant seeks to have removed from the claim, so that the claim may be expanded as though it read as follows:

"In a fruit grader, in combination a plurality of independent adjustable rollers situated within the sphere of the fruit runway, a non-movable guide, and means for propelling the fruit through the runway."

Claim 10 of the letters patent in suit is limited by the wording thereof to the end to end arrangement of the rolls. This claim differentiates from claim 1 by the non-restriction as to what may comprise the parallel member of the runway opposing the member of the runway composed of the end to end rollers. However, it does specify the arrangement of the grading rollers relative to each other and the specific construction of the brackets carrying the said rollers and the means for adjusting the said brackets.

As will be hereinafter shown, appellees' machine does not embody in its structural arrangement of co-operative parts end to end rollers as one of the grading members of the fruit runway, as called for by claim 10 of the Reissue letters patent. It does not embody therein a fruit runway composed of such arrangement of rollers in combination with a non-movable grooved guide lying parallel with the plane which passes vertically and longitudinally through the center of said rollers, as called for by claim 1 of the said letters patent, and appellees' machine does not embrace in its arrangement of working parts the "brackets carrying the rolls, the guide for the brackets and means for adjusting the brackets upon the guides," in combination with "a series of end to end rolls," as called for by claim 10 of the letters patent in suit.

It is the limitation of the "end to end" arrangement of the rolls, and the specified supporting brackets, guides for the brackets, and the adjusting means therefor, which the appellant seeks to have read out of claim 10.

The wish of appellant is to have the claims construed and enlarged as follows:

Claim 1. In a fruit grader, in combination a plurality of independent adjustable rollers, a non-movable guide lying parallel with said rollers, and means for propelling the fruit through the runway.

Claim 10. In a fruit grading machine, a runway formed of two parallel members, one of said members having embodied therein a plurality of longitudinally disposed adjustable rollers, and means for adjusting said rollers.

The foregoing claims express that which appellant seeks for the inventions of the combinations of the claims alleged to have been infringed, for it is only by so expanding the claims that appellees' device can be made to fall within the claims of the patent in suit. Against any such enlargement of the involved claims, we most earnestly protest. The claims in suit clearly express that which they endeavored to express, for they are not ambiguous in any manner. Again, the combinations called for by the claims cover the only form of co-operative working elements disclosed by the letters patent, and the combinations were expressed with the limitations therein to induce an allowance of the claims.

It is well known that the claims of letters patent will not be enlarged merely for the purpose of making out an infringement. In the present case, not only is the appellant prohibited from so expanding the invention by reason of the involved claims clearly expressing that sought to be protected, but due to the further fact that during the prosecution of the application which eventuated in the grant of the

original letters patent of the Reissue letters patent in suit and the application of the letters patent which resulted in the grant of claim 10 of the said Reissue letters patent, the effort was made to secure the allowance of claims commensurate in scope to the above suggested claims, but the Patent Office refused to grant an allowance of any such claims. It was only after the broad claims of the application had been abandoned and the specific claims filed, was applicant enabled to secure an allowance of the claims herein involved.

The original letters patent of which the patent involved is a reissue, were granted June 9, 1903, on an application filed by Robert Strain, said letters patent being No. 730412, and appearing in the record in connection with complainant's exhibit "Original File Wrapper," pp. 169-190, the printed letters patent appearing on pp. 188-190 of the record. The application of the said original letters patent as filed in the Patent Office contained the following claims:

1. In a fruit grader, one or more transversely adjustable rotating rollers; in combination with a guide lying parallel with the rollers, said guide and rollers forming a fruit runway; and ropes in said guides.

2. In a fruit grader, a plurality of independently, transversely adjustable rotating rollers; in combination with a longitudinal guide lying parallel to said rollers, said guide and rollers forming a fruit runway; a rope in a groove in said guide adapted by the movement thereof to cause the fruit to travel along said runway; a fruit retaining bin below each roller having an apron therein to break the fall of the fruit.

3. In a fruit grader, one or more transversely and independently adjustable rotating rollers.

4. In a fruit grader, a plurality of independently, transversely adjustable rotating rollers in combination with a longitudinal guide lying parallel to said rollers, said guide and rollers forming a runway for the fruit; a rope in a groove in said guide, adapted by the movement thereof to cause the fruit to travel along the runway; a fruit retaining bin below each roller.

5. In a fruit grader, one or more bins below the graders each having a yielding soft apron therein elevated above the bottom of the bin.

6. In a fruit grader, a grooved longitudinal guide, a rope in said groove; means to impart movement to said rope; one or more rollers lying parallel to said guide revolubly mounted in arms transversely adjustable; means to adjust said arms comprising a threaded belt passing through two stop blocks; a nut on said bolt in threaded contact therewith between said stop blocks; and means to revolve each of said rollers, comprising a belt passing around said roller and a pulley mounted on a shaft; and means to impart motion to said shaft.

Particular attention is called to claim 1 of said series of claims, inasmuch as claim 1 of the reissue letters patent in suit differentiates therefrom only by incorporating into the claim the limiting expression "independent," as applied to the adjustable rollers; and the expression, "plane which passes vertically and longitudinally through the center of," as applied to the location of the guide, and the further limitations that the guide shall be non-movable and grooved, and that the rollers and guide shall form the fruit runway of the grader.

Original claim 2 is the same as claim 1 of the re-issue letters patent, with the exception that the limitation of the guide being situated in a "plane which passes vertically and longitudinally through the center of" was added to claim 1 of the reissue letters patent to induce an allowance of the claim.

The first five originally filed claims were rejected by the Patent Office, their rejection acquiesced in by applicant Strain and the claims cancelled. For the cancelled claims, the following claims were substituted:

1. In a fruit grader in combination a plurality of independent transversely adjustable rotating rollers; a non-movable grooved guide lying parallel with the plane which passes vertically and longitudinally through the center of said rollers, said rollers and guide forming a fruit runway; a rope in the groove in said guide and means to move said rope.

2. In a fruit grader a plurality of independently transversely adjustable rotating rollers, said rollers being adapted to form one side of the fruit runway of the grader.

3. In a fruit grader having a bin means to break the fall of the fruit from the grading way comprising a yielding soft apron above the bottom of the bin and extending under the grading way, said apron having the end thereof under the grading way at a higher elevation than the other end; the lower end extending to near the outer side of the bin.

Of these claims, the first claim appears as claim 1 of the reissue letters patent, and in all respects is the same as original claim 1 with the limitations applied thereto to induce an allowance thereof. Of this

series of claims, 1 and 3 were allowed. Claim 2 of the series of amended claims endeavored to cover broadly as one member of a fruit runway, "a plurality of independently transversely adjustable rollers." This claim was rejected and cancelled by the patentee. However, a comparison thereof with claim 10 of the reissue letters patent in suit is requested. It will be noted that claim 10 calls for the same elements as rejected claim 2, with the exception that the rollers shall constitute one member of the fruit runway and are limited to the extent that the said rollers shall be arranged "end to end," and into the claim is brought the specific means for supporting the rollers and adjusting the same toward and from the companion member of the runway. Without these limitations an allowance of the claim was refused, consequently, appellant cannot be credited at this time when arguing that the expression "end to end" disposition of the grading rollers does not restrict the same to the end to end arrangement of the rollers shown and described in the reissue patent in suit. If such limitations deliberately placed into the claim for the purpose of inducing an allowance thereof and which succeeded in doing so does not serve to so restrict the claim, then the claim must be construed to mean that which the Patent Office refused to grant and which was cancelled by the applicant.

The limitation placed into claim 1 to induce an allowance thereof and the limitations placed into claim 10 for the same purpose, cannot, at this time, be ignored or eliminated in order to enlarge the scope of the said claims.

On the cancellation of claim 2, of the second series of claims filed, the original application filed by Strain was passed to an allowance, and the letters patent No. 730412, record p. 188, issued with the three allowed claims of which the amended allowed claim 1 is the same as claim 1 of the reissue patent in suit.

HISTORY OF THE REISSUE PATENT IN SUIT.

During the pendency of the original application of Robert Strain, there was filed in the United States Patent Office on August 18, 1902, by one Charles Rayburn, an application for letters patent for an improved fruit grader. The file wrapper of this application appears as Defendants' Exhibit "File-Wrapper Rayburn Application for Letters Patent," record pp. 559-578, and the letters patent issued on said application appears between pp. 591-594 of the record.

The Rayburn application was filed with the following claims:

1. A fruit sizing machine having a series of sizing rolls independently adjustable to regulate the size of the discharge apertures, substantially as described.
2. A fruit sizing machine having a series of sizing rolls, brackets carrying the rolls, and means for independently adjusting each bracket and roll, substantially as specified.
3. Fruit sizing mechanism comprising a relatively stationary member, a series of parallel sizing rolls, and means whereby each roll may be

adjusted toward and from said stationary member independently of the other rolls, substantially as set forth.

4. Fruit sizing mechanism comprising a central member, parallel longitudinal rows arranged on opposite sides thereof, and means for independently adjusting the rolls, substantially as and for the purpose specified.

5. Fruit sizing mechanism comprising co-operating members, one of said members consisting of a series of rolls independently adjustable toward and from the other member, substantially as described.

6. Fruit sizing mechanism embodying a drive-shaft, co-operating sizing members, one consisting of a series of rolls independently adjustable toward and from the other member, belts connecting the shaft and rolls, and means for maintaining the requisite tautness of the belts, substantially in the manner set forth.

These claims (like the broad claims filed in connection with Strain's original application) were rejected by the Patent Office on reference to prior issued United States letters patent, which letters patent, and equally so others of the prior art, will be given consideration hereinafter.

It will be noted that by claims 1, 2, 3, 4, and 5 applicant Rayburn endeavored, like applicant Strain, to cover broadly one member of the fruit runway as comprising a series of independently adjustable grading rolls, provision for the adjustment of which was to enable the outlet aperture for the fruit being graded to be varied. As stated, these claims were rejected, equally so claim 6 of the series of claims, and the rejection thereof acquiesced in by

the applicant by the cancellation of the claims and the insertion *in lieu* thereof the following claims:

1. In a fruit sizing machine, a runway for the fruit comprising co-operating parallel members, one of said members consisting of a series of rolls arranged end to end and disposed progressively at different distances from the other member, forming communicating fruit-discharging apertures of progressively different widths along the length of the runway, means for adjusting each roll independently to vary the size of the aperture formed thereby, and means for driving the rolls, substantially as described.

2. In a fruit sizing machine, a supporting frame, a runway for the fruit comprising co-operating parallel members, one of said members consisting of a series of rolls arranged end to end and disposed progressively at different distances from the other member, forming communicating fruit discharging apertures of progressively different widths along the length of the runway, brackets carrying the rolls, means mounted upon the frame for moving each bracket and adjusting each roll independently to vary the size of the aperture formed thereby, and means for driving the rolls substantially as described.

3. In a fruit sizing machine, the combination with a supporting frame, of a fruit runway formed by a relatively stationary member and a longitudinal series of rolls arranged end to end at different distances from said stationary member, thus providing communicating spaces of progressively varying sizes for the discharge of the fruit, means for independently adjusting the rolls with relation to said stationary member, means for driving the rolls, and means for positively feeding the fruit along the runway, substantially as set forth.

4. In a fruit grading machine, the combination with a supporting frame, of a fruit runway comprising a relatively stationary member and a series of rolls disposed in parallel relation to said member and arranged end to end at different distances from the stationary member, forming communicating passages of progressively varying sizes along the runway for the discharge of the fruit, means for adjusting the rolls with relation to the stationary member, means for driving said rolls, and a traveling belt moving in parallel relation to the stationary member and rolls for positively feeding the fruit along the runway, substantially as described.

5. In a fruit grading machine, the combination with a supporting frame, of a central longitudinal divider, forming one side of two parallel runways, a series of rolls disposed on each side of the divider and arranged end to end at different distances from the divider, forming therewith a runway having progressively varying discharge spaces for the fruit, means for adjusting the rolls of each series toward and from the common divider, means for driving the rolls, and belts disposed on opposite sides of the divider for positively feeding the fruit along the runways, substantially as described.

6. In a fruit sizing machine, the combination with a supporting frame, of a longitudinal shaft, transverse shafts, one of which is adapted to be driven from a suitable source of power, a runway comprising a relatively stationary member and an adjustable member consisting of a series of rolls arranged parallel therewith and disposed end to end and at different distances from the stationary member, means for independently adjusting the rolls with relation to the stationary member, means for driving the rolls from the longitudinal shaft, and a belt connected with the transverse shafts for positively feeding the fruit along the runway, substantially as set forth.

7. In a fruit grading machine, a runway formed of two parallel members, one of said members consisting of a series of end to end rolls, brackets carrying the rolls, guides for the brackets, and means for adjusting the brackets upon the guides, substantially as set forth.

The application of Rayburn was allowed with the foregoing amended claims and letters patent No. 726756 were issued for the invention covered by the amended claims under date of April 28, 1903, more than one month prior to the issuance date of the Strain original letters patent No. 730412.

After the issuance of the Strain original letters patent under date of June 9, 1903, the assignees of patentee Strain (Fred Stebler, appellant herein, and his partner, Austin A. Gamble) decided to apply for a reissue of the Strain letters patent, and filed such reissue application in the United States Patent Office under date of October 21, 1903. The reissue application was filed solely for the purpose of enlarging the claims of the original letters patent and to secure the claims granted in connection with the issued letters patent of Charles Rayburn. The only claims filed in connection with the Strain reissue application in addition to the claims of the original letters patent are those appearing as claims 4 to 10 of the reissue letters patent, and these are identical with and in fact an exact copy of the seven claims contained in the Rayburn issued letters patent. After the filing of the Strain reissue application, an interference was declared in the United States Patent Office with the issued letters patent of Charles Rayburn, the issue of interference embrac-

ing claims 4 to 10 of the said reissue application of Strain, and all of the claims contained in the Rayburn issued letters patent.

This interference was apparently decided in favor of Robert Strain, with the result that Strain's reissue application was passed to an allowance and the reissue letters patent herein involved issued under date of December 27, 1904.

The assignees of Robert Strain and the filers of the reissue application were content to accept the claims contained in the Rayburn issued letters patent subject to all restrictions and limitations placed thereon by the Patent Office during the prosecution of the application which eventuated in the grant of the Rayburn letters patent with which they sought and obtained an interference, for at no time during the prosecution of the reissue application was any effort made to secure an allowance of claims other than those contained in the Rayburn letters patent. By so accepting these claims, they became bound by such equities as attach thereto, for by this acceptance of the claims as measuring the scope of the invention, they are bound by the acquiescence of Charles Rayburn in the rejection of the broad claims of his application as filed and are estopped at this time from asserting for the claims a scope greater than could have been urged for the same by patentee Charles Rayburn. So far as these claims are concerned, appellant stands in the same position as an assignee of Charles Rayburn, and can not at this time ask for an enlargement of the claims to cover in substance that which was denied the applicant in the Patent Office, and cancelled from the application. Of the series of

claims allowed for the Strain reissue application, the 10th claim of the reissue letters patent in suit is identical with the 7th claim of the Rayburn letters patent.

This claim is therefore limited by the file-wrapper proceedings of the application which eventuated in the grant of the Rayburn letters patent, in exactly the same manner as claim 1 of the reissue letters patent is limited by the file-wrapper disclosure of the Strain original application. Such being the case, appellant cannot at this time ask that the limitation "end to end" disposition of the grading rolls be disregarded and an "end toward end" disposition be substituted therefor, for this limitation, together with the specific form of the bearing brackets for the rolls and the adjusting means for said brackets was put into the claim to induce an allowance thereof over the references cited in anticipation of the broad claims originally filed by Rayburn covering any disposition of a series of rolls forming one member of the fruit runway.

ENLARGEMENT OF CLAIMS IN SUIT.

Appellant realizing that the appellees' device does not fall within the scope of claims 1 and 10 of the reissue letters patent as therein expressed, wishes such limiting expressions removed or ignored as prevents appellees' machine from falling within the charge of infringement, but all limitations retained which will save the claims from being held invalid by reason of anticipation. If one limitation is removed from the claim, all others must likewise be elimi-

nated. However, limitations incorporated into a claim to induce an allowance thereof, cannot afterwards be disregarded for the purpose of making out a case of infringement nor for any other purpose.

It is elementary that the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office when the terms of the claim in a patent are clear and distinct, as they should always be. A patentee in a suit brought upon the patent is bound by the claims thereof, and he can assert nothing beyond the term thereof.

The claim is a statutory requirement prescribed for the purpose of making the patentee define precisely what his invention is; and it is unjust to the public as well as an evasion of the law to construe it in a manner different from the plain import of its terms.

Keystone Bridge Co. vs. Phoenix Iron Works,
95 U. S. 274.

White vs. Dunbar, 119 U. S. 47.

“Where the language in the specification of the patent is clear and unambiguous it must speak its own construction.”

Mitchell vs. Tilghman, 19 Wall, 287.

If the language of the specification and claim show clearly what he desired to secure as a monopoly, nothing can be held as an infringement which does not fall within the terms the patentee has himself chosen to express his invention.

McClain vs. Otmayer, 141 U. S. 423.

In making his claim the inventor is at liberty to choose his own form of expression and while the courts may construe the same in view of the specification and the state of the art, they must not add to or detract from the claim.

Cimiotti Co. vs. American Co., 198 U. S. 399.
Dey Time Register Co. vs. Syracuse Co., 161
Fed. 284.
Schreiber et al. vs. Adams Co., 171 Fed. 830.
Westinghouse Co. vs. New York Co., 119 Fed.
874.

The courts should regard with jealousy and disfavor any attempt to enlarge the scope of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alterations.

Chicago et al. vs. Sayles, 97 U. S. 554.

The construction of a patent must be in conformity with the self imposed limitations which it contained in its claims.

New Departure Bell Co. vs. Bevin et al., 64
Fed. 859, 73 Fed. 469.

A patentee, who acquiesced in the rejection of a claim by the Patent Office, is estopped to claim the benefit of such claim, or such a construction of the claims allowed as would be equivalent thereto.

Credit Electrical Supply Co. vs. Westing-
house Electric Mfg. Co., 200 Fed. 144.

CONSTRUCTION OF CLAIMS IN SUIT.

We maintain under the restrictions placed on the invention of the patent in suit, that claim 1 of the re-issue patent in suit is limited:

1. To a fruit runway formed of a non-movable guide member and an opposing rotary member.

2. That the rotary member shall be composed of a series of longitudinally disposed end to end rollers.

3. That the non-movable guide member of the runway shall lie parallel with the plane which passes vertically and longitudinally through the center of the rollers forming the opposing member of the runway.

4. That the non-movable guide of the runway shall be grooved and a propelling rope be mounted in such groove of the non-movable guide for feeding the fruit through the runway, and means provided for moving the rope.

It is necessary that in the fruit runway called for by the above claim that the outer or movable member thereof be formed of a series of end to end rollers, due to the fact that it is required by the patent and the specification states, "that the ropes carry the fruit toward the lower end of the machine and at the same time the grade rollers are revolving, so as to keep the fruit from sticking in the runway." Unless the member opposing the non-movable guide be composed of positively driven rotary end to end disposed rollers, the fruit will stick in the runway, for the rollers must be disposed "end to end" to provide a substantially unbroken rotary outer wall surface for the travel of the fruit through the machine.

It is essential to the operativeness of appellant's machine that the non-movable guide be arranged in the specified plane called for by the claim, for by no other location thereof can the said guide constitute a parallel runway member for the opposing rotary member, so as to permit of the rope working in the groove of said non-movable guide to carry the fruit. Again, it must be so disposed, for the patent does not illustrate nor describe any other manner of locating the same relative to the parallel rotary member, and further for the reason that it was only by so claiming the position of the non-movable guide relative to the parallel series of end to end rollers of the rotary member of the runway and causing the rollers to form one member of the fruit runway that an allowance of the claim was secured.

That which induces an allowance of a claim is essential to the validity thereof and cannot be disregarded after the issuance of the letters patent in a suit for infringement.

Claim 10 of the reissue patent in suit requires:

1. That the fruit runway shall be composed of two parallel members.
2. That one of said members shall be composed of a "series of end to end rolls."
3. That bearing brackets shall be provided for the rolls.
4. Guides shall be provided for the brackets.
5. That means shall be provided for adjusting the brackets upon the guides.

This specific combination of co-operating elements must be employed and as specified in order to come

within the protection afforded by the said claim. You cannot disregard the "end to end" disposition of the rolls called for in the claim any more than you can the bearing brackets, the guides for the brackets nor the means for adjusting the brackets. If the series of rolls are not arranged "end to end" then the claim is not complied with, inasmuch as you do not in such case construct the runway of two parallel members "one of which is composed of a series of end to end rollers." As this disposition of the rolls was expressly brought into the claim to induce an allowance thereof, the same is just as essential to the claim as any other element expressed therein. Furthermore, you cannot produce a runway of two parallel members where one of the members comprises a series of rolls and obtain a substantially unbroken rotary wall surface for the runway, unless the rolls be placed "end to end." The placing of the rolls a distance apart would not produce such a runway, inasmuch as it would leave non-available grading spaces between the ends of adjacent rolls, just what the patentee sought to avoid and successfully accomplished by the "end to end" disposition of the rolls; besides, the Patent Office refused to grant a claim for the rolls arranged otherwise than "end to end" as specified in claim 10 of the reissue letters patent in suit.

The above is our construction of claims 1 and 10 of the reissue patent in suit gained from a reading of the letters patent and the disclosures of the file-wrapper proceedings which eventuated in the grant of the said letters patent, and this construction was given to the claim by his Honor Judge Wellborn on

careful consideration of the entire case after four days of argument. If we are correct in our conclusion there can be no infringement of the claims by the machine manufactured, sold and used by the appellees, inasmuch (as will be hereinafter shown) the said machine does not embody in its construction and mode of operation the combinations called for by said claims 1 and 10 of the reissue patent in suit. In fact, as stated by Judge Wellborn, the two are "different mechanically, are mechanically different."

So far we have construed claims 1 and 10 from the face of the reissue patent itself, in connection with the file-wrapper disclosure, in order to determine the exact construction to be placed on said claims and the scope thereof, under the assumption that the said claims are valid. However, we most earnestly contend not only that the appellees do not infringe the claims if valid and properly construed, but further that the claims are absolutely invalid by the prior art.

PRIOR ART.

As heretofore stated, the Strain reissue patent is designed for the grading of fruit, nuts and vegetables, its use not being intended to be confined to the grading of one class of fruit, viz.: oranges. In fact, the patentee states that as the grading rollers are adjustable relative to the non-movable guide "the distance between the roller and guide can be made small or large to adapt the machine to grading small nuts or fruit or large nuts or fruit," lines 92-95, p. 1 of the printed specification.

In anticipation of the claims in suit, the defendants

offered in evidence as exhibits, the following prior United States letters patent, the same appearing in the record between pp. 487-559, viz.:

399509 granted F. N. Ellithorpe, March 12, 1889, for improved Fruit Assorter.

No. 430031 granted J. A. Jones, June 10, 1890, for an improved Machine for Assorting or Sizing Fruit.

No. 442288 granted J. A. Jones, Dec. 9, 1890, for an improved Machine for Assorting and Sizing Fruits, etc.

No. 456092 granted H. H. Hutchins, July 14, 1891, for an improved Assorting Machine.

No. 458422 granted J. T. Ish, Aug. 25, 1891, for an improved Fruit Grading Machine.

No. 465856 granted H. H. Hutchins, Dec. 29, 1891, for an improved Fruit and Vegetable Assorter.

No. 466817 granted E. E. Woodward, Jany. 12, 1892, for an improved Orange Sizer.

No. 475497 granted G. A. & C. F. Fleming, May 24, 1892, for an improved Fruit Grader.

No. 482294 granted A. C. Burke, Sept. 6, 1892, for an improved Fruit Sizer.

No. 529032 granted H. C. Jones, Nov. 13, 1894, for an improved Fruit Sizer.

No. 534783 granted A. Cerruti, Feby. 26, 1895, for an improved Fruit Grader.

No. 538330 granted A. D. Huntley, Apr. 30, 1895, for an improved Orange Sizer.

No. 671646 granted R. G. Bailey, Apr. 9, 1901, for an improved Fruit Grader.

No. 673127 granted E. N. Maull, Apr. 30, 1901, for an improved Fruit Sorting Machine.

No. 713484 granted C. D. Nelson, Nov. 11, 1902, for an improved Fruit Assorting Table.

It will not be necessary to discuss each of the foregoing letters patent, inasmuch as the same have been sufficiently testified to by witness Cobb between pages 408 and 414 of the record. In the main, these prior letters patent were introduced to show that the machine of the patent in suit relates to mere improvements in a well filled field, and therefore not entitled to be given the consideration which is accorded under the patent law to a pioneer invention.

Many of the prior letters patent disclose fruit graders having a runway composed of a non-movable and a rotating member, with means for propelling the fruit to be graded through said runway and means for adjusting the rotary member of the runway to and from the fixed member thereof in order to vary the outlet aperture for the escape of the fruit. Certain of the prior letters patent illustrate machines having co-operating elements which comply with the terms of the claims in suit, for instance:

Letters Patent No. 456092—defendant's exhibit—Hutchins Patent "record page 505, granted H. H. Hutchins, July 14, 1891, for an improved Assorting Machine." For convenience, we present a series of cuts disclosing more clearly the structural arrangement of the Hutchins machine. Like the machine of the patent in suit, it discloses a machine for the sorting or grading of "fruit and vegetables," the same comprising a suitable frame, designated on the cut by the numeral A. Within the frame is arranged a fruit runway, the same consist-

Fig. 1

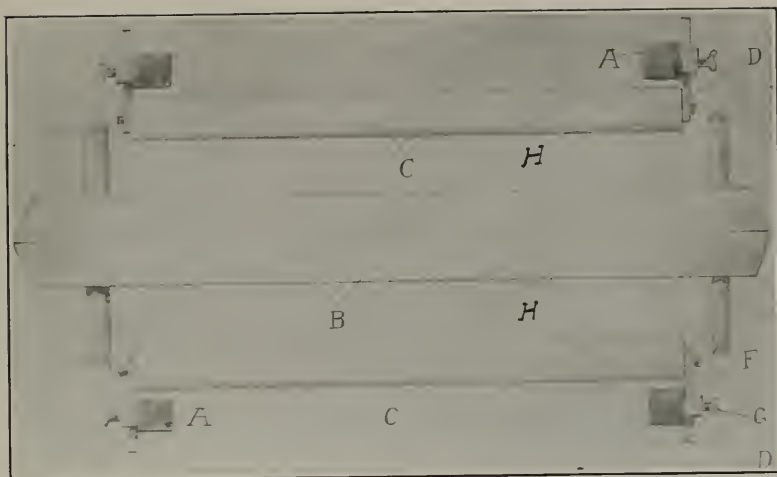


Fig. 2

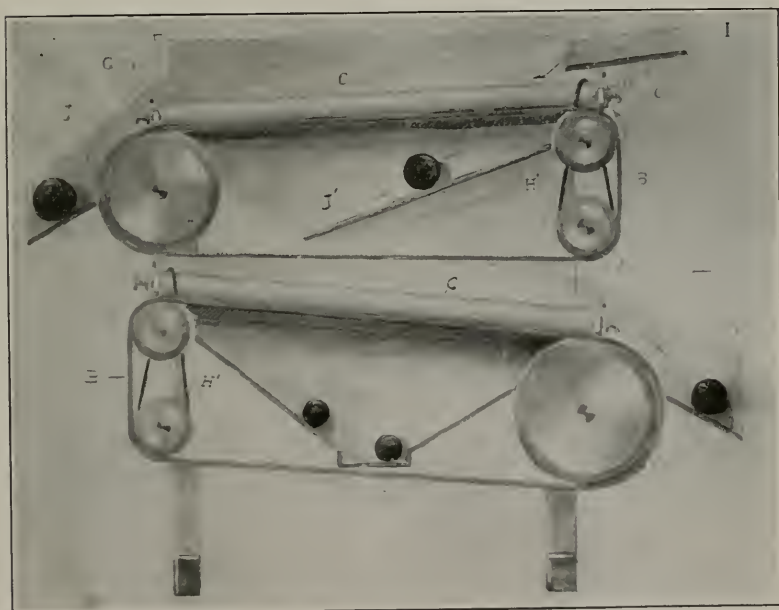
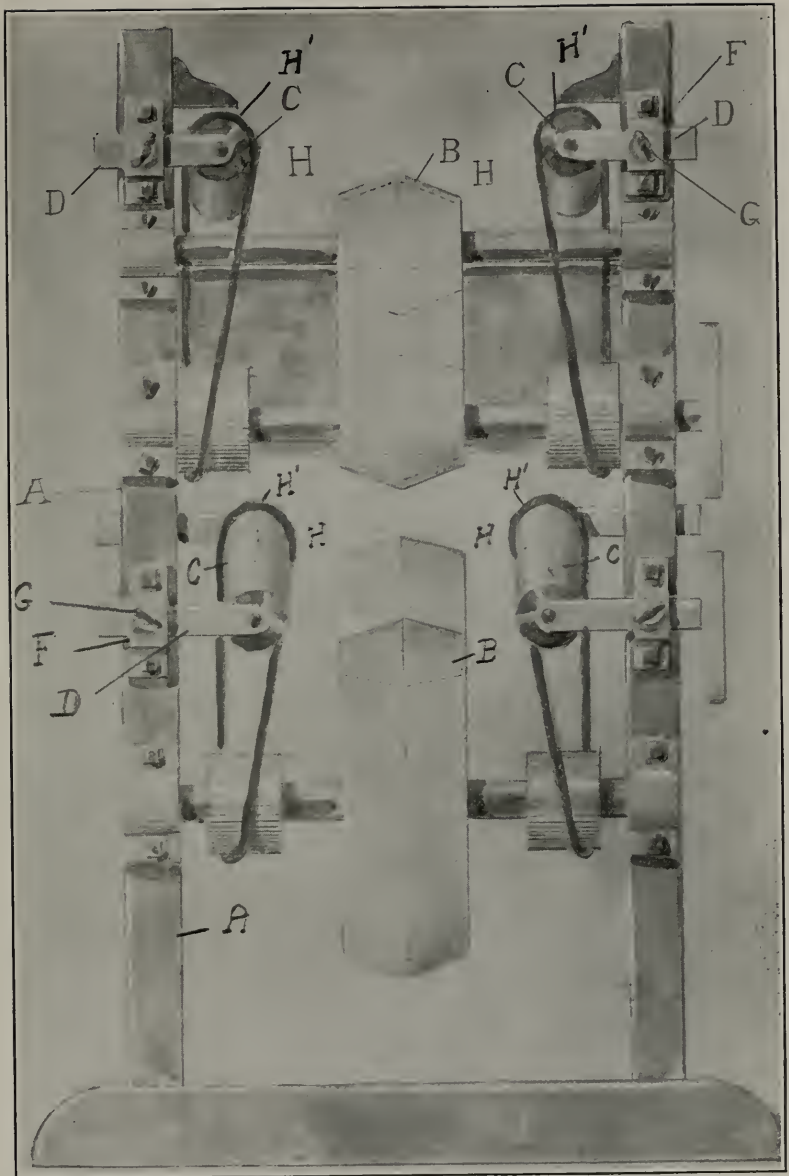


Fig. 3



ing of a non-movable guide which supports and over which works the belt B for conveying the fruit through the machine. This non-movable guide (designated in Fig. 3 of the drawings accompanying the letters patent by the reference numeral E), constitutes one member of the fruit runway, while the rotary member C constitutes the opposing member of the fruit runway. The rotary member is supported in bearing brackets D, which work in guides F, the said guides being adjusted within the bearing brackets by the adjusting means G. This adjustment permits of the rotary member being adjustable toward and from the non-movable guide member of the runway to vary the aperture or passage-way H for the fruit being graded within the machine, for the same purpose accomplished by the adjustability permitted the rotary rollers of the patent in suit. These rollers, like those of the patent in suit, are power driven by means of the drive belts or ropes H¹. In the Hutchins machine, which is a double grader like the grader of the patent in suit, the fruit runway is not a continuous longitudinally disposed runway, but for compactness of the machine, the runway is sub-divided into two vertically disposed sections, each section consisting of a non-movable member and an opposing adjustable rotary member. The entire fruit runway comprises a non-movable guide and a plurality of independent transversely adjustable rollers, and the non-movable guide member of the runway lies parallel with the plane which passes vertically and longitudinally through the center of the rotary member. Like the grader of the reissue patent in suit, the disposition of the transversely ad-

justable rotary member of the runway relative to non-movable guide member is such, that substantially the weight of the fruit being graded is taken care of by the rotary and non-movable member of the runway.

In operation, the fruit to be graded is delivered into the machine from the feed chute I, and enters at the upper end of the fruit runway. The fruit too large to pass through the discharge passageway of the runway as propelled there through by the belt or rope B discharges into the bin or receptacle J, while the fruit of a size sufficiently small to pass through the first grade space of the fruit runway enters onto the incline J¹, by which it is guided and deposited onto the second section of the fruit runway. Such fruit as is too large to pass through the discharge passageway of the fruit runway is conveyed there through by the belt or rope and discharged into the receptacle K for such sized fruit, while the smaller fruit of a size which will pass through the graded section of the runway is discharged into the receptacle L. By the Hutchins patent provision has been made for taking care of only three grades of fruit, but the number of grades is an immaterial feature. By increasing the length of the runway, an increased number of grades may be taken care of. The distinction between the Hutchins' patented grader and the grader of the patent in suit, is this, in the Strain grader all the grade spaces of the fruit runway for the fruit passing through the machine are formed by two parallel longitudinally disposed members, one being non-movable and the other rotary, whereas, in the Hutchins' grader, the said grade members of the

runway are vertically disposed. However, the said Hutchins' patent does disclose in a fruit grader the combination of a plurality of independent transversely adjustable rotating rollers, a non-movable guide lying parallel with a plane passing vertically and longitudinally through the center of the rollers, the rollers and guide forming a fruit runway, a propelling belt or rope supported by the said guide, and means to move said rope.

This is the combination called for by claim 1 of the reissue letters patent in suit, and it meets the terms of claim 10 of the said letters patent—if the limiting expression “end to end” disposition relative to the rollers is to be eliminated from the claim, as contended for by appellant; inasmuch as the patented machine discloses the combination—

In a fruit grading machine, a runway formed of two parallel members (the non-movable guide and the rotating member) the rotary member of said runway consisting of a series of rolls (C-C), brackets (D) carrying the rolls, guides (F) for the brackets, and means (G) for adjusting the brackets upon the guides.

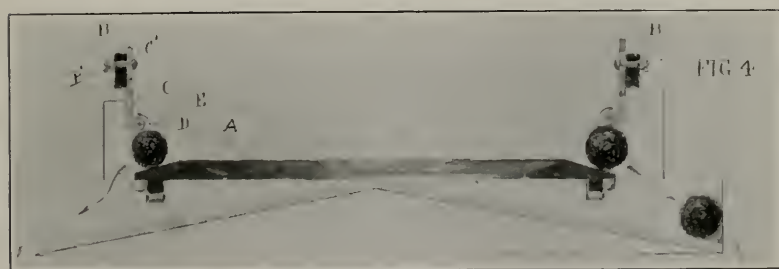
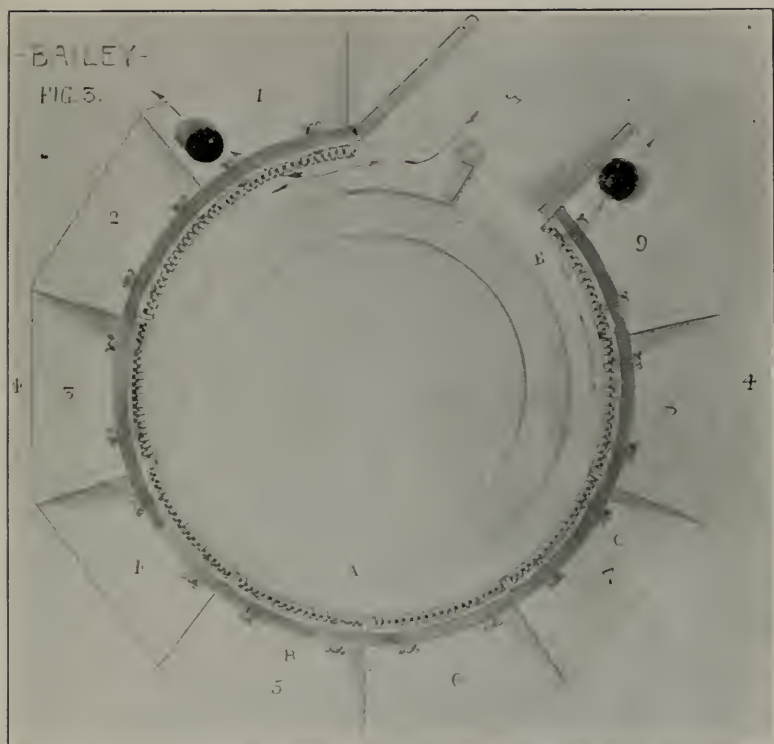
It will thus be seen that every element, and the identical combination called for by claim 10 (excepting “end to end” disposition of the rolls) is found in the Hutchins' machine, and used therein for the same purpose as called for by the patent in suit.

The “end to end” disposition of the grading rolls was not new with patentee Strain, for on reference to United States letters patent No. 671646, granted R. G. Bailey, April 9, 1901, for an improved Fruit Grader, such an arrangement of the grade rolls are

illustrated and described. It was admitted at the hearing in the lower court that these letters patent ante dated the filing date of the application of the Strain original letters patent, and no evidence was introduced to carry the Strain invention back of the date of the Bailey patent.

This patent (record page 544), like the Hutchins and other letters patent of the prior art, discloses a machine for the grading and sorting of fruit, and the same will be readily understood by the cuts appearing opposite hereto. The separate parts constituting the grading members are shown in detail by Figs. 1, 2 and 5, while in Fig. 3 a plan view of the assembled parts and by Fig. 4 a sectional view of the machine is illustrated.

In the Bailey machine, the fruit runway is a circular one, the same being composed of the rotatable guide member A, and the series of end to end rollers E. Instead of a single roller for each grade space, the roller is sub-divided into a plurality of small rollers E. The series of rollers E for each grade space are carried by a bracket C, and said brackets are supported by adjustable bearings. The purpose of the adjustment permitted the brackets C is to permit the rolls E to be moved toward and from the guide member A to increase or decrease the aperture for the escape of the fruit through the grade spaces. Each set of rollers E is independently adjustable toward and from the opposing member, so that the adjustment given to the rotatable wall surface of any given section of the fruit runway does not disturb the position of any of the other rotatable wall sections. The rotary member of the parallel members



-BAILEY-

FIG. 1.

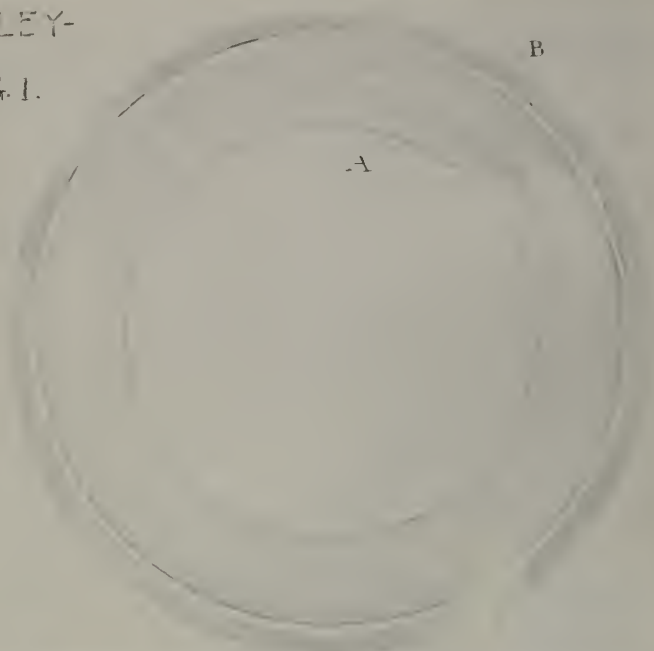
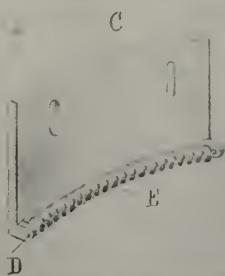


FIG. 2.



FIG. 5.



of the fruit runway is composed, as stated, of a plurality of independently adjustable rotary sections or grade units, these rotary sections or units being suspended in adjustable brackets from the circular non-movable plate B. Each independently adjustable rotary section controls a grade discharge opening for the fruit, the series of grade openings being numbered 1 to 9 in Fig. 3 of the cuts. The fruit to be graded is delivered into the machine from a suitable feed chute A¹ and is received onto the inclined surface of the rotating plate A, being carried around by the movement thereof. The fruit too large to escape through the grade outlet 1, is carried to the next outlet 2 and if too large for said outlet is advanced to outlet 3, and so on until an outlet of proper opening is found for the escape of the fruit.

The rollers E of the Bailey machine are arranged "end to end" so as to present a continuous rotary wall surface with which the fruit passing through the fruit runway co-acts until an outlet space in the runway of proper size is found for the escape of the fruit. Each rotary section, although composed of a plurality of individual units, constitutes a roller so far as relates to the grading feature for the fruit, and operates in the same manner as a rotary grade section composed of a single roller. These rotary sections of the Bailey fruit runway are independently adjustable toward and from the opposing member of the runway, and are adjustable for the same reason as the adjustment provided for the rotary sections of the Strain reissue patent in suit. Furthermore, the rotary sections of the runway of the Bailey machine are arranged "end to end" for the

same reason as the "end to end" disposition of the rotary sections of the Strain machine, to wit: to "form a continuous contact for the sides of the fruit" and to provide "a contact surface for the fruit which is freely movable, and which revolving in the opposite direction or upwardly prevents the fruit from being pinched when it arrives at spaces which are nearly large enough to allow it to pass, and it will thus be retained in the channel (fruit runway) until it arrives at a space which is sufficiently large for it to fall through."

Although the machine of the Bailey patent is of circular form, it nevertheless illustrates and describes a fruit grader having a fruit runway composed of two parallel members, one of said members comprising a series of "end to end" rollers, any one of the grade sections of the rotary member being adjustable toward and from the opposing member of the runway independent of the other sections of the rotary member.

Such being the case, each and every element of claim 10 of the reissue letters patent in suit is found in the Bailey machine, employed therein for the same purpose and working in the identical manner called for by said claim. In other words, the device of the Bailey patent is a fruit grading machine having "a runway formed of two parallel members, one of said members consisting of a series of end to end rolls (E), a bracket (C) carrying the rolls, guide (C¹) for the brackets, and means (B¹) for adjusting the brackets upon the guides."

If we are correct in our construction of the Bailey patent, and as to this we submit that the same is

(No Model.)

2 Sheets—Sheet 2.

J. T. ISH.
FRUIT GRADING MACHINE.

No. 458,422.

Patented Aug. 25, 1891.

Fig. 2.

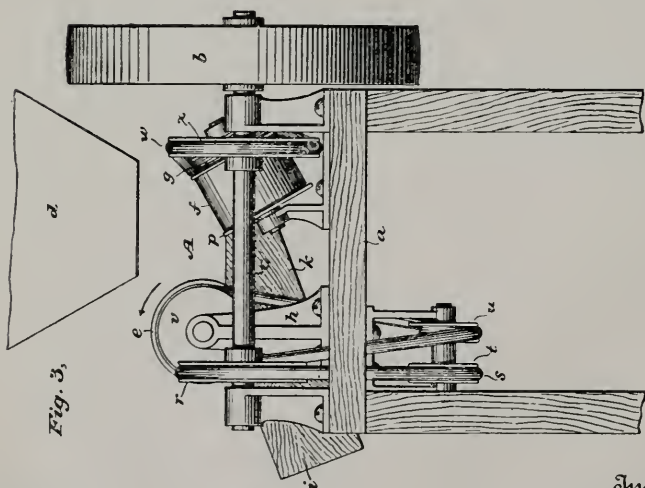
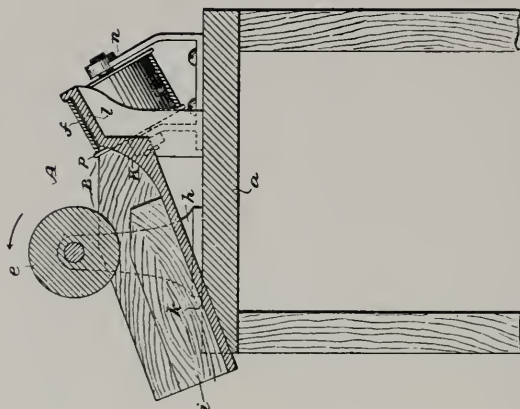


Fig. 3.

Witnesses
Geo W. Brock.
Edward Thorpe.

Inventor
James T. Ish.
By his Attorneys
Fowler & Fowler

(No Model.)

2 Sheets—Sheet 1.

J. T. ISH.
FRUIT GRADING MACHINE.

No. 458,422.

Patented Aug. 25, 1891.

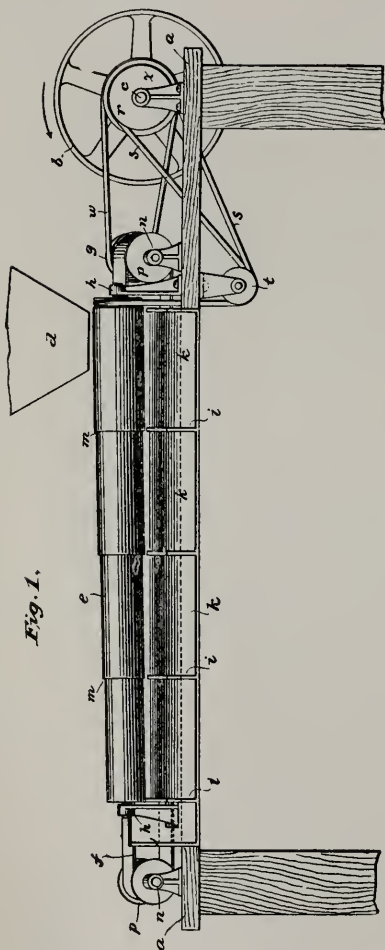


Fig. 1.

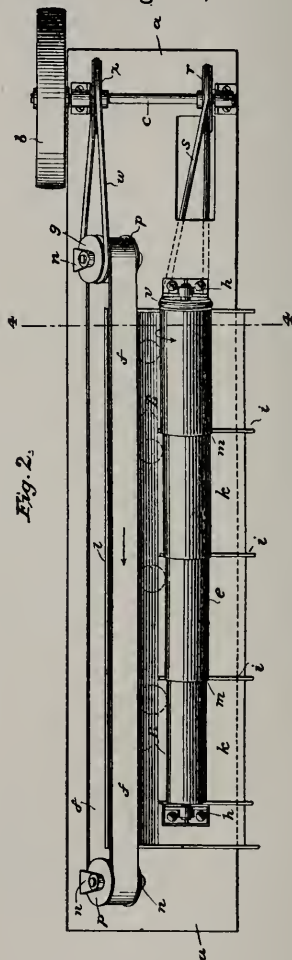


Fig. 2.

Witnesses
Geo. W. Breech.
Edward Thorpe.

Inventor
James T. Ish.
By his Attorneys
Fowler & Fowler

upheld by the testimony of appellant's expert witness Knight in answer to cross-questions 82 to 102, record pp. 708 to 712, then claim 10 of the reissue letters patent in suit is anticipated thereby, and the claim is invalid.

At this time, we wish to direct attention to United States letters patent No. 458422, granted J. T. Ish, August 25, 1891, for an improved Fruit Grading Machine.

These letters patent appear on p. 510 of the record, a cut illustrating the same appearing on the opposite page. This is one of the earliest forms of what is known as the "rope and roller" grader. As will be noted from the cut, the fruit runway is formed by a non-movable member *i* and a rotary member *e*, the fruit being conveyed through the fruit runway or "grading chute A" by means of "a flat belt" or "a rope" *f*. The disposition of the non-movable member is such that the edge of the belt or rope *f* "adjacent to the member *e* is in a plane parallel to the axis of said member." Means are provided for driving the conveyor belt or rope for the fruit, and the rotary member *e* of the runway is driven by suitable connection shown in the patent.

The application of the Ish patent was filed in the Patent Office June 21, 1889, although the letters patent for the invention disclosed thereby did not issue until August, 1891. This patent discloses perhaps the first form of a fruit grader having a graduated fruit runway formed of two parallel members, one of said members being non-movable and supporting an endless traveling propelling belt or rope for the fruit, and the other being a rotary member so

arranged as to provide independent graduated grade openings in the runway for the escape of the graded fruit. In the Ish machine (which according to the record herein was largely used in Southern California in connection with the grading of oranges) the rotary member of the runway is a stepped roller, each stepped section providing for a different size grade opening. In the patent drawing, the rotary member is formed with four step sections, permitting four sizes or grades of oranges to fall through the outlet aperture of the fruit runway. This patent is a pioneer one and contains a generic claim for a fruit separator "comprising a graduated rotary member and a traveling endless belt arranged parallel and adjacent thereto."

The Ish patent was owned by appellant Stebler—answer to X-Q. 99, record p. 651—and a great many of the machines were placed on the market—answer to X-Q. 110, record p. 652.

It will be noticed that the only difference between the Ish fruit grader and that of the patent in suit resides in the fact that in the Ish machine the rotating member of the fruit runway consists of a single roll stepped to produce grade sections, whereas in the Strain grader of the reissue patent instead of a stepped roll the roll is sub-divided into a plurality of short rolls, or, in other words, where the Ish patent discloses a four stepped roll as the rotary member of the runway, the Strain grader employs a short roll for each step of the single roll. Otherwise, the machines are the same—so far as concerns a fruit grader. Whether this amounts to invention is exceedingly questionable in view of the Bailey patent,

where the rotary member of the fruit runway is made up of a series of independently adjustable grade sections.

Patentee Bailey was the first to depart from the Ish invention by substituting for the single stepped roll member of the fruit runway a plurality of independently adjustable rotary sections as the rotary member of the runway. After this change, it certainly did not amount to invention to make each independently adjustable rotary grade section of a single short roll in place of an independently adjustable grade section consisting of a series of small rolls; more especially so where the independently adjustable end to end rotary sections perform the same function in each machine, as we have seen from the testimony of appellant's expert witness Knight. It is not invention to substitute for one well known device another well known device, where each perform the same function in the combination of co-operating elements of the machine. Thus, the substitution of an adjustable single small roller for each grade section of the fruit runway for the plurality of adjustable smaller rollers disclosed in the machine of the Bailey patent for each grade section of the fruit runway, does not amount to invention.

So long as the grading or sizing of oranges was carried out on a small scale, the Ish patented machine answered all the demands of the trade, in fact, as the record shows, such machine is in use in some of the smaller or individual packing houses today. However, as the orange industry increased it became necessary to secure greater bin capacity for the sized oranges.

It will be understood that with these sizing or fruit grading machines, the oranges flowing from the different gradeways of the machine are delivered into bins, and are taken from such bins by operators and packed into boxes. While the Ish machine as to sizing capacity supplied all the requirements demanded of a grader, it was limited as to bin capacity. To secure greater bin capacity it required that the grading machine be considerably increased in length over that of the Ish machine, which was approximately twelve feet long. To meet this demand, the first act of the manufacturer and users of the Ish machine (including the appellant herein) was to substitute for the single stepped roller of the Ish machine two stepped rollers, which rollers were placed end to end and formed the rotary parallel member of the fruit runway, the non-movable guide member being varied from that shown in the Ish patent to the extent of being grooved and having a propelling rope for the fruit placed in the groove of the said guide. By this change, the Ish machine was considerably lengthened to accommodate bins of increased capacity. In fact, the extension of the Ish machine was not confined to two "end to end" rollers, but three and four of such "end to end" rollers were utilized as the rotary member of the fruit runway, thereby producing a machine thirty feet or more in length. This machine (or rather the enlarged Ish machine), as placed on the market, was known as the "rope and roller sizer," and termed the "California Grader," and was largely manufactured and sold by the appellant herein, and is in use at the present time





California
Singer

in many of the larger fruit packing houses in Southern California.

A model of this California sizer was introduced in connection with defendant's testimony as "Defendants' Exhibit Model California Sizer," record page 323, and in connection with the introduction of said exhibit it was stipulated by counsel for appellant, that the same constituted a correct model of the old California sizer and that the California sizer was in use prior to the year 1900. A photographic print of one of the California sizers was introduced as "Defendants' Exhibit Upland Sizer," record page 225.

For convenience, we present herewith two cuts of the California sizer, the larger cut disclosing the machine with a plurality of end to end rollers, as installed for use in one of the packing houses. An examination of the smaller cut discloses a fruit grading machine, the runway of which is composed of two parallel members, one member consisting of a non-movable grooved guide A, the other of a plurality of independently adjustable rollers B. The non-movable groove guide member lies parallel "with a plane which passes vertically and longitudinally through the center of the said rollers." A rope C for propelling the fruit through the runway work within the groove B¹ of the non-movable member of the runway, and means are provided as illustrated for driving the said rope. From the drive mechanism for the rope C power is transmitted for imparting rotation to the series of rollers. The rollers B are arranged "end to end" and the said rollers with the non-movable grooved guide A constitute the parallel

members forming the fruit runway of the grader. The "end to end" rollers B are carried by brackets *a*, which brackets in turn work in guide *b*, and the means *c* adjust the brackets upon the guides. The larger cut illustrates a greater number of end to end rollers than are disclosed in the smaller cut.

This California sizer contains each every element of the combinations called for by claims 1 and 10 of the reissue letters patent in suit, and, in fact, such a constructed machine falls within the protection afforded by said claims. The manufacture, use and sale of the California sizer at this time would constitute an infringement of the involved claims 1 and 10, if the same are valid. Such being the case, the claims are void, for, it is well established, "that what would infringes, if later, anticipates, if earlier."

Peters vs. Active Mfg. Co., 21 Fed 319.

A comparison of the California sizer with the fruit grader of the patent in suit, discloses that each comprises the same working elements, arranged in the same manner, each element performing in one machine the corresponding work accomplished in the other, each machine being designed for the sizing of the same class of fruit, and each manufactured and sold for use in connection with packing houses.

The California sizer was placed into use at least as early as 1896 and has continued in use ever since. It was a successful machine and handled all fruit delivered thereto for sizing purposes.

These facts are amply proven by the testimony of witness L. E. Tucker (record p. 220), foreman of the Upland Citrus Association; T. C. Jameson (record

p. 240), foreman of the Jameson Packing House; F. K. Adams (record p. 252), manager of the West Ontario Citrus Association; F. E. Proceid (record p. 264), formerly foreman of the Parker Packing House; H. E. Wolcott (record p. 284), manager of The Pomona Fruit Growers' Exchange, and of George D. Parker (record p. 315), one of the appellees herein.

Each of the above witnesses testify as to the use and operation of the California sizer, but, in view of the stipulation of appellant's counsel regarding the prior use of the machine, it is needless to quote the testimony of the witnesses relative thereto.

While from an examination of the model exhibit of the California sizer, it is evident that the rolls comprising the rotary member of the runway are arranged "end to end" and supported by adjustable brackets, as called for by claim 10 of the reissue letters patent in suit and as testified to by the mentioned witnesses, the same is testified to by witness Cobb, in following answer to questions 47, 48, 49, 50 and 51, record pp. 423-425:

"Claim 10 of the patent in suit reads: 'In a fruit grading machine, a runway formed of two parallel members, one of said members consisting of a series of end to end rolls, brackets carrying the rolls, guides for the brackets and means for adjusting the bracket upon the guide, substantially as set forth.' In the model I find a fruit-grading machine having a runway formed of two parallel members, one of said members consisting of a series of end to end rolls. I find brackets carrying the rolls, guides for the brackets and means for adjusting the brackets upon

the guides as set forth in claim 10 of the patent in suit.

“Q. 48 (By MR. ACHER). How does the end to end arrangement of the rollers of the model exhibit conform to the end to end arrangement of the rollers of the machine disclosed by the patent in suit?

“A. In the model the rolls placed end to end, considering two consecutive rolls in the series, are supported by a bracket which acts as a common support of one end of each roll adjacent thereto. The connection between one roll and its adjacent roll is not so rigid as to prevent slight adjustment. In the patent in suit the arrangement of the rolls and their supports are such that either end of either roll forming the series of end to end rolls may be independently adjusted without affecting either end of any of the remaining rolls.

“Q. 49. My question was, Mr. Cobb, how did the end to end arrangement of the rolls of the model compare with the end to end arrangement of the rollers of the grading member of the machine set forth in the patent in suit?

“A. So far as forming a runway is concerned, they are practically the same. They are arranged as close together as mechanical construction will allow, so that there is in use a continuous runway for fruit, and no space allowed for fruit of improper size brought through at an improper place.

“Q. 50. You have described to me the construction of the model, and my question is, how does that compare with the arrangement of the end to end rolls of the machine disclosed by the patent in suit?

“A. It has all the parts shown here that are shown there, and virtually in the same position

relative to one another, and operating substantially in the same manner.

“Q. 51. In the same manner as what?

“A. As shown by and accomplished by the parallel members of the runway in the patent in suit.”

This testimony is upheld by appellant's expert witness Knight, in answer to X-Q. 44 to 49, relative to a photograph illustrating such machine, record pp. 132-133.

The rollers of the California machine are transversely adjustable toward and from the non-movable grooved guide, the guide lies parallel with the plane which passes vertically and longitudinally through the center of the rollers, the rollers are independently adjustable, and they are mounted as called for by the patent in suit. The propelling rope for the fruit works within the groove of the non-movable guide.

The said California sizer not only anticipates claim 10 of the reissue letters patent in suit, but equally so claim 1 thereof.

We submit that all that was done by patentee Strain was to substitute one short roller for the series of small rollers of the Bailey patent for each individually adjustable grade section, or to substitute a plurality of short rollers for the plurality of long “end to end” rollers of the California grader. Such substitution of well known equivalent produced no new function in the working of the machine, and such substitution did not amount to invention.

The substitution of equivalents is not invention.

Smith vs. Nichols, 21 Wall. 112.

Atlantic Works vs. Brady, 107 U. S. 192.

Hollister vs. Mfg. Co., 113 U. S. 59.

Aron vs. Railway Co., 132 U. S. 85.

Trimmer Co. vs. Slivers, 137 U. S. 425.

Manufacturing Co. vs. Cary, 147 U. S. 625.

From the above, taken in connection with the other prior patents introduced in evidence, it will be observed that if anything remains in the patent in suit on which to base a claim for invention, it must reside in the specific detailed arrangement of the working parts for its differentiation from the prior art. The claims to be held valid, must be held restricted to every limitation appearing therein, and no departure therefrom can be permitted. The patent does not fall within the recognized definition of a pioneer invention. The Supreme Court states in connection with the word "pioneer": "This word, although used somewhat loosely, is commonly understood to denote a patent covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improvement or perfection in what had gone before. Most conspicuous examples of such patents are: the one to Howe of the sewing machine; to Morse of the electric telegraph; and to Bell of the telephone."

Westinghouse vs. Boyden Power Brake Co.,
170 U. S. 537.

If anything of an inventive character remained to Strain, patentee of the reissue letters patent in suit,

at the time he entered the field of fruit graders as an inventor, the law applicable to the construction of the letters patent granted him and to the determination of infringing identity based upon that construction is to be found in the following cases in the Supreme Court:

Cimiotti Unhairing Co. vs. American Fur Refining Company, 25 Supreme Ct. Reporter, 697.

Singer Mfg. Co. vs. Cramer, 192 U. S. 265.

Kokomo Fence Machine Co. vs. Kitselman, 189 U. S. 8.

Westinghouse vs. Boyden Power Brake Co., 170 U. S. 537.

Boyd vs. Janesville Hay Tool Co., 158 U. S. 260.

Also in the following cases in the Courts of Appeal and the Circuit Courts:

Brown vs. Huntington Piano Co., 134 Fed. 735.

Rich vs. Baldwin, Tuthill & Bolton, 133 Fed. 920.

Julius King Optical Co. vs. Bilhoefer, 127 Fed. 127.

Overweight Counterbalance Elevator Co. vs. Improved Order Red Men's Hall, 94 Fed. 155.

Griffith vs. Shaw, 89 Fed. 313.

Taber Bas-Relief Co. vs. Marceau, 87 Fed. 871.

Boyden Power-Brake Co. vs. Westinghouse

Air Brake Co., 70 Fed. 816.

Ransome vs. Hyatt, 69 Fed. 148.

Ney vs. Ney Mfg. Co., 69 Fed. 405.

In considering the claim of invention for the machine of the letters patent in suit and the combinations called for by claims 1 and 10 thereof, it must be borne in mind that the Patent Office had no knowledge of the prior use of the California sizer nor the testimony relative thereto. We have no hesitation in asserting that had this machine been before the Patent Office, the claims herein sued on would never have been allowed.

Before passing to a consideration of the appellees' machine, we wish to give slight attention to the claim made in the lower court that the machine of the re-issue letters patent in suit supplanted all other fruit graders. This is not a fact. More correctly stated, it is a case of suppression and not supplanting. The record herein discloses that the manufacture of such machines of the rope and roller type as were placed on the market prior to the issuance of the Strain letters patent were stopped by suits brought by Fred Stebler (appellant herein) for infringement of the Ish letters patent owned by his company. After securing the Strain patent in suit, Fred Stebler, according to the record, virtually discontinued the manufacture of the California sizer, protected under the generic claims of the Ish patent, and proceeded to place on the market the Strain sizer. Under these circumstances, the Strain machine cannot be said to have supplanted other machines. It is a case where the appellant herein controlled the market, and it is

this control which he seeks to maintain at the present time.

However, where there is no patentable novelty, utility or extended use is of no importance in considering the question of inventions.

In the case of *Voightmann vs. Weis & Ridge Cornice Co.*, 133 F. R. 298, 304, the Court said:

“No extent of use can supply the want of actual invention or cure the vice of mere aggregation. *Adams vs. Bellaire Stamping Company*, 141 U. S. 539, 12 Sup. Ct. 66, 35 L. Ed. 849; *Lehigh Valley R. Co. vs. Kearney*, 158 U. S. 461, 15 Sup. Ct. 871, 39 L. Ed. 1055; *Olin vs. Timken*, 155 U. S. 141, 15 Sup. Ct. 49, 39 L. Ed. 100; *Grant vs. Walter*, 148 U. S. 547, 13 Sup. Ct. 699, 37 L. Ed. 552. This is well summed up by Mr. Justice Brown in *McClain vs. Ortmyer*, 141 U. S. 420, 12 Sup. Ct. 79, 35 L. Ed. 800.”

In *Hotel Security Checking Co. vs. Lorraine Co.*, 155 F. R. 298, the Court said:

“In view of the foregoing, the asserted extensive use into which the device has gone and the large amounts in royalties that have been paid to complainant cannot be considered as giving the device patentable novelty. Upon this point the adjudications uniformly hold that, where there is no invention, the extent of the sales and use of the patented article is immaterial. *McClain vs. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. 76, 35 L. Ed. 800; *Adams vs. Bellaire Stamping Co.*, 141 U. S. 539, 12 Sup. Ct. 66, 35 L. Ed. 849; *Peoria Target Co. vs. Cleveland Target Co. (C. C.)*, 47 Fed. 725; *Olin vs. Timken*, 155 U. S. 155, 15 Sup. Ct. 49, 39 L. Ed. 100.”

In the case of *Tubelt Co. vs. Friedman*, 158 F. R. 430, 439, the Court said:

“Its greater utility, durability, attractiveness, and marketability do not of themselves show patentable novelty. These facts are evidence on the subject, and in very doubtful cases may be persuasive and turn the scale in favor of the patentability of the device. A valid patent must combine utility, novelty and invention. Neither large sales nor popularity nor effectiveness of itself shows patentable invention. Nor do all these combined establish it. See *Duer vs. Corbin Co.*, 149 U. S. 216, 223, 13 Sup. Ct. 850, 37 L. Ed. 707; *Richards vs. Elevator Co.*, 159 U. S. 477, 487, 16 Sup. Ct. 53, 40 L. Ed. 225; *American Sales Book Co. vs. Bullivant*, 117 Fed. 255, 54 C. C. A. 287; *McClain vs. Ortmyer*, 141 U. S. 419, 429, 12 Sup. Ct. 76, 35 L. Ed. 800; *Union Biscuit Co. vs. Peters*, 125 Fed. 601, 609, 60 C. C. A. 337; *Falk Mfg. Co. vs. Missouri R. Co.*, 103 Fed. 295, 43 C. C. A. 240; *New Departure Bell Co. vs. Bevin Bros. Mfg. Co.*, 73 Fed. 469, 19 C. C. A. 534; *Dodge Coal Storage Co. vs. N. Y. C. & H. R. R. Co.*, 150 Fed. 738, 80 C. C. A. 404.”

In the case of *McClain vs. Ortmyer*, 141 U. S. 419, the Court said:

“That the extent to which a patented device has gone into use is an unsafe criterion even of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often effected by extensive and judicious advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the articles themselves.
* * * While this Court has held in a number of cases, even so late as *Magowan vs. New York Belt. & Pack. Co.*, 141 U. S. 332, decided at the present term, that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility, it is not conclusive even of that—much less of its patentable novelty.”

The same rule is applied in *Lovell Mfg. Co. vs. Cary*, 147 U. S. 623.

In the case of *Adams vs. Bellaire Stamping Co.*, 141 U. S. 539, the Court said:

“Nor under the circumstances did the Court err in declining to instruct the jury, that the fact that the Irwin lantern had practically superseded all others was strong evidence of its novelty. The question before the Court upon the main issue was not of the novelty of the invention, but rather of its patentable character. Where there is no invention the extent of the use is not a matter of moment.”

In the case of *Olin vs. Timken*, 155 U. S. 141, 155, the Court said:

“And while the patented article may have been popular and met with large sales, that fact is not important when the alleged invention is without patentable novelty. *Duer vs. Corbin Cabinet Lock Co.*, 149 U. S. 216.

ALLEGED INFRINGING MACHINE.

The claimed infringing machine is the output of the Parker Machine Works, a company located and doing business at Riverside, Southern District of California. The said works is engaged in the manufacture and sale of packing house machinery generally, fruit grading or sizing machines being one of its outputs. The owner of the works is George D. Parker, one of the appellees herein, and the other appellee is a user of the grading machine purchased from the Parker Machine Works. The grading machine placed on the market by the Parker Machine

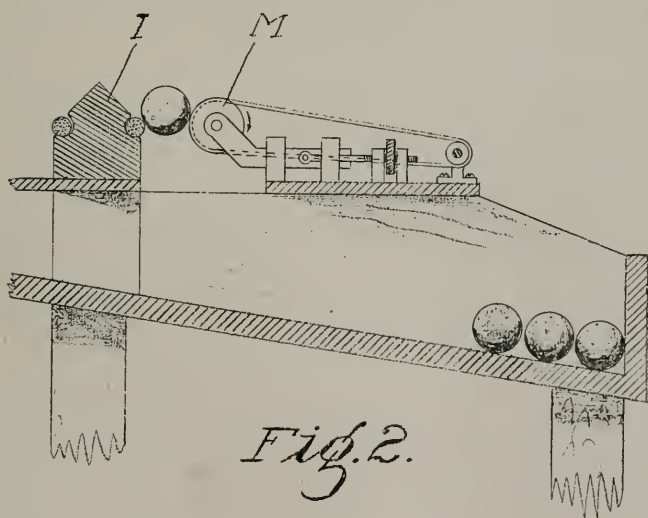
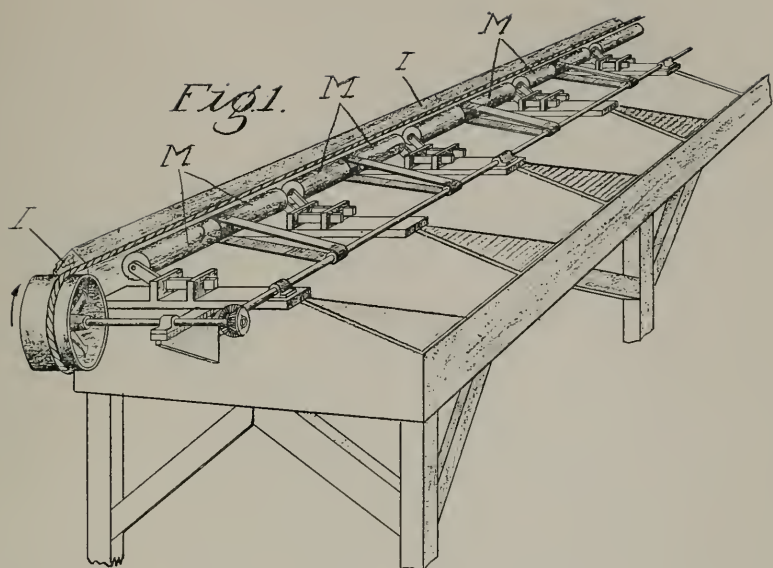
Works and claimed to be an infringement of claims 1 and 10 of the reissue patent in suit, is protected by United States letters patent No. 997468, issued to George D. Parker, July 11, 1911, for an improved Fruit Sizer or Grader, the said letters patent appearing on p. 784 of the record.

The presumption arising from the grant of a subsequent patent to the defendant is that there was a substantial difference between inventions.

For comparison we present a cut of appellant's machine and a cut of appellees' machine, Figs. 1 and 2 representing appellant's machine and Figs. 1, 2, 3, and 4 appellees' machine.

As heretofore pointed out and as will be noted by reference to Fig. 1 of the cut, the inner member of the runway of appellant's machine is the non-movable grooved guide I, and the outer rotary member of the runway consists of a series of "end to end" rollers M. The non-movable guide member lies parallel with the plane which passes vertically and longitudinally through the center of the rollers, and the said guide and rollers constitute the parallel members of the fruit runway for the grader.

Comparing appellees' machine with appellant's machine, it will be noted that the fruit runway is composed of two non-rotary members, of which the inner member A constitutes the outer inclined surface of the table of the machine and serves as a support for the propelling belt B, which conveys the fruit through the runway. The outer non-rotary member is composed of a series of longitudinally movable open frames C, each being provided with laterally extended arms D. The opening E of each



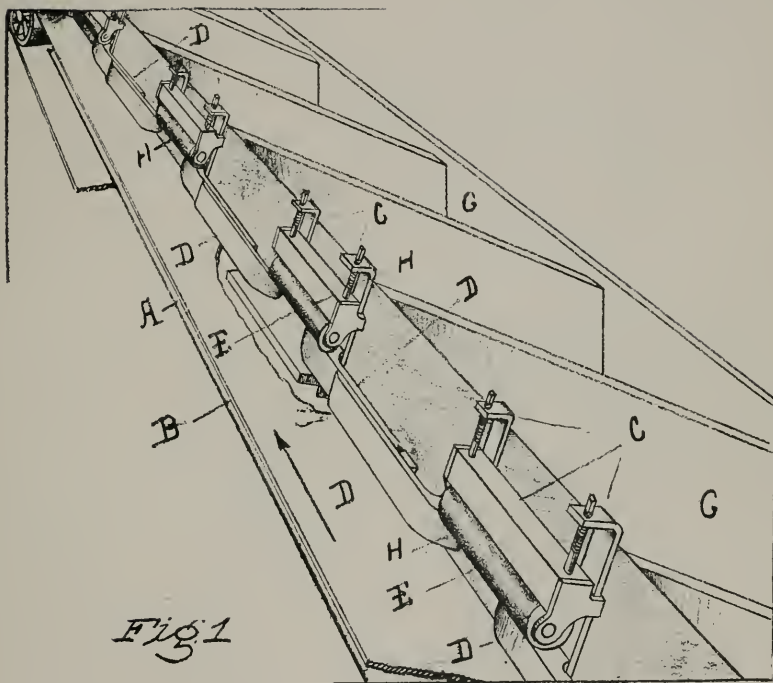
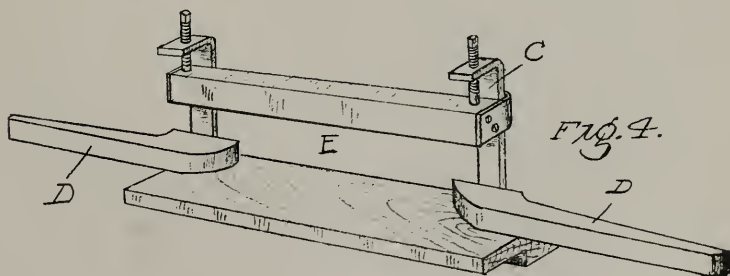
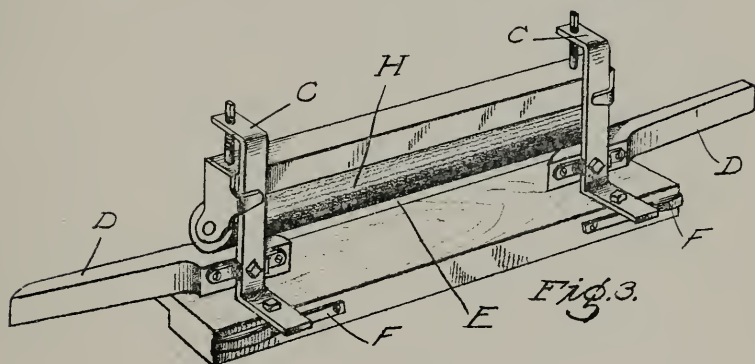
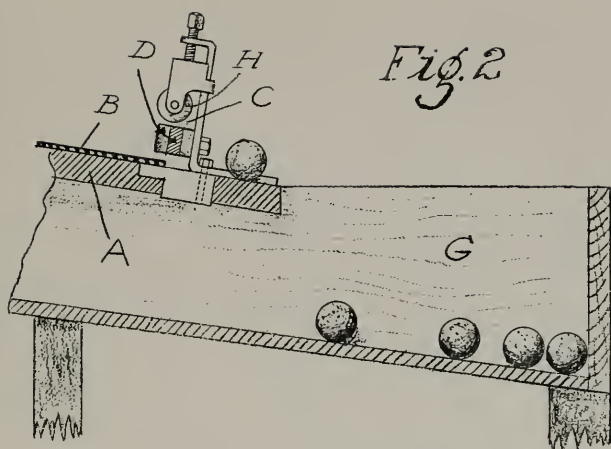


Fig 1



frame constitutes the discharge outlet for the fruit, there being a frame C for each size of fruit to be graded. These frames are adjustably attached to the outer edge of the inclined table A, by clamping means F.

It is these open frames C with the overlapping arms D which constitute the non-rotary outer member of the fruit runway for the fruit, and it requires but a casual glance to convince anyone that this arrangement of longitudinally adjustable frames C does not provide a rotary member of a fruit runway consisting of a series of rotary "end to end" rollers. In the operation of appellees' machine, the fruit passing over the support or inclined surface of the table A, being conveyed thereover by the belt B, as it reaches an outlet opening E of proper size in any one of the series of open frames C, the fruit escapes there through and flows into the fruit bin G, controlled by such frame. To adapt the machine for fruit of varying kinds, it is preferable that the outlet opening E of each frame C be controlled to vary the opening thereof vertically. Preferably, for this purpose there is adjustably mounted in each frame a roll H, which may be adjusted vertically to vary the height of the opening D in order that the outlet of each frame C may be regulated for the fruit to be sized. While the roll H serves to adjust the opening C, its main function is to provide a cushioned surface against which the fruit impinges as it escapes through any one of the frames C, the elasticity provided for by said roll preventing the fruit being injured, which would be liable to occur if the fruit was forced against the edge of a metallic adjustable bar

or non-elastic plate. Of course, an adjustable canvas flap would answer the same purpose, but preferably an adjustable roller is employed for this purpose, just as is utilized in connection with the machine of the Bailey patent. In appellees' machine the outer wall of the fruit runway is a non-rotatable member composed of a series of aligned open frames C, gradation for such open frames being provided for by the adjustable cushion rolls H, situated within each of the openings of the frames C.

At best, it can only be said of appellees' machine that it has a fruit runway provided with graduated outlets for the fruit to be sized, but such is in common with every fruit runway of the machines of the prior art. This feature of a runway is not new in appellant's machine and no novelty can be claimed therefor, and, as a matter of fact, this is the only feature in common between the appellant's and appellees' machine.

The cushion rolls H of the appellees' machine are not designed for the purpose of providing a rotary parallel member for a fruit runway consisting of a series of end to end rolls, for, as a matter of fact, the said rolls are separated and located a long distance apart. Again, the said rolls are not arranged so that they, in combination with a non-movable grooved guide member lying parallel with a plane which passes vertically and longitudinally through the center of the rolls, shall constitute a fruit runway, as called for by claim 1 of the patent in suit. In fact, no such non-movable grooved guide is found in appellees' machine, unless the inclined portion of the table A be treated as such. Even then, the in-

clined supporting surface of said table does not lie parallel with a plane which passes vertically and longitudinally through the center of rollers which form the opposing member of a fruit runway.

It will thus be seen that the Parker patented machine is not a fruit grader having a plurality of independently transversely adjustable rotating rollers as one member of a fruit runway, element of claim 1 of the patent in suit.

It has not "a non-movable groove guide lying parallel with the plane which passes vertically and longitudinally through the center of rollers forming an outer member of a fruit runway," element 2 of the claim.

Its fruit runway is not formed of such a series of independently transversely adjustable rollers and a non-movable grooved guide, element 3 of the claim, and it has not such a constructed runway provided with a propelling rope working in the groove of the non-movable grooved guide.

Thus every combined element of claim 1 of the patent in suit is lacking in appellees' machine.

Appellees' machine does not fall within the terms of claim 10 of the reissue letters patent in suit, inasmuch as there is lacking in said machine the features which induced an allowance of the claim, viz.: "a runway formed of two parallel members, one of said members consisting of a series of *end to end* rolls," and equally so it lacks the detailed bearing brackets for the rolls and the adjusting means for the brackets called for by the claim.

Appellant contends that the expression "end to end" positioning of the rolls does not mean that they

shall be arranged actually *end to end*, but that by such expression is meant an end toward end disposition of the rollers, so that if the rollers are situated eighteen inches, two feet, or more apart, such an arrangement is covered by the claim.

In answer to this proposition we assert—

1. That it is essential under the disclosure of appellant's patent in suit that the rotary parallel member of the runway be composed of rollers placed "end to end," and not end toward end, in order to produce a substantially unbroken rotary wall surface.

2. That no other form of constructed rotary member is disclosed by the patent in suit.

3. That any other arrangement of the rolls forming the rotary member of the fruit runway would produce an inoperative machine for the successful sizing of the fruit.

4. That to expand the expression "end to end" into "end toward end" is to give to appellant that which the patentee did not invent and so enlarges the claim as to embrace the prior art.

5. That it was only by so limiting the construction of the rotary member to a series of "end to end" rollers, together with the detailed supporting and adjusting means for the rollers that the patentee induced an allowance of the claim.

We assert without hesitation that neither claim of the reissue patent in suit is infringed by appellees' machine.

In the lower court it was argued, with some degree of seriousness, that the overlapping extended arms of the open grade frames of the Parker patented

machine was the equivalent of appellant's construction with certain rolls of the rotary member blocked out or rather put out of commission, it being stated that in place of such roll a filler stick may be employed for guiding the fruit from one roll of the rotary member of the fruit runway to the successive roll, and such construction is the equivalent of the guide arm employed by the appellees for permitting the fruit to pass through the fruit runway of the machine.

We are frank to state that such an arrangement is not understood, and, furthermore, that no such arrangement can be employed and the integrity of the grader maintained. However, no such disclosure is given by the specification and drawings of the patent in suit. Such a contention is absurd, and we seriously question the sincerity of appellant in advancing the same.

The absurdity of the statement will be appreciated when it is understood that each independently adjustable roll of appellant's machine and each open frame of the appellees' machine stands for one grade of fruit, and in the patent in suit we are told that there is provided a grade roller for each grade of fruit and that in "*orange grading there are usually nine grades.*" If the machine is provided with nine independently adjustable grade rollers, as called for by the patent in suit for the grading of oranges, and you cut out one of the series of end to end rollers by the employment of a filled stick or other means to block out one or more of such rollers, you then destroy the usefulness of such roller and lose the grade of fruit which such roller is to take care of. If two

rollers are cut out, then two grades of the fruit is lost, so for each roller cut out. The machine when so mutilated will not operate to successfully grade oranges, and any such mutilated machine would not be given consideration to by any packing house in connection with the sizing or grading of oranges, for it would defeat the very purpose for which graders of this class are designed. Furthermore, appellant Stebler, manufacturer of the fruit grader of the patent in suit, never placed a machine on the market equipped with filler sticks nor ever explained to a purchaser of such machines how the same could be employed. In support of this statement, attention is directed to the testimony of appellant Stebler in answer to R. C. Q. 7, record p. 114 to X. Q. 63 to 98, record pp. 647-650, also answer to X. Q. 180, p. 660.

Appellees' machine is entirely different from appellant's machine, and performs a function never contemplated by patentee Strain and which cannot be carried out by a machine constructed under the reissue patent in suit. In appellees' machine the outer member of the fruit runway is composed of a series of *longitudinally adjustable non-rotary units*, each unit having an outlet opening for the fruit and in each outlet opening there is mounted a vertically adjustable elastic cushion. The purpose of the longitudinal adjustment provided for the non-rotatable units of the said machine, is to permit the fruit bins to be adjustable in order that the capacity thereof may be varied to accommodate them to the different runs of the fruit as to size. Where the bins are adjustable, it is required that the grade unit be adjusted longitudinally in order that the graded or

sized fruit may be delivered as nearly as possible to the center of the bin. This is best explained by the following testimony of witness Parker in answer to Q. 69 to 78, record pp. 333-335:

“Q. 69. How does the end to end arrangement of rollers in the California sizer model conform to the end to end arrangement as disclosed by the letters patent in suit? A. They are identical.

“Q. 70. How does the operation of the co-acting parts in the Parker machine, as illustrated by the model exhibit, compare with the operation of the working parts of the sizer of the patent in suit?

“A. They are entirely different, and are adjustable longitudinally of the sizer, each roller being a distinct sizer, independent of all the others, the sizer or opening for the fruit conforming to the sizes on the run of the fruit. The sizing portions may be any distance apart longitudinally of the sizer. In the Strain or Stebler sizer the rollers abut or form a continuous roll from end to end.

“Q. 71. What purpose is accomplished by the longitudinal adjustment permitted in the Parker machine of the sizing units?

“A. In sizing for fruit at different seasons of the year, they run to an excess of one size, making it necessary that the bins be adjustable where the fruit may run a large proportion of one size. Of late years it has been necessary to have what they style an adjustable bin. In the Parker sizer we adjust our sizing member longitudinally to conform with the run of the fruit, and the run of the fruit determining the size of the bins holding the same. This makes a very flexible, if one might use that term, adjust-

able of the bins, allowing a large variation in the size of the same. In this machine, constructed as it is, we get about fifty per cent more bin-room in relation to the floor space occupied than is gotten by the Strain or Stebler sizer of the present style as manufactured and installed. The adjustable bin feature is the principal reason for any changes in the equipment of the ordinary house as equipped for packing fruit. The outputs of the same increasing from year to year, and as installed by the Strain sizer made in lengths up to 40 feet, there was no provision made for the adjustment of bins, it not being practical to make the sizers longer, and the packing-house people were calling to some extent for some of the advantages of the overhead or elevated California sizers, in which the fruit was allowed to roll down inclined chutes or roll-ways, and could be switched from one portion of the bins to another. In this switching or adjustable bin feature, it allows more packers to pack in a given floor space, and by making the bins larger, to hold any particular fruit, which may be running to an excess, it allows more packers to pack from that particular size of fruit.

“Q. 72. What is the purpose of the rolls or rollers appearing in connection with the grading units of the Parker device as disclosed by the model exhibit?

“A. They are buffers or cushions which relieve the tension or binding of the fruit as it is being sized.

“Q. 73. Are you familiar with the construction and operation of the Stebler sizer as utilized in the packing-houses, and by the Stebler sizer, I mean the sizer conforming to the sizer in the letters patent in suit? A. Yes.

“Q. 74. What provision, if any, is made in the

Stebler sizer to vary the run of fruit to any given bin or to permit of the adaptability or adjustment of the bin to the run of various sizes of fruit?

“A. There is none.

“Q. 75. Have you read the testimony given by Fred Stebler in connection with the present suit?

“A. Yes sir.

“Q. 76. What have you to state regarding the use of filler-sticks referred to by Mr. Stebler in his testimony?

“A. We do not see how the same could be used, and the sizer utilized in its entirety.

“Q. 77. What do you mean by ‘not utilized in its entirety’?

“A. If we use a filler-stick we lose that grading space.

“Q. 78. Do you know of any instance where filler-sticks have been employed in connection with the Strain sizer?

“A. I do not.”

Appellees' machine is protected by the grant of letters patent covering the invention disclosed thereby, and the patented machine is directed toward adapting the grading units to the adjustability of the fruit bins, apparently a new feature in connection with fruit graders. While it is true that appellant has a patent, it is respectfully submitted that the validity thereof is seriously questioned in view of the prior art as disclosed by the patent record and more particularly by the prior art and public use as disclosed by the California Grader, which was unknown to the Patent Office. If any invention re-

sides in the machine of the letters patent in suit, it seemingly is microscopic. Anyway, it is not a pioneer invention, and the substance of the invention (if any) is not found in appellees' machine.

The case of Kokomo Fence Machine Co. vs. Kitselman, 189 U. S. 8, is very applicable to the case at bar, in that in addition to the statement of the rule of claim construction of patents which are not "pioneers" it limits that construction still more closely where the defendant has a patent, and plaintiff and defendant are contending as to infringement "on an equal field," and by reason of the presumption which arises from the grant of the defendant's patent. The Court says that under the circumstances of that case, the claims must be limited in their scope to the *actual* combination of essential parts shown, and cannot be construed to cover other combinations of elements of *different construction and arrangement*.

The opinion was rendered by Mr. Chief Justice Fuller. The history of the case below is first briefly stated. The Circuit Court was of the opinion that none of the complainants' patents was a pioneer invention, but that all were merely improvements on the prior art, and to be construed in that light. "In its judgment, complainants and defendants contended as to infringement on an equal field, the presumption of the validity of the complainants' patents being met by the presumption of the validity of the patent to Whitney," referring to the defendants' patent.

The Circuit Court thereupon found that there was no infringement and dismissed the bill.

The case was taken then to the Circuit Court of Appeals, which Court "concurrent with the Circuit Court that the case turned upon the question whether the patents sued on embodied a pioneer invention; that if complainant's invention was not of the prior art, defendant's machine was so sufficiently differentiated that the claim of infringement could not be maintained; while on the other hand, if complainant's patents were the first to give to the world a workable portable machine for weaving wire fences in the field, a machine distinctly creating a new product, and aptly embodying in their specifications and claims the mechanical arrangements that bring about such a result, the decree below is erroneous."

The Circuit Court of Appeals upon reviewing the state of the art found that the Kitzelman patent, one of the patents sued on, was entitled to be treated as embodying primary invention and to such liberal construction as brought defendant's machine within it. But the Supreme Court found with the Circuit Court that it was not a pioneer patent, and said of it:

"In view of what passed in the Patent Office and the state of the art, we cannot regard the Kitzelman patent as a pioneer patent, but think its claims must be limited in their scope to the *actual* combination of the essential parts shown and cannot be construed to cover other combinations of elements of *different construction* and arrangement."

Concerning the effect of the defendant's patent, the Whitney patent, the Supreme Court says:

"Considering the complainants' and Whitney

as alike having improved on the prior act, the question is whether the specific improvement of the one actionably invaded the domain of the other. *The presumption from the grant of the letters patent is that there was a substantial difference between the inventions.*”

It will be seen that all the Courts before which the case was heard concurred in the different rule of construction as applicable to pioneer inventions and those which are mere improvements. The Supreme Court in concluding its opinion, says:

“For the reasons given in treating of the Kitselman patent we think that none of the complainant’s patents embodied primary invention, and we concur with both the Courts below that, this being so, the differences in means and operation between defendant’s machine and the others were such that there was no infringement. It does not seem necessary for us to enumerate these differences in respect of the other three patents. This was well done in the Circuit Court, and the Circuit Court of Appeals accepted the view of that Court as to the absence of infringement if primary invention did not exist. We are content with that conclusion.”

The case of *Westinghouse vs. Boydel Power Brake Co.*, 170 U. S. 537, from which the definition of the term “pioneer” is taken, as fully quoted above in discussing the *Cimiotti Unhairing Co.* case and the *Singer Mfg. Co.* case, points to an abuse even in finding infringement of “pioneer” claims, and lays down a restriction, which it will be well to note. Mr. Justice Brown, who delivered the opinion of the Court, quotes from Mr. Justice Grier in *Burr vs. Duryee*, 1 Wall. 531, 572:

“An infringement involves substantial identity whether that identity be described by the terms ‘same principle,’ same ‘modus operandi’ or any other. The argument used to show infringement, assumes that every combination of devices in a machine which is used to produce the same effect is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term ‘equivalent.’ ”

The opinion of Mr. Justice Brown then proceeds:

“We have no desire to qualify the repeated expressions of this Court to the effect that, where the invention is functional, and the defendant’s device differs from that of the patentee only in form, or in a rearrangement of the same elements of a combination, he would be adjudged an infringer, even if, in certain particulars, his device be an improvement upon that of the patentee. But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that a function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function. Mere variations of form may be disregarded, but the substance of the invention must be there. As was said in *Burr vs. Duryee*, 1 Wall. 531, 573, an infringement is a copy of the thing described in the specification of the patentee, either without variation or with such variations as are consistent with its being in substance the same thing. If the invention of the patentee be a machine, it will be infringed by a machine which incorporates in its structure

and operation the substance of the invention; that is, by an arrangement of mechanism which performs the same service or produces the same effect in the same way or substantially the same way, etc. That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used are therefore mere equivalents for those of the other."

It must be remembered that this language is used in respect to primary patents. That the principles there stated find no place in construing patents for mere improvements is plainly indicated further along in the opinion where it says:

"Conceding that the functions of the two devices are practically the same, the means used in accomplishing this function are so different that we find it impossible to say, *even in favor of a primary patent, that they are mechanical equivalents.*"

The case of *Boyd vs. Janesville Jay Tool Company*, 158 U. S. 260, is particularly applicable to the case at bar, in that the patent sued on was not a pioneer, and the defendant was operating under a patent of its own. Under these circumstances the Court limited the patent sued on to its *precise* devices, and not finding these *precise* devices in defendant's machine, held that there was no infringement. Mr. Justice Shiras delivered the opinion of the Court. He said:

"It clearly appears that Boyd was not a pioneer in this department of machinery. Many inventors had preceded him, and many patents had been issued for improvements in hay car-

riers in form and purpose similar to those described in Boyd's specification. We think the case is one where, in view of the state of the art, the patentee is only entitled, at the most, to the *precise* devices mentioned in the claims."

The opinion then states that the appellant has failed to show that the defendants have used the particular devices to which Boyd can be considered entitled. It quotes from *Pavement Co. vs. City of Elizabeth*, 4 Fish. 189:

"The grant of the letters patent" (referring to the complainant's and defendant's patents) "was virtually a decision of the Patent Office that there is a substantial difference between the inventions. It raises the presumption that, according to the claims of the latter patentees, this invention is not an infringement of the earlier patents."

The opinion concludes:

"Doubtless, if the Boyd patent contained an invention entirely new, and first adapted to the end sought, such differences" (referring to the differences between the complainant's and the defendant's machines) "might be regarded as formal and evasive. But, coming as he did in the train of the numerous inventors that had preceded him, whose inventions had been patented and put into practical use, we must conclude that Boyd, if entitled to anything, is only entitled to the *precise* devices described and claims in his patent. Of course, it follows that if the defendant's specific devices are different from those of Boyd, no combination of such devices could be deemed an infringement of any combination claimed by Boyd."

This ruling is directly applicable to the present case. The Strain patent sued on is not a pioneer patent. The state of the art shows that, if valid at all, it must be confined to its precise devices. These precise devices are not found in the appellees' machine, and there can, therefore, be no infringement.

Careful examination of appellant's brief (copy of which has been received since the writing of the foregoing), discloses no reason for modifying anything herein stated.

On pages 15 and 16 of appellant's brief is contained the following relative to the Strain invention:

“His invention resides broadly in the use of the individual rollers, each mounted independently of the other, and each separately and independently adjustable toward and from the carrier belt.”

This, we believe, is an erroneous statement, for which no foundation is found in the letters patent in suit nor in the claim thereof. At most, all that can be contended for under claims 1 and 10 of the letters patent in suit is that its fruit runway shall be formed of two parallel members, one of said members being non-movable and the other a rotary member, the rotary parallel member being composed of a series of end to end rollers independently adjustable toward and from the non-movable parallel member. In appellees' device no such formed fruit runway is present. As previously pointed out, in appellees' machine the fruit runway is formed of two non-rotative parallel members, one of which members is provided with cushioned graduated outlet openings. To hold appellant's invention to reside in the use of

independently adjustable rollers, is to give to the letters patent that which was refused by the Patent Office.

The only distinction between claims 1 and 10 resides in claim 10 calling for the specific supporting brackets for the end to end rollers and the specific means for adjusting the brackets, which supporting brackets and adjusting means are eliminated from claim 1. This is our understanding of the difference between the two claims in suit, and in this we are supported by the decision of his Honor, Judge Wellborn, and equally so by the appellant, for on page 43 of appellant's brief we are told "Claim 10 differs from claim 1 in its reference to the means for supporting the rolls." Thus we find each claim calls for a fruit runway composed of two parallel members, one being non-movable and grooved to receive a propelling rope for the fruit runway, and the other member being rotary and composed of a plurality of end to end rollers independently adjustable toward and from the non-movable grooved member. As stated, no such constructed fruit runway is found in appellees' machine.

On page 73 of appellant's brief the prior references are treated as "paper conceptions." Just how this applies to the California grader admitted by complainant's witnesses and equally so by all of defendant's witnesses not only to have been a practical and successful machine, but one in use at the present time, we are at a loss to understand. Throughout his brief, appellant has treated the Ish patented grader and the California grader as one and the same machine. Such is not the case. In the Ish

patent the fruit runway is formed of two parallel members, one being a non-movable member and the other a rotary member composed of a single stepped roller, and a traveling belt working over the non-movable member for propelling the fruit through the machine. The California grader differs from the Ish grader in this—of the two parallel members constituting the fruit runway, the non-movable member is grooved and within said groove works a propelling rope for the fruit, the opposing member of the fruit runway is a rotary one composed of a series of end to end rollers, brackets for the rollers, and means for adjusting the brackets supporting the end to end rollers.

This California grader if made for the first time after the issuance of the Strain patent in suit, would constitute an infringement of claims 1 and 10 of the reissue letters patent. Such being the case, the prior use and continued use of the said machine anticipates the said claims and the same are invalid.

Of the so-called “paper conceptions, the patent to Hutchins, Ish, Ellithrope, Stevens, and Dillman were cited by the Patent Office in anticipation of the original claims as filed in connection with the application on which the claims in suit were granted. At such time no effort was made to differentiate the inventions of the rejected claims from such patented devices. In fact, the rejection was based on said prior patents acquiesced in and the broad claims cancelled. Appellant is estopped from now claiming the non-pertinency thereof and from having the claims expanded to cover that which was rejected and cancelled.

We submit that these conclusions are fully proven.

CONCLUSION.

First. The lower court properly held that claims 1 and 10 of the reissue letters patent in suit had not been infringed by the appellees herein.

Second. That said claims 1 and 10 are invalid by reason of the existing prior art and more particularly so by reason of the admittedly prior use of the California grader.

Respectfully submitted.

N. A. ACKER,
WM. M. HIATT,
H. L. CARNAHAN,

Solicitors and Counsel for Appellees.

N. A. ACKER,
Of Counsel.

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No. 2232.

United States

Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

Fred Stebler,

Complainant and Appellant,

vs.

Riverside Heights Orange Grow-
ers Association and George D.
Parker,

Defendants and Appellees.

REPLY BRIEF OF APPELLANT.

The trial court decreed that claims 1 and 10 were good and valid in law. No appeal has been taken from such decree by defendants, although after the court announced that it found the patent in suit valid and that said claims 1 and 10 were not anticipated by anything shown in evidence by defendants, defendants insisted upon the decree setting forth such finding of validity. Defendants are, therefore, met *in limine* with the question: is the validity of such patent or of either of such claims open to question by them in this court upon appellant's appeal? The assignments of error raise the single question of infringement.

Leaving this question for the court to determine, we submit that the decree of the lower court is correct as to the validity of the patent in suit and as to each of said claims.

In determining the question of anticipation of an invention the first and primary inquiry is,—*does the alleged anticipating device have the same mode of operation and secure the same result in substantially the same manner?* If this be answered in the negative, no anticipation is shown.

This is emphasized by this court in its opinion in *Los Alamitos Sugar Co. v. Carroll* (173 Fed. 280), in which it is stated:

“A device which does not operate on the same principle cannot be an anticipation.”

There is not a single witness who testifies that independent adjustment of the grading-opening in the Ish or California grader can be secured. This new result characterizes the Strain invention and refutes the statement of appellees, in their brief (page 76), that:

“This California grader, if made for the first time after the issuance of the Strain patent in suit, would constitute an infringement of claims 1 and 10 of the re-issue letters patent. Such being the case, the prior use and continued use of the said machine anticipates the said claims and the same are invalid.”

A claim in a patent must be read in the light of the drawing and specifications of the patent which show the purpose of the combination and the objects sought and obtained and the principles invoked in obtaining that object.

As said by the Supreme Court in *Bates v. Coe* (98 U. S. 31):

“Sufficient has already been remarked to show that the invention, in its primary feature, is an improved machine for drilling, composed of the devices pointed out in the specification, which operate and perform the functions therein described, and which by their joint operation in the manner described accomplish the patented result.”

“Where there is only one combination of an entire character, incapable of division or separate use, the defenses of the kind mentioned must be addressed to the invention.”

“Devices in one machine may be called by the same name as those contained in another, and yet they may be quite unlike, in the sense of the patent law, in a case where those in one of the machines perform different functions from those in the other. *In determining about similarities and differences, courts of justice are not governed merely by the names of things, but they look at the machines and their devices in the light of what they do or what office or function they perform, and how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the same result; and that devices are substantially different when they perform different duties in a substantially different way, or produce substantially a different result.* Cahoon v. Ring, 1 Cliff. 620.”

As said by Circuit Judge Putnam of the First Circuit in *American St. Car Adv. Co. v. Newton Co.* (82 Fed. 732-735):

“We do not find it necessary to discuss individually the patents thus cited, or to explain precisely how they bear on each of the topics referred to. *It is sufficient to say that none of them anticipate all the elements found in the claim in issue, and*

none of them are capable of being operated or used in the manner in which complainant's device was intended to be operated and used, as clearly shown by the specification."

The California grader would not infringe the Strain patent, *as the object sought and obtained by Mr. Strain cannot be secured by the Ish or California machine.* The very fact that manufacturers and users have deviated from the exact form of the Ish patent, in many ways, to render it more efficient in use and with all such modifications and improvements failed to attain Mr. Strain's purpose or to utilize the principle of independent and individual control or adjustment of each grade-opening without effecting an adjacent grade-opening, proves conclusively that such principle was not obvious even to the most skilled mechanic in that art. These facts prove most conclusively the presence of invention in the Strain conception.

As said by the Supreme Court in *Webster Loom Co. v. Higgins* (105 U. S. 580, 591):

"But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skillful persons. It may have been under their very eyes, they may almost be said to have stumbled over it; but they certainly failed to see it, estimate its value, and bring it to notice. * * * Now that it has succeeded, it may seem very plain to anyone that he could have done it as well. This is often the case with inventions of the greatest value."

As said by the court in *Bates Mach. Co. v. Wetter Numbering Mach. Co.* (136 Fed. 776), in sustaining the patent there before it:

“The matter is so simple that there is a temptation to conclude that the mere elimination of the screws, leaving the pins to perform the entire function of fixing the position of the plates, and attaching them to the frame, does not show invention, but, on the other hand, such arrangement appears to be highly useful.”

The courts have many times remarked that it was the seemingly obvious and simple things which were the most obscure, and as said by Mr. Justice Brown in *The Barbed Wire Case* (143 U. S. 154):

“In the law of patents it is the last step that wins. It may be strange that, considering the important result obtained by Kelly in his patent, it did not occur to him to substitute a coiled wire in place of the diamond-shaped prong, but evidently it did not; and to the man to whom it did ought not to be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed to grasp.”

The various changes and improvements which were made from time to time in the Ish or California grader, as referred to on page 46 of appellee's brief, served only to lengthen out the machine and provide for more access of the packers to the fruit bins. None of these manufacturers or improvers had any conception of the individual and independent control of the several grade-openings by the operator. They all retained the fixed relation of each grade-opening to the grade-opening adjacent and retained the feature of construction and relation of the parts that compelled the user of the

machine to separate his fruit according to the distinction in sizes or grades set by the manufacturer and prohibited the user from individual control. (See defendants' exhibit model of California sizer.) It is absurd to argue that any machine (so inherently dependent upon a single adjustment of one grade-opening coincidentally adjusting all the grade-openings simultaneously and to the same degree) embodies the Strain invention of independent and individually controllable grade-openings, or that such a machine anticipates, *i. e.*, shows and embodies such feature and principle of independent and individual control of each grade-opening independent of each other grade-opening, when in fact such machine does not embody such principle nor can such result in any way be secured by such machine. It is for these reasons appellant insists that the Ish or California machine fails utterly to anticipate or to show want of invention in the patent in suit. Every witness in this case has testified that individual and independent adjustment of the grade-openings separately of each other cannot be secured in the Ish or California grader. Defendants' expert Cobb admits this. [Transcript page 473, Q. 261.]

No prior device is an anticipation which cannot be made to produce, without substantial alteration of its construction, the same results as those of the subsequent device.

Ryan v. Newark Spring Mattress Co., 96 Fed.

100;

Tannage Co. v. Zahn, 70 Fed. 1003;

Merrow v. Shoemaker, 59 Fed. 120.

The Bailey patent [Transcript page 544] may be dismissed from serious consideration for two important reasons. First: it has been shown by the evidence that this is a mere paper conception which was impractical and never went into use and never in fact had any place in the art and from it no one in fact gained any knowledge and the paper conception of Mr. Bailey was without utility or use in the art and the patent is very evidently simply a "find" of counsel for appellees when searching the patent records for something upon which to found a defense.

"This defense presents the common instance of a patent which attracted no attention and was commercially a failure, being set up as an anticipation of a subsequent patent which has proved a success, because there appears to be in the mechanism described a possibility of its having been, with some alterations, adaptable to the process thereafter discovered."

Carnegie Steel Co. v. Cambria Iron Works, 185
U. S. 425.

But if it were admitted for the purpose of argument that such Bailey patent did disclose something of utility and was entitled to a place in the art as a practical and useful machine, a second important reason remains for its elimination as an anticipation. Both the machine of the Strain patent and the defendants' machines use a belt and the claims under consideration call for combinations in which belts are used. The Bailey patent does not show a belt and a belt could not be used in a machine organized as Mr. Bailey proposed to make it. The rotating element 3 of the Bailey patent, which car-

ries the fruit around, must be made of wood or metal or other stiff material which will turn as a table. A belt cannot be operated in this manner. This shows that the Bailey patent cannot be used by appellees as an anticipation of the combinations of respective claims 1 and 10, and that only by a process of reorganization and rearrangement can either the Strain machine or defendants' machines be deduced therefrom. The grooved guide for supporting the belt and keeping it in place is absent from the Bailey conception. It is necessary in both the defendants' machines and in the Strain machine, and performs the function of centering the belt and supporting the belt against the weight of the fruit. In both the Strain machine and the defendants' machines the longitudinally moving belt is necessarily supported on a fixed support and a grooved guide is formed in such support to prevent the displacement of the belt laterally in either direction. This essential feature of the Strain and defendants' machines is utterly lacking in the Bailey conception.

There are many reasons why the Hutchins patent fails as an anticipation. This patent, like the Bailey, is a mere paper conception. It has never had any place in the actual art. The Hutchins machine is unknown. It is impractical for the reasons pointed out by appellant's expert Mr. Knight (appellant's opening brief, page 67) and the testimony of Mr. Stebler and Mr. Stevenson [Transcript pages 612-619, 721-723, and 765.]

This Hutchins patent also fails as it does not answer to the longitudinal extension of the machine in a hori-

zontal plane, as called for by the Strain patent and claims. This is tersely explained by Mr. Knight:

“As a complete machine, comprising a series of end to end elements, the machine is different *in that the elements are arranged one above another instead of end to end.*”

This distinction between the Hutchins conception and the Strain machine is also true of the defendants' machine and as we have heretofore pointed out illustrates the true meaning of the term “end to end” in the claims of the Strain patent.

Another and vital distinction between this Hutchins conception and the Strain and defendants' machines is that the principle of operation of the Hutchins conception is different from the principle of operation of the Strain and defendants' machines. Bearing in mind that the principle of operation is the first test as to similarity of machines and of comparison of inventions, it is seen that this renders the Hutchins patent ineffective as an anticipation. In the Hutchins conception the intermingled fruit drops onto the first roll, the *largest fruit rolls off the end of that roll*, while all smaller drops through between the roll and moving member, and subsequently each succeeding size is separated and *rolled off the end of a roll*, the sizes being separated successively in accord with the *largest* remaining fruit and all smaller sizes keeping up the drop. In defendants' machines, as in the Strain machine, the smaller sizes are dropped through between the belt and roller forming the respective grading-openings, the separation being made as to successively larger sizes, commencing with the *smallest* first, and only one drop

of any of the fruit being permitted. The separation as to size is effected by permitting only the given size to escape through the given grading-openings.

In Hutchins' theory of a machine the drop of the fruit between the roller and belt is of all the fruit except the largest size, which is carried the length of the roll by the conveying means and is rolled off the end of the roller to suitable receiving means. The individual roller does not contact with any of the fruit except this size. In defendants' and the Strain machines, on the other hand, a single size of fruit is separated by passing through a given grade-opening, while all the other fruit is carried along on such rollers and belt by such openings.

After explaining these differences in the mode and principle of operation of the Hutchins conception and the Strain and defendants' machines, Mr. Knight says:

"In regard to the machine as a whole, *its distinctive principle is different.*"

As said by this court in *Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 280, 284:

"A device which does not operate on the same principle as that of a patent cannot be an anticipation."

In appellees' brief it is admitted that appellees do not contend that any of the many other patents introduced in evidence are anticipations. These other patents, in fact, only show the extent of the novelty of the Strain invention.

As said by the Circuit Court of Appeals for the First Circuit in *Forsyth v. Garlock* (142 Fed. 461, 463):

“The citation of a large number of patents as anticipations tends to strengthen rather than weaken the patent sued upon, by showing that the trade has long and persistently been seeking in vain for what the complainant finally accomplished.”

Supported, as it is, by the abundance of evidence of the public adoption and general use of the Strain invention, and its entire superseding of all other machines for the purpose, the Strain patent is of unchallengable validity.

As said by the Supreme Court in *Winans v. Denmead* (15 How. 340):

“Its substance is a new mode of operation, by means of which a new result is obtained. It is this new mode of operation which gives it the character of an invention, and entitled the inventor to a patent; *and this new mode of operation is, in view of the patent law, the thing entitled to protection.*”

To the same effect see:

McSherry Mfg. Co. v. Dowagiac Co., 101 Fed. 716;

Brown Bag Filling Co. v. Drohen, 140 Fed. 107;

Gandy v. Main Belting Co., 143 U. S. 587;

Farmers' Mfg. Co. v. Spruks Mfg. Co., 127 Fed. 691;

Sayre v. Scott, 55 Fed. 971.

In *Keystone Mfg. Co. v. Adams* (151 U. S. 142) the Supreme Court held that the Henry Adams corn sheller was an invention, and was patentable to him, although

his father, Augustus Adams, had previously made a corn sheller from which that of Henry differed only in reversing the direction of revolution of one of its parts. That part was the revolving beater, which Augustus Adams made to turn in the direction opposite to the desired motion of the ears of corn, expecting it to knock back any ear that might ride upon another, and thus tend to prevent choking the shelling devices. This mode of operation was not entirely satisfactory and Henry Adams reversed the revolution of the beater so that its wings moved in the same direction as that of the ears of corn, thus driving them forward into the shelling devices. The old combination, with that new mode of operation, was highly successful, and the patent thereon was held to be valid and given a liberal interpretation.

“In determining the question of invention, the fact that the article produced supersedes all other appliances, or that a useful or commercial result has been attained, or that the value of the thing patented has been recognized by the public in extensive use, has a controlling if not conclusive effect; and it should have on obvious principles of justice to one who sees that which he suggests constantly adopted and used by others.”

Wilkins Shoe B. Co. v. Webb, 89 Fed. 982;

Krementz v. Cottle Co., 148 U. S. 556;

Western Elec. Co. v. Chicago Co., 14 Fed. 691;

Star Brass Co. v. Gen. Elec. Co., 111 Fed. 398;

Union Biscuit Co. v. Peters, 125 Fed. 601;

St. Louis Flushing M. Co. v. American Co., 156 Fed. 574, 577;

Robbins v. Dueber Watch Case Co., 71 Fed. 186.

Your Honors have said, in *Morton v. Llewellyn* (164 Fed. 693) :

“Apart from the presumption of validity that always attends the grant of a patent, the law is that where it is shown that a patented device has gone into general use and has superseded prior devices having the same general purpose, it is sufficient evidence of invention in a doubtful case.”

In constructing an argument against the validity of claims 1 and 10 and in support of an attempted defense of anticipation appellees have fallen into the same error common to those who first appropriate an invention (which has gone into extensive use and proven its commercial value), and then seek by picking out one similarity in one prior device and another similarity in another prior device and by putting the two together form a hypothetical device which did not in fact exist in either of these prior devices and which will approximate the invention and secure its results. The argument of pages 34-40 of appellees' brief is based upon a combination of features and principles of the Hutchins patent and the Bailey patent and of the Ish or California grader and is an admission that the combinations of the respective claims 1 and 10 of the patent in suit are not found in either of these alone. Such an attempted building up of a prior art has been denounced by this court in

Los Alamitos Sugar Co. v. Carroll (173 Fed. 280) :

“It is not sufficient to constitute an anticipation that the devices relied upon might by a process of modification, reorganization, or combination, be made to accomplish the function performed by the device of the patent.”

In *Western Elec. Co. v. Home Tel. Co.* (85 Fed. 649), in discussing this principle of patent law, the court says:

“The force of this ruling is made manifest, in its practical application to the rights of parties, by the reflection that all earlier patents set up in defense against a later patent sued upon are but the record evidence of the state the art has reached. The rights under such later patent are subject to what this record actually shows. To change this record, by permitting theoretical modifications of these earlier patents, would be the same, in force, as to change, by interpolations or modifications, any other evidence between the parties.”

This rule is well established.

See

Wayne Mfg. Co. v. Benbow Brammer Co., 168 Fed. 271;

Topliff v. Topliff, 145 U. S.;

Gunn v. Bridgeport Brass Co., 148 Fed. 239;

Zubelt Co. v. Friedman, 158 Fed. 430;

Tannage Co. v. Zahn, 70 Fed. 1003;

Ryan v. Newark Co., 96 Fed. 100;

Simonds R. M. Co. v. Hathorn Mfg. Co., 90 Fed. 201-208;

Gormully & J. Co. v. Stanley Cycle Co., 90 Fed. 279;

Merrow v. Shoemaker, 59 Fed. 120;

Western Elec. Co. v. Capital T. & T. Co., 86 Fed. 776.

“One who takes old devices, with material defects, and retaining the desirable features, adapts them by novel modifications to new and varying

conditions, so as to produce an article superior to all others, is not anticipated by such prior devices.”

Wales v. Waterbury Mfg. Co., 59 Fed. 285.

As the burden of proof is upon the defendants to *prove* anticipation it is not sufficient for them to show that someone *might* have produced a machine capable of performing the function thus accomplished by Robert Strain's invention but they must show that prior to Robert Strain's invention someone *did actually produce such a machine in a practical form*.

The entire testimony in this case shows conclusively that the Robert Strain invention for the first time produced a practical and commercial machine in which the user could control as he desired each grade-opening without affecting any other grade-opening. This new result cannot be and must not be ignored or overlooked. It is the very essence of the patent in suit and it is, as we have already shown, and, as is admitted by defendants, found in defendants' machines.

In reviewing this question of infringement we desire, in addition to the decisions cited on pages 18-27 of appellant's opening brief, to call attention to the recent decision of the court in

American Caramel Co. v. Glen Rock Co., 201
Fed. 363,

in which the correctness of appellant's position is demonstrated. The court says:

“The holder manufactured and sold by the defendant is clearly within the range of these claims. Neither of the defendant's experts have denied that the holder embodied the construction claimed, while

both of complainant's experts have found that this holder embodies *the structure and all of the advantages described and claimed in the patent*. True, it has some features not described in the patent; but these are added to those described in the patent, and not substituted for them. The defendant's holder has certain ribs or creases across its surface and about its margin, no doubt intended to stiffen it; otherwise it has the flanges as claimed by the complainant's patent, which necessarily are produced by like operation. *The idea covered by the patent is completely embraced in the idea expressed in the infringement, although the latter is more comprehensive than the former.*

"Identity exists with reference to the question of infringement, if the idea of means protected by the patent is found, substantially existing, in the invention practised by the alleged infringer." Robinson on Patents, vol. 3, par. 892; *Lourie Implement Co. v. Lenhart et al.*, 130 Fed. 122, 64 C. C. A. 456; *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 Fed. 116, 74 C. C. A. 310.

"That the flanges of defendant's holders are segmental or almost semicircular in outline, while in the patent they are shown as rectangular, is not of importance, *since they perform the same functions in either, and their form has, therefore, nothing to do with the essence of the invention. Neither technical distinctions nor differences of appearance are as important in determining questions of identity as the substance of the matter in controversy in arriving at the conclusion whether the real inventive thought has been appropriated by the defendant.*

"*The court will look through the disguises, however ingenious, to see whether the inventive idea of the original patentee has been appropriated, and whether the defendant's device contains the material features of the patent in suit, and will declare infringement, even when those features have been supplemented and modified to such an extent that the defendant may be entitled to a patent for*

the improvement.' *Crown v. Aluminum Stopper Co.*, 108 Fed. 845, 48 C. C. A. 72; *Robins v. American Road Mach. Co.*, 145 Fed. 923, 76 C. C. A. 461; *Norton v. Jensen*, 49 Fed. 859, 1 C. C. A. 452; *Dowagiac v. Superior Drill Co.*, 115 Fed. 886, 53 C. C. A. 36."

Defendants have never denied that in their machines they have the independent and individual adjustment of each roller with respect to the surface of the belt, or that this adjustment is for the identical purpose of the Strain invention, or that they employ the individual adjustment of each grading-opening independent of each other grading-opening. The trial court did not base its decree upon any denial of these propositions, *but upon the added function of the overlapping guide-arms* interposed between the rollers in lengthening out the machine and securing the new additional function invented by Mr. Parker. Mr. Parker's patent was granted by the Patent Office to secure to him his added invention, *i. e., the longitudinal adjustment of the grade-openings*. This is an improvement, but the action of the Patent Office is no decision as to whether the Parker machine includes the Strain invention.

In the trial court the decision of this case was based entirely upon the feature of moving the grading-openings longitudinally of the machine by shifting lengthwise the brackets and rollers. *This added adjustment* appellant submits was given a wrong interpretation and effect.

This is apparent from His Honor Judge Wellborn's statement:

"That feature, the end adjustment by reason of the spaces between the rolls in the Parker device and that

in the Strain device, it seems to me makes them different and prevents the latter from infringing upon it."

This is further emphasized by His Honor saying:

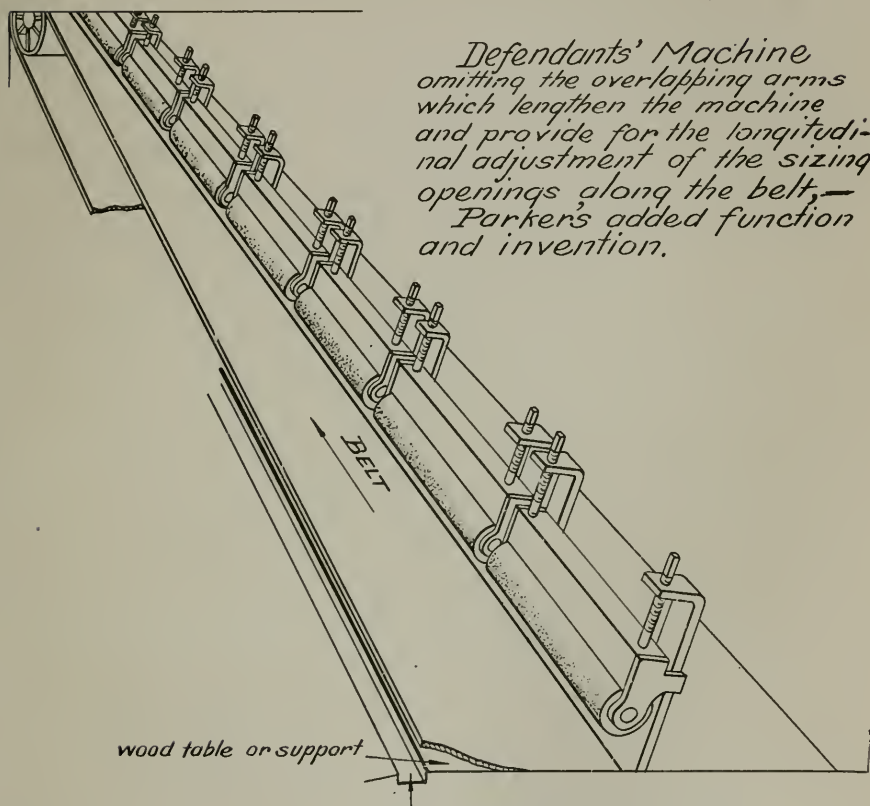
"He (Parker) has introduced the guide-arm in that machine, and they have an apparent function to perform *aside from forming part of the runway.*"

That the lower court actually decided in favor of appellant on all issues of infringement of these two combinations of claims 1 and 10 but dismissed the bill on an erroneous theory of non-infringement because defendants had added an additional function to a part of the element, is clear from His Honor's words:

"That it is true that these guide-arms in a Parker machine perform exactly the same function in the Parker device that they do in the Strain patent, that is, so far as constituting one member of the runway, but there is something more to that guide-arm. It is a part of Parker's invention by which he gets an enlarged bin capacity. It is a part of the end adjustability of the guide-arms and they perform a function in the machine that Parker manufactures which in my mind differentiates it very materially from the Strain patent."

Appellant produces a cut of the defendants' machine, *omitting these overlapping guide-arms.* Otherwise this cut is substantially the same as that found as the second inserted cut opposite page 58 of appellant's brief. Undoubtedly the lower court would have held this machine (without such guide-arms) to have infringed both claims 1 and 10. It held the Miller machine, "complainant's exhibit model of defendants' machine in Pioneer Fruit Co. case" to infringe. Compare this cut with that exhibit. This cut illustrates the fact that all the several elements of the two combinations embraced in

*Infringement illustrated in accord with
lower Court's decision.*



*Defendants' Machine
omitting the overlapping arms
which lengthen the machine
and provide for the longitudinal
adjustment of the sizing
openings along the belt,—
Parker's added function
and invention.*

*groove of the non movable guide
and support for the belt. In this
groove the propelling and centering
chain or belt (attached to main belt)
runs. This groove performs the same
office in the stationary table, that appellants
non movable grooved guide performs.*

claims 1 and 10 are found in defendants' machines and that the spacing apart of the individual and independent rollers and their brackets is the sole distinction.

The issue of infringement is thus demonstrated to turn *solely* upon the additional function of these guide-arms.

It is clear, therefore, from the decision of the lower court that the decision to be reviewed was not based upon any differentiation as to mechanical devices or any detail of construction or any other structural feature or any proposition than this added function, *i. e.*, longitudinal sliding or adjustment bodily of the independent and individual rollers, and that the lower court did not find any other feature which differentiated defendants' machine from Robert Strain's invention or from either claim 1 or 10 of the patent in suit. The question is then a precise one and a very narrow one, and is wholly determined by answer to the proposition:

"Can a defendant appropriate a patented invention and, while employing its principles and benefits and its mode of operation, by adding an element for an additional function escape the charge of infringement?"

If this question be answered in the negative then the decree of the lower court was wrong and defendants' machines are an infringement and the decree appealed from must be reversed. The authorities settle the question in the negative. See:

Appellant's Opening Brief, pages 25 to 27;

Kisinger-Ison Co. v. Bradford, 97 Fed. 502, 38
C. C. A. 300;

Letson v. Alaska Packers' Ass'n, 130 Fed. 129,
page 143;

Comptograph Co. v. Mechanical Co., 145 Fed.

331;

Walker on Pats., Sec. 352, page 309;

Masseth v. Palm, 51 Fed. 824;

Western Co. v. American Co., 131 Fed. 75, 65

C. C. A. 313;

American Co. v. Wyeth, 139 Fed. 389, 71 C.

C. A. 485.

Defendants urge that each of the defendants' rollers and its brackets form, in conjunction with the belt, "*a distinct sizer, independent of all the others.*" This contention is so plainly unsound as a distinction between the machine of the drawings and specification of the patent in suit, as an embodiment of Robert Strain's invention, as to need only comparison to utterly destroy it. In the machine as shown in the Strain patent each roller is mounted in its own individual brackets and forms in the same sense as defendants' a separate or distinct sizer. But in actual fact and in practical use in both defendants' machines and the machine of the patent in suit each roller does *not* form "*a distinct sizer*" but simply *an independent and individual grading-opening* separately controllable and regulable as the will of the user determines, and this demonstrates the embodiment therein of Robert Strain's invention, and shows the infringement complained of, and is not a demonstration of the absence of infringement. A single grading-opening is not a complete grader or sizer. The comparison, however, is equally true of defendants' machines and the machine shown by Robert Strain in his drawings.

Appellant again calls the court's attention to this fallacy as it is characteristic of the defendants' whole case. It is demonstrated erroneous by a reference to the patent in suit. [Transcript page 164.] Each roller M is mounted at each end in an adjusting arm or bracket N. These arms or brackets N are slidably mounted in blocks O. The brackets N and blocks O of each roller are as independent of those of an adjacent roll as are the corresponding parts in defendants' machines. This is illustrated by the fact that a removal of one roller, its brackets and blocks, has no effect upon the next roller, its brackets and blocks, in any sense in which defendants' rollers, their brackets and adjusting blocks are independent. The difference between defendants' machines and the embodiment of machine of the drawings of the patent in suit *does not exist in one roller, its brackets and adjusting devices forming in conjunction with the belt "a distinct sizer, independent of all others."* This is as true of the machine shown in the patent in suit as it is of defendants' machine. The utter fallacy of Mr. Cobb's testimony, quoted on page 65 of appellee's brief, is thus apparent. He has utterly failed to understand the machine of the patent in suit.

Remove from the defendants' machine one of these so-called "distinct sizers" (*i. e.*, the independent and individual roller and its supporting bracket and adjusting devices), and you have in the same sense removed from the machine one of the sizing openings and thus destroyed the integrity of the machine to the same degree and in the same sense as the removal of one

of Mr. Strain's individual and independent rollers, its brackets and adjusting devices. The correspondence is direct and exact. The only difference in the two machines, *in substance*, is the overlapping guide-arms *employed by defendants for an additional and independent function, i. e.*, a shifting of the delivery point of a given grading-opening along the longitudinal extension of the machine. So far as forming part of the run-way is concerned these guide-arms are the equivalent of Mr. Strain's. The lower court so held, and properly. His Honor said:

"It is true that these guide-arms in a Parker machine perform exactly the same function in the Parker device that they do in the Strain patent, *that is, so far as constituting one member of the run-way.*"

It is true that His Honor finishes this sentence by adding: "But there is something more to that guide-arm." His Honor, however, very correctly finds that so far as constituting the run-way is concerned the use of the overlapping guide-arms has not changed the idea of means of the Strain invention, and that, as shown by the next sentence of his opinion, the distinction which he dwells upon is the added function. His Honor again reiterates this and emphasizes it by saying "they (the overlapping guide-arms) have an apparent function to perform aside from forming a part of the run-way."

As referred to on page 23 of appellant's opening brief, Mr. Strain, in the specification or description of his invention, has stated that he could provide "short grade-rollers," each separately adjustable, "*and more*

than one roller may be adjusted to the same grade, if desired.” [Transcript page 166, page 2 of the Strain specification, lines 15-16.] The result of adjusting two rollers to the same grade is to employ the second roller simply as an idler, or non-grading opening, or space, to carry the fruit to the next succeeding bin, the same as in employing the over-lapping guide-arms in place of such roller. Such roller would not have the function of permitting the roller of such “next succeeding bin” to be slid longitudinally of the machine to vary the point in the machine in which it forms a grading-opening, but such blocked-out roller,—*i. e.*, the second roller adjusted to the same grade,—would only perform the function of a wall on which the fruit bore as carried along by the belt and would not be a grading-opening in the operation of the machine. This shows conclusively the equivalence of the guide-arms as forming a part of the run-way and shows that the Strain machine in this respect has not been deviated from by the defendants by the insertion of their element constructed with such additional function. For all the functions of Mr. Strain’s invention they are, however, the same. The added function is Mr. Parker’s invention, and it is an addition to Mr. Strain’s. This is what the lower court found, but, as appellant submits, erroneously believed the law to hold it non-infringing because of such added function.

Nowhere in the specification of the patent in suit has Robert Strain limited his invention to the use of only that number of rollers corresponding to the number of grades or separations as to size desired to be

made. Nowhere in the art is there any absolute requirement for nine sizes or any other fixed number of sizes. In fact some of the witness have testified that in given orchard runs the oranges run to four or five sizes. Others have testified to making a separation into ten sizes. Mr. Strain says in his specification that short rollers may be used and that more than one roller may be adjusted to the same grade, if desired. He says that his preference is to have a bin for each roller and that usually oranges are separated into nine sizes, but he does not say that in a given quantity of fruit you will always find oranges of each of these sizes, nor is that the fact. This specification of the patent in suit shows the preferred embodiment of the Strain invention. The last of the specification refers to a modification in which short rollers may be used. If two rollers are adjusted to the same grade, *i. e.*, the opening between the belt and two consecutive rollers be the same, then the second roller is idle, as all the fruit of that size passes through between the first roller and the belt and the second roller simply forms a wall in conjunction with the belt, along which the fruit travels to the next grading-opening, in the same manner as the fruit is carried along between the belt and overlapping guide-arms in the Parker machine. This is what the lower court referred to in saying "it is true that these guide-arms in a Parker machine perform exactly the same function in the Parker device that they do in the Strain patent, that is, so far as constituting one member of the run-way." The court does not differentiate on the Strain function performed by these parts but by the additional

function performed by Mr. Parker's guide-arms, and again we see that this suit narrows down to the proposition "Will merely adding a function to a machine or to one of its parts, and yet retaining the old mode of operation and all the old functions and advantages, permit a defendant to appropriate a patented invention, thus unchanged except by an addition thereto?"

In appellees' brief in referring to the rollers of defendants' machines they are termed "an elastic buffer or cushion." Why this term? It is clearly misleading and erroneous. They are wooden rolls. They are non-elastic and they are neither buffers nor cushions. These parts are made in roller form for the very same reason that Robert Strain utilized rotating rollers. This has been fully explained in our opening brief. Defendants' machines would be impractical if they did not use the rotating rolls as one wall of the grading-opening. The rolls rotate upward and away from the pinch and in no sense are elastic.

On page 6 of appellee's brief it is stated that: "there is no provision made for a non-movable grooved guide, mentioned in the patent in suit as constituting one of the parallel members of the fruit run-way."

In the second cut inserted between pages 58 and 59 of appellees' brief the drawing has been stopped just where, if it were completed, it would show the groove in which the propelling chain or belt rests and which hold the wide conveying belts in place against displacement laterally by the weight or by the action of the oranges. The cut produced by appellant in this brief supplies this *in accord with the defendants' machine* and shows the misleading character of the statement

just quoted from appellees' brief. In defendants' machines the stationary guide, within which the groove is produced, extends under the whole of the fruit-carrying belt and the stationary guide or table and the groove performs exactly the same function and in exactly the same manner as in the machine of the drawings of the patent in suit. The only difference is that which would be present in the change of the form of the belt from a round or "rope" form to a flat belt. And if you will demonstrate the plane referred to in claim 1 you will find that this same plane "which passes vertically and longitudinally through the center of said rollers" in the Strain machine, passes vertically and longitudinally through the center of the rollers of defendants' machines and that the table or non-movable guide lies parallel to this plane in both defendants' and the Strain machine for the same purpose and in the same sense. Defendants' machines answer perfectly to this requirement. The purpose in both is the same,—to support and guide the belt.

A "*plane*" passing through the rollers longitudinally and vertically must lie parallel with or to the table or support and to the groove therein of defendants' machines and in the same sense as in appellant's machines. The language or wording of the claim in this respect fits defendants' machine even better than it does the machine as illustrated in the drawings of the patent in suit.

Appellees seek to make much of the use of the words "end to end" in claim 10. In appellant's opening brief, pages 53-59, is found a discussion of this term and its

history. The Patent Office had cited against *Mr. Rayburn's* original claims the patent to Hutchins. To differentiate from Mr. Hutchins' proposed and thoroughly impractical mode of operation embodying a series of rolls arranged one above the other and spaced apart from a stationary member or belt between which roll and belt all the fruit dropped (except one size, which was carried the length of the roll) and to indicate that the invention claimed had to do with a machine in which the grading-openings were arranged in progressive order in longitudinal extension, Mr. Rayburn adopted the phrase "a series of end to end rolls." Mr. Hutchins showed his rolls superposed or one above the other. The words adopted by Mr. Rayburn were not "a series of rolls the end of one abutting the other." It is submitted that the preposition "to" has several meanings; it may mean "toward" or it may mean "at." As the term must be interpreted and is not exact the court will adopt that construction which will preserve to the patent in suit a monopoly of the real invention disclosed thereby.

See authorities cited pages 57-59 appellant's opening brief.

As said by the Circuit Court of Appeals for the Second Circuit, in *Carlson Motor & Truck Co. v. Maxwell Briscoe Co.* (197 Fed. 309, 315):

"The question is not one of nomenclature but of mechanics, and relates not to the names given to the parts of the combination, but to the functions they perform."

To give this term "end to end" the meaning and interpretation thus contended for will only give it a

proper, ordinary and usual meaning and one peculiarly apt in describing the Strain machine in which the rollers do not abut. The term "end to end" was never used to denote there was not or could not be a non-separating or non-grading space between the ends of the rolls, and no such construction had been shown by the Patent Office, as prior to Mr. Strain's invention, to cause the limitation to the placing of the rollers so as to form "a continuous, substantially unbroken rotary member for the front run-way," as appellees would have the court interpret the wording of the claim. Appellees insist that defendants' machines are not provided "with a continuous, substantially unbroken outer rotary wall member for the fruit run-way." Such is not even the terms of either claim 1 or claim 10. In defendants' machines, however, each part of the machine, utilized in separating the fruit, is formed of a longitudinally moving belt and an individual and independently adjustable roller. The terms of claims 1 and 10 do not call for "a continuous, substantially unbroken outer rotary wall member for the fruit run-way." There was no need for such a limitation, and, as said by the Supreme Court in *Topliff v. Topliff* (145 U. S.):

"The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute or by the application of artificial rules of interpretation."

And in *Klein v. Russell* (19 Wall. 433):

"The court should proceed in a liberal spirit, so far as to sustain the patent and the construction

claimed by the patentee himself if it can be done consistently with the language which he has employed.”

The spacing apart of the rollers to permit the interposition of the guide-arms and permit the guide-arms to contribute the added function of longitudinal sliding of the respective rollers for the added adjustment conceived by Mr. Parker has not changed the inventive idea produced by Mr. Strain and the substance of Mr. Strain’s invention remains unchanged in defendants’ machines. This is the true test of infringement.

Justice Blatchford says:

“Any improvement in one element of a combination which does not affect its manner of cooperation with the remaining devices will not serve to avoid the charge of infringement.”

Potter v. Stewart, 7 Fed. 215, 18 Blatchf. 561.

As said by the Circuit Court of Appeals for the Eighth Circuit in *Lourie Imp. Co. v. Lenhart* (130 Fed. 122):

“A device which is constructed on the same principle, which has the same mode of operation, and which accomplishes the same result as another by the same means or by equivalent means, is the same device, and a claim in a patent of one such device claims and secures the other.” Citing *Machine Co. v. Murphy*, 97 U. S. 120, 125.

On page 6 of appellees’ brief the statement is made that the cut of defendants’ machine illustrates “a series of aligned non-rotary grading units.” The statement is inaccurate and misleading. As has already been seen the rollers of defendants’ machines

form, in conjunction with the belt, the grading-openings, and the belt is supported in the same manner as in the Strain invention. How defendants' justify the statement that the defendants' machine is made up of a series of aligned non-rotary grading units is not apparent, and such is not the fact.

Appellees' seek to make a point against the patent in suit in a contention that the same is not in terms limited to a machine for grading any given class of fruit. This is true. It is the best adapted machine for sizing oranges. It is because of the control of the operator over each grading-opening, independent of any other grading-opening, that the Strain invention is so readily and peculiarly adjustable from a condition for use in grading oranges, to grading other fruits and nuts. It is the first machine that could be so generally used, and that adaptability is due to Mr. Strain's broad conception of placing the grading-openings each independently within control of the user and not dependent upon the whim of the manufacturer and in fixed relation to each other.

Appellant does not seek to have the court enlarge either claim 1 or claim 10 or to remove any limitation of either of these claims, as appellees urge. Defendants' machines answer perfectly to every limitation of each of these claims, and the only difference between the appellees and the appellant as to the construction to be given to the claims is that appellees contend the claims must be restricted to the exact elements specified in the claims and in the exact form shown and described in the patent in suit, while appellant insists that a reasonable application of the doctrine of equiv-

alents be applied to these claims to protect Robert Strain's invention according to its importance in the art and according to the real merit and scope of the invention. Every element of both of the claims are found in defendants' device, and the only distinction between the machine of the patent in suit and defendants' machines is the spacing apart of the individual and independently adjustable rollers by means of the overlapping guide-arms. This change or addition has not changed the function of the rollers in any manner whatever, and the overlapping guide-arms serve solely to perform an additional function,—the longitudinal adjustment of the rollers lengthwise.

A mechanical equivalent, in the patent law sense, is a device which is substituted in one mechanism for some other device, and to be an equivalent the substituted device must perform the function of the device for which it is substituted, and in substantially the same manner. It is immaterial if such substitute also performs an additional function.

Walker on Pats., Section 352;

Norton v. California Can Co., 45 Fed. 638;

Masseth v. Palm, 51 Fed. 825;

Foss v. Herbert, 2 Fisher Pat. Cas. 31;

Sarven v. Hall, 9 Blatchf. 524;

Cantrell v. Wallick, 117 U. S. 689.

The operative portion of that side of the fruit runway, opposite the traveling or "propelling" belt, as appellees seem to desire to term it, is in defendants' machine made up of the same elements as in the Strain patent,—plus an additional element which has an ad-

ditional function brought into use when the machine is not in operation, but when in operation the functions are the same and the interposition of this element, the guide-arms, still enables defendants' to make up the operative part of the fruit run-way of grading-openings consecutively increasing along the longitudinal extension of the belt in the same manner as proposed by Mr. Strain for the first time in the art, and to form such grading-openings in the manner proposed by Mr. Strain,—*i. e.*, by the belt on one side and the individual and independently adjustable roller on the other. Furthermore defendants mount each of these individual rollers in individual brackets, the form only slightly differing from that of the drawings of the patent in suit,—and these brackets, the adjusting screws thereof, etc., lying in the same plane with respect to the belt and its grooved support, guide or table as do the similar elements in the patent in suit. In fact every analysis given of the various elements of claims 1 and 10 brings the conclusion that the only difference is in Mr. Parker's added adjustment. He has taken the whole of the Strain invention and seeks to escape the charge of appropriation solely by adding an additional advantage (?).

On page 17 of appellees' brief there are printed two revised claims, in an attempt to demonstrate that appellant is seeking to have the court read out of or omit from the claims some kind of a limitation supposed to exist therein, which does not correspond with the interrelation of parts in the defendants' machines. Unfortunately for appellees each of such proposed claims have only omitted such parts of claims 1 and

10 of the patent in suit as are clearly embodied in defendants' machines, and the futility of appellees' proposition is apparent from a comparison thereof.

The futility of appellees' attempt to show that the claims in suit were limited (to matters not found in defendants' machines), during the prosecution of the application for patent in the Patent Office, is demonstrated on pages 18 and 19 of appellees' brief. Original claim 1 of the application, according to appellees, differed from claim 1 of the re-issue patent in suit "only by incorporating into the claim the limiting expression 'independent' as applied to the adjustable rollers; and the expression, 'plane which passes vertically and longitudinally through the center of,' as applied to the location of the guide, and the further limitations that the guide shall be non-movable and grooved, and that the rollers and guide shall form the fruit runway of the grader."

If this be an accurate statement of the alleged limiting of claim 1, it is found that the defendants' machines answer fully to each of these limitations.

1. Defendants' machines each contain a plurality of independent transversely adjustable rotating rollers, thus conforming to what appellees insist was the first limitation thus incorporated in the claim.

2. In defendants' machines a plane which passes vertically and longitudinally through the center of the rollers is parallel with the grooved guide or table support for the belt, thus conforming to the other limitations thus incorporated, as appellees' contend, in the claim.

It is clear that the rollers and the belt or grooved guide for the belt form the run-way in both defendants' and appellant's machines. The lower court so found.

One of the most remarkable statements that appellant's counsel has read in a brief for a long time is that contained on page 21 of appellees' brief, *i. e.*:

"It will be noted that claim 10 calls for the same elements as rejected claim 2, with the exception that the rollers shall constitute one member of the fruit run-way and are limited to the extent that said rollers shall be arranged 'end to end,' " etc.

Original claim 2 of the Strain application called for but one element, to-wit: a plurality of transversely adjustable rotating rollers. No other element is mentioned in said original claim 2. It was not directed to any such combination as is expressed in the tenth claim of the re-issue patent. Furthermore the tenth claim was allowed without any such action by the Patent Office. See appellant's opening brief, pages 51-54. This claim most certainly cannot have less scope than it would have in the Rayburn patent. Nothing in the Strain application can limit. Its scope was determined, according to appellees' contention in the Rayburn application proceedings. All these contentions by appellees may be substantially disregarded, however, as every one of the alleged limitations defendants' machine respond to and embody.

In appellees' brief, page 54, an attempt is made to throw mud at the fact that machines embodying Robert Strain's invention have totally displaced all the Ish or California graders. The fact remains that

although the Ish patent expired five years ago, not a single new Ish or California grader has been manufactured or placed in use by anyone. The facts are that the Strain invention was of such merit as to compel the users of California graders to displace them with the Robert Strain type of machine. This is proven not only by the testimony of Mr. Stebler and Mr. Whiffin, on behalf of appellant, but by every one of appellees' witnesses.

The fact remains that the inventive idea expressed in the patent in suit, and in the combinations embraced by claims 1 and 10, are the formation of the grading-openings between the supported belt and the rollers, mounting each roller independently of the other rollers and thus giving the user the absolutely perfect control of the grading-opening without affecting any of the other grading-openings. Appellant firmly believes that this court will give to the patent in suit such a construction as will reserve to the owner of the patent in suit the substantial monopoly intended by the patent law of this inventive idea. This is particularly and peculiarly a case where such a construction can be given to the claims in suit without eliminating from them any limitation expressed in the claims. Such action by this court would only give appellant a monopoly of what Mr. Strain added to the art. It is submitted as the proper construction of the patent in suit.

As said by the Supreme Court in *Keystone Mfg. Co. v. Adams* (151 U. S. 139):

“But when in a class of machines so widely used as those in question, it is made to appear that at last, after repeated and futile attempts, a machine has been contrived which accomplishes the result desired, and when the Patent Office has granted a patent to the successful inventor, the court should not be ready to adopt a narrow or astute construction, fatal to the grant.”

In appellees' brief many references are found to “pioneer” or “primary” inventions as distinguished from inventions which, although of broad character, are not strictly the very first invention in a given art or line, and appellees seem to insist that no liberality of construction whatever is to be indulged in by the court in the interpretation of the scope of the claims for any other invention than such a truly “pioneer” or “primary” invention.

This is not the true rule of law. It is not necessary for this court to hold that Robert Strain's invention was a “pioneer” or “primary” one. The true rule of law is that the scope and breadth of range of equivalents depends upon and varies with the degree of invention or the importance of the invention, and that an invention may be of broad character without being a truly “pioneer” or “primary” invention. This rule has been recognized by this court in *Los Alamitos Sugar Co. v. Carroll* (173 Fed. 280), and in *Parker v. Stebler* (177 Fed. 210). It is well settled that a patent can be very broad in scope and broad enough to carry very broad differences of details in mechanism without requiring that it shall occupy the position,

held by so few patents or inventions, of being of a strictly "primary" or "pioneer" character.

2 *Rob. on Pats.*, section 526, page 141;

Renwick v. Pond, 10 Blatch. 39, Fed. Cas. No. 11702;

Brush Elec. Co. v. Ft. Wayne Elec. L. Co., 40 Fed. 833;

Brush Elec. Co. v. Western Elec. L. & P. Co., 43 Fed. 537;

Brush Elec. Co. v. Electric Imp. Co., 52 Fed. 975;

Walker on Pats. (4th Ed.), pages 308, 309, 312.

Even though the invention of a complainants' patent is not of a pioneer or primary character, and notwithstanding a defendant's means and mode of operation are different and even patented, yet there may be infringement.

Mason v. Graham, 23 Wall. 261;

Ives v. Hamilton, 92 U. S. 426;

Machine Co. v. Murphy, 97 U. S. 120;

Elizabeth v. American Nicholson Pav. Co., 97 U. S. 137;

Clough v. Gilbert & B. Mfg. Co., 106 U. S. 166;

Western Elec. Co. v. La Rue, 139 U. S. 601;

Hoyt v. Horne, 145 U. S. 302.

In the case of *Continental Paper Bag Co. v. Eastern Paper Bag Co.* (210 U. S. 405), the defendant and appellant contended that the patent in suit not

being a "pioneer" or "primary" patent, was not infringed, claiming:

"Identity of means and of operation are necessary to constitute infringement of a secondary patent."

This the Supreme Court refused to uphold, finding the patent infringed, and saying:

"The two questions, therefore, which remain for decision, are the jurisdiction of the court and the question of infringement. We will consider the latter question first.

"It does not depend, counsel for the Continental Company says, 'upon any issue of fact, but does depend, as questions of infringement' sometimes do, upon a 'point of law.' This point of law, it is further said, has been formulated in a decision of this court as follows: 'Where the patent does not embody a primary invention, but only an improvement on the prior art, and defendant's machines can be differentiated, the charge of infringement is not sustained.' Counsel for respondent do not contend that the Liddell invention is primary within the definition given of that term by petitioner. Their concession is that it is 'not basic, in the sense of covering the first machine ever produced to make self-opening square bags by machinery.' They do not contend, however, that it is one of high rank, and if it be given a 'fair construction and scope, no matter whether we call it basic, primary, or broad, or even merely entitled to be construed, as covering obvious mechanical equivalents, the question of infringement of the claims in suit by petitioner's machine becomes mechanically, and from a patent law standpoint, a simple one, in spite of slight differences of operation and of reversal of some of the moving parts.' The lower courts did not designate the invention as either primary or secondary. They did, however, as we shall presently see, decide that it was one of high rank and entitled to a broad range of equivalents. It becomes neces-

sary, therefore, to consider the point of law upon which petitioner contends the question of infringement depends."

"The citation is from *Cimiotti Unhairing Co. v. American Fur. Ref. Co.*, 198 U. S. 399, 49 L. Ed. 1100, 25 Sup. Ct. Rep. 697, and *Kokomo Fence Mach. Co. v. Kitselman*, 189 U. S. 8, 47 L. Ed. 689, 23 Sup. Ct. Rep. 521, was adduced to sustain the proposition. But the whole opinion must be considered, and it will be seen from the language which we shall presently quote that it was not intended to say that the doctrine of equivalents applied only to primary patents.

"We do not think it is necessary to follow counsel for petitioner in his review of other cases which, he urges, sustain his contention. The right view is expressed in *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 207, 38 L. Ed. 121, 130, 14 Sup. Ct. Rep. 310, as follows: 'The range of equivalents depends upon the extent and nature of the invention. If the invention is broad or primary in its character, the range of equivalents will be correspondingly broad, under the liberal construction which the courts give to such inventions.' And this was what was decided in *Kokomo Fence Mach. Co. v. Kitselman*, *Cimiotti Unhairing Co. v. American Fur. Ref. Co.*, and *Computing Scale Co. v. Automatic Scale Co.*, 204 U. S. 609, 51 L. Ed. 645, 27 Sup. Ct. Rep. 307. It is from the second of those cases, as we have seen, that the citation is made which petitioner contends the point of law upon which infringement depends is formulated; but it was said in that case: 'It is well settled that a greater degree of liberality and a wider range of equivalents are permitted where the patent is of a pioneer character than when the invention is simply an improvement, maybe the last and successful step, in the art theretofore partially developed by other inventors in the same field.'

"It is manifest, therefore, that it was not meant to decide that only pioneer patents are entitled to

invoke the doctrine of equivalents, but that it was decided that the range of equivalents depends upon and varies with the degree of invention. See *Ives v. Hamilton*, 92 U. S. 426, 23 L. Ed. 494; *Hoyt v. Horne*, 145 U. S. 302, 36 L. Ed. 713, 12 Sup. Ct. Rep. 922; *Deering v. Winona Harvester Wks.*, 155 U. S. 286, 39 L. Ed. 153, 15 Sup. Ct. Rep. 118; *Walker, Patents*, Sec. 362; *Robinson, Patents*, Sec. 258."

In *Clough v. Gilbert & Barker Manufacturing Co.*, 106 U. S. 166, Mr. Justice Blatchford says:

"The combination of the first claim of the Clough patent being new, and, consequently, there never having been any valve arrangement applied to regulate the flow of gas in such a combination, the premises on which the decision of the court below proceeded fail. Clough is entitled to the benefit of the doctrine of equivalents as applied to the combination of the burner, surrounding-tube, and regulating-tube, covered by the second claim of his patent. The regulation in the defendants' burners was by a tubular valve on the outside of the perforation instead of on the inside, and performing its work by being screwed up or down, as in Clough's. Although in the Clough structure the burner and surrounding-tube revolve together in adjusting their position in reference to that of the tubular valve, so as to let in or turn off the supply of gas through the perforations, and although in the Clough structure the flame revolves by the revolution of the burner, and although in the defendant's burners the revolution of the surrounding-tube regulated the supply of gas through such perforation, and neither the burner nor the flame revolved, the defendants' valve arrangement must be held to have been an equivalent for that of Clough to the full extent to which that of Clough goes, involving, perhaps, patentable improvements, but still tributary or subject to the patent of Clough. It is true that that patent de-

scribes the tubular valve as being inside of the burner-tube. But Clough was the first person who applied a valve regulation of any kind to the combination to which he applied it, and the first person who made such combination, and he is entitled, under decisions heretofore made by this court, to hold as infringements all valve regulations, applied to such a combination, which perform the same office in substantially the same way as, and were known equivalents for, his form of valve regulation. The record shows that prior to the existence of the appellants' burner it was common in gas burners to check the flow of gas out of the burner by applying an obstruction operated by a screw indifferently outside or inside of the burner. It follows, from these considerations, that the defendants infringed the second claim of the Clough patent."

The Court of Appeals for the Eighth Circuit, in *Lewis Blind Switch Co. v. Premium Mfg. Co.* (163 Fed. 950), says:

"A patent for an invention which is neither primary nor a slight improvement on the prior art, but possesses substantial patentable novelty, covers a reasonable range of equivalents."

"In interpreting the claims of a patent, proper regard should be had to the natural import of the terms in question, the context and the specification."

"The question of infringement turns upon the character of Lewis' invention. We regard it as neither primary nor a slight improvement on the prior art, but as possessing enough of patentable novelty to command a reasonable range of equivalents. The defendants' machine embodies every element or its equivalent, of the claims which we sustain, and accomplishes substantially the same result in substantially the same way."

In *Brown Bag-Filling Mach. Co. v. Drohen* (140 Fed. 97, 100) it is said:

“The Cummings patent in suit, in my opinion, is for a new machine or combination which produces a new and useful result, entitling the patentee to invoke the doctrine of equivalents. The claims secured by the patentee are such that in the determination of the question of infringement by defendants’ apparatus the forms and dissimilarities of construction are not controlling. As was stated in *Kinloch Tel. Co. v. Western Electric Co.*, 113 Fed. 652, 5 C. C. A. 362:

“The similarities and differences of machines and combinations are to be determined by the offices or functions which they perform, by the principles on which they are constructed, and by the modes which are used in their operation. A device which is constructed on the same principle, which has the same mode of operation, and which accomplished the same result as another by the same or by equivalent mechanical means, is the same device, and a claim in a patent of one such device claims and secures the other.’ Citing *Machine Co. v. Murphy*, 97 U. S. 120, 125, 24 L. Ed. 935.”

The Supreme Court of the United States has repeatedly held that a charge of infringement may be made out though the letter of the claims is avoided.

Machine Co. v. Murphy, 97 U. S. 120;

Ives v. Hamilton, 92 U. S. 426-431;

Morey v. Lockwood, 8 Wall. 230;

Elizabeth v. Pavement Co., 97 U. S. 126-137;

Sessions v. Romadaka, 145 U. S. 29;

Hoyt v. Horne, 145 U. S. 302.

A patent is to be construed to cover the novelty of the invention disclosed thereby, as said by the Circuit Court of Appeals for the Sixth Circuit, in *Vrooman v. Penhollow* (179 Fed. 297-9):

“According to the advance it has made in novelty and utility beyond the former art.”

It does not require a broad and generic construction upon the claims of the patent in suit to hold defendants' machines as infringements. On the contrary such machines can escape the charge of infringement only upon the most narrow and strict interpretation of such claims and the limitation thereof to the precise constructions shown and described. If the doctrine of equivalency is applied even with slight liberality the combinations of these respective claims are readily found in defendants' machines.

For these reasons appellant prays that the decree be reversed and appellees enjoined from further appropriating the inventive idea of Robert Strain as thus expressed in the patent in suit.

FREDERICK S. LYON,
Solicitor for Appellant.

